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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,524	12/12/2009	7497943	IND4-29741-USRX	9423
87884	7590	07/20/2011	EXAMINER	
Mossman, Kumar and Tyler, PC P.O. Box 421239 Houston, TX 77242			ART UNIT	PAPER NUMBER

DATE MAILED: 07/20/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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485 7TH AVENUE  
14TH FLOOR  
NEW YORK, NY 10018

Date:

**MAILED**

**JUL 20 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000524  
PATENT NO. : 7497943  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,399	07/16/2010	7497943	IND4-29741-USRX-1	5884
87884	7590	07/20/2011	EXAMINER	
Mossman, Kumar and Tyler, PC P.O. Box 421239 Houston, TX 77242			ART UNIT	PAPER NUMBER

DATE MAILED: 07/20/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

K&L GATES LLP

P.O. BOX 1135

CHICAGO, IL 60690

Date: **MAILED**

**JUL 20 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001399

PATENT NO. : 7497943

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

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P.O. Box 421239  
Houston TX 77242

(For patent owner)

MAILED

JUL 20 2011

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(For the '524 requester) CENTRAL REEXAMINATION UNIT

K & L Gates LLP  
PO Box 1135  
Chicago, IL 60690

(For the '1399 requester)

*In re* Nguyen *et al.*  
*Inter Partes* Reexamination  
Control No. 95/000,524  
Filed: December 12, 2009  
For: U.S. Patent No. 7,497,943

:  
:  
:  
: **DECISION,**  
: **SUA SPONTE,**  
: **TO MERGE**  
: **REEXAMINATION**  
: **PROCEEDINGS**

*In re* Nguyen *et al.*  
*Inter Partes* Reexamination  
Control No. 95/001,399  
Filed: July 16, 2010  
For: U.S. Patent No. 7,497,943

:  
:  
:

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

### REVIEW OF FACTS

1. On March 3, 2009, the Office issued U.S. Patent No. 7,497,943 (the '943 patent) to Tran M. Nguyen *et al.* with 25 claims.
2. On December 12, 2009, a request for *inter partes* reexamination of claims 1, 5-6, and 17 of the '943 patent, was filed by a third party requester and assigned control No. 95/000,524 ("the '524 proceeding"). The request identified Assateague Oil, LLC ("the '524 requester") as the real party in interest.
3. On February 4, 2010, *inter partes* reexamination of the '943 patent was granted in the '524

proceeding. Reexamination was granted for claims 1, 5-6, and 17 of the '943 patent. An Office action was concurrently issued.

4. On April 5, 2010, patent owner timely filed a response to the February 4, 2010 Office action. Patent owner did not amend the specification or the claims.
5. On May 4, 2010, the '524 third party requester timely filed responsive comments.
6. On July 16, 2010, a second request for *inter partes* reexamination of claims 1, 9, and 17 of the '943 patent, assigned control No. 95/001,399 ("the '1399 proceeding"), was filed by a third party requester. The request identified Nalco Company ("the '1399 requester") as the real party in interest.
7. On September 17, 2010, *inter partes* reexamination was ordered on claims 1, 9, and 17 of the '943 patent in the '524 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
8. To date, no Office action has issued in the '1399 *inter partes* reexamination proceeding.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination is ordered in the above-captioned proceedings for overlapping claims of the same patent. Both proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/000,524 and 95/001,399 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the specification and claims are identical in both proceedings. Therefore a "housekeeping amendment" is NOT needed.

### III. CONDUCT OF MERGED PROCEEDING

#### A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

## B. *Inter partes* Third Party Requester Participation:

### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

### 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of *rejection* can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

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<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

It is to be noted that, because the '524 *inter partes* third party requester did not propose any rejections of claim 9 in their request for reexamination, the '524 requester has no appeal rights as to those claims as they appear in the '943 patent.

Likewise, it is to be noted that, because the '1399 *inter partes* third party requester did not propose any rejections of claims 5 and 6 in their request for reexamination, the '1399 requester has no appeal rights as to those claims as they appear in the '943 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to:       Attn: Mail Stop "*Inter Partes* Reexam"  
                      Central Reexamination Unit  
                      Commissioner for Patents  
                      P.O. Box 1450  
                      Alexandria, VA 22313-1450

by FAX to:       (571) 273-9900  
                      Central Reexamination Unit

by Hand to:       Customer Service Window  
                      Attn: Central Reexamination Unit  
                      Randolph Building, Lobby Level  
                      401 Dulany Street  
                      Alexandria, VA 22314

by EFS:           Registered users may submit papers via the  
                      electronic filing system EFS-Web, at:

<https://spportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

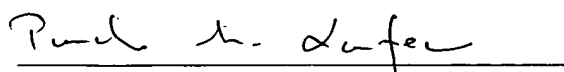
Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/00,524 and 95/001,399 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,526	01/04/2010	6867423	QIPC.REEX01	7335
22428	7590	01/24/2011	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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*Inter partes* Q.I Press Controls B.V. QIPC North America v. Quad/Tech,  
Inc.

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Reexamination Control No. 95/000,526  
Patent 6,867,423  
Technology Center 3900

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DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.183 to suspend 37 C.F.R. § 1.943(c)," filed December 21, 2010. Petitioner requests waiver of the 14,000 word limit of 37 C.F.R. §1.943(c), to permit entry of the patent owner's appellant brief indicated to be 55 pages or 17,500 words. The petition fee of \$400 in accordance with 37 C.F.R. § 41.20(a) was charged to petitioner's credit card account on December 21, 2010, along with the appeal brief fee.

## FINDINGS

1. On January 4, 2010, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,867,423.
2. Reexamination was ordered and a non-final Office action was mailed on February 5, 2010.
3. Patent owner filed a response to the Office action on April 2, 2010, and third party requester filed comments in reply to the Office action and patent owner's response on May 3, 2010, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
4. On June 24 2010, an Action Closing Prosecution (ACP) was mailed, and on September 24, 2010, a Right of Appeal Notice (RAN) was mailed.
5. Patent Owner filed a Notice of Appeal on October 22, 2010, appealing the rejections of claims 1-72.
6. On December 21, 2010, Patent Owner filed an appellant's brief appealing the rejections of claims 1-72, and accompanied by the present petition.

## DISCUSSION

In the present Petition, patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner's appellant brief is stated to be 55 pages and 17,500 words.

Waiver is requested for the following reasons:

- (1) The RAN mailed on September 24, 2010, is 62 pages, includes 12 separate grounds of rejection under 35 U.S.C. 103(a) of 72 claims, and rejects 3 claims under 35 U.S.C. 112. There are new rejections being formally addressed by the Patent Owner for the first time.
- (2) Patent owner has attempted to minimize the length by grouping subject matter where possible, and avoiding needless repetition using cross-references to similar arguments (see appellant's brief). The argument section is 1.44 pages per grounds of rejection separately argued, much of which consists of formal material required by the rules, *e.g.*, separate headings required by 37 C.F.R., § 41.67(c)(1)(viii).
- (3) Much of the additional length of appellant's brief is taken up by other formal requirements, *e.g.*, the Summary of Claimed Subject Matter section (5 pages); the Grounds of Rejection to be Reviewed on Appeal section (3 pages); with all of the preliminary sections and due to the number of grounds of rejection on appeal, the substance of the argument does not begin until page 13 of the Appellant Brief.

(4) Patent Owner does not acquiesce to any of the grounds of rejection included in the Right of Appeal Notice, and contests each of the grounds on appeal. Therefore, the brief includes at least 12 separate arguments (37 C.F.R. § 41.67(c)(1)(viii)); and there are several individual rejections to be considered separately from the larger group.

## RELEVANT AUTHORITY

### **37 CFR 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

### **37 CFR 1.943(c) provides:**

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

### **MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) provides:**

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a

rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

**MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:**

For additional information with respect to the length of papers, see Subsection I.A.2 above.

## ANALYSIS

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. However, the appellant brief filed subsequent to appeal is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Patent owner's appellant brief filed on December 21, 2010, is stated to be 55 pages and 17,500 words which count toward the limit of 30 pages and 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of the RAN, the numerous rejections which are appealed, and the fact that there are new rejections that Patent Owner has not responded to before. However, the prosecution history reveals that the patent owner chose to present an additional 60 claims in their amendment in response to the non-final Office action, without canceling any of the original 12 patent claims. It is not surprising that Patent Owner is now challenged by the page and word limit, given that the number of claims being examined has increased from 12 to 72; and is now six times the number of original patent claims. The Patent Owner caused this challenge itself. Presenting

the Office with 60 new claims is not conducive to expediting *inter partes* reexamination of the instant patent.

The RAN contains rejections under 35 U.S.C. 112 of 3 new claims, and 12 separate grounds of rejection under 35 U.S.C. 103(a) of 72 claims, as compared to the non-final action which contains 2 separate grounds of rejection of 12 original patent claims. Patent owner's amendment necessitated new grounds of rejections by amending claims 5, 9 and 12, and adding claims 13-72. Patent Owner did have an opportunity to respond to the new rejections prior to the RAN, *i.e.*, in response to the ACP of June 24, 2010, but elected not to.

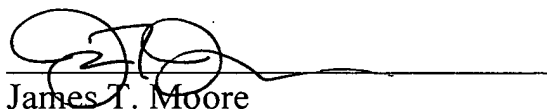
Patent Owner asserts that the length of appellant's brief is due to the number of grounds of rejection on appeal. Patent Owner does not acquiesce to any of the grounds of rejection included in the Right of Appeal Notice, and contests each of the grounds on appeal. Therefore, the brief includes at least 12 separate arguments (37 C.F.R. § 41.67(c)(1)(viii)); and there are several individual rejections to be considered separately from the larger group. However, patent owner argues no less than 26 separate groupings of 12 grounds of rejection under 35 U.S.C. 103(a). It is not surprising that Patent Owner is now challenged by the page and word limit, given that the number of issues has been expanded from 12 to 26, by virtue of all the claims added by Patent Owner.

A persuasive showing has not been made that this situation is extraordinary nor that justice requires that significantly more pages/words be allotted to appellant's brief compared to prior responses and comments submitted in reply to actions issued by the Office.

## DECISION

Appellant is given one opportunity to file a corrected appellant brief in compliance with of 37 CFR 1.943(c), within a non-extendable time period of 30 days/1 month (whichever is longer) from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the appellant's appeal will be dismissed.

In view of the foregoing, the Petition is DENIED.



James T. Moore  
Acting Chief Administrative Patent Judge

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Counsel for Third Party Requester:  
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Hillsboro, Oregon 97124





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,528	03/05/2010	7232656	048522-0002	8947
22922	7590	10/18/2010	EXAMINER	
REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			ART UNIT	PAPER NUMBER

DATE MAILED: 10/18/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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1001 FANNIN STREET, SUITE 2500

HOUSTON, TX 77002-6760

Date:

**MAILED**

**OCT 18 2010**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000528

PATENT NO. : 7232656

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES DEPARTMENT OF COMMERCE

**U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95000528	05 March 2010	7232656	

KLAUBER & JACKSON  
411 HACKENSACK AVENUE  
HACKENSACK, NJ 07601

EXAMINER

ART UNIT

PAPER

20101018-1

**MAILED**

DATE MAILED:

**OCT 18 2010**

**CENTRAL REEXAMINATION UNIT**

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KLAUBER & JACKSON  
411 HACKENSACK AVENUE  
HACKENSACK, NJ 07601

(For Patent Owner)

VINSON & ELKINS, LLP  
FIRST CITY TOWER  
1001 FANNIN STREET  
SUITE 2500  
HOUSTON, TX 77002-6760

(For Third Party Requester)

**MAILED**

**OCT 18 2010**

REINHART BOERNER VAN DEUREN S.C.  
ATTN: LINDA KASULKE,  
DOCKET COORDINATOR  
1000 NORTH WATER STREET  
SUITE 2200  
MILWAUKEE, WI 53202

(Courtesy Copy) **CENTRAL REEXAMINATION UNIT**

In re Balasubramanian et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,528  
Filed: March 5, 2010  
For: U.S. Patent No. 7,232,656

:  
: **DECISION**  
: **GRANTING**  
: **PETITION**  
:

This is a decision on the August 17, 2010 third party requester petition entitled "PETITION TO SUSPEND RULE 37 CFR § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 CFR § 1.183." The petition requests suspension of the requirement of 37 CFR 1.943(b) that the comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to approximately 83 pages in order to fully address the May 19, 2010 non-final Office action and the July 19, 2010 patent owner response. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in comments by third party requester is granted to the extent that the page limit for comments by third party requester is extended to not exceed 86 pages in length.

excluding amendments, appendices of claims, and reference materials such as prior art references.

### **FEES**

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for third party requester's petition under 37 CFR 1.183 has been paid.

### **REVIEW OF THE RELEVANT FACTS**

1. On June 19, 2007, United States Patent Number 7,232,656 (the '656 patent) issued.
2. On January 27, 2010, a request for *inter partes* reexamination of the '656 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/000,528 ("the '528 proceeding").
3. On March 5, 2010, a corrected request for *inter partes* reexamination of the '656 patent was filed by the third party requester in the '528 proceeding, resulting in the proceeding being granted a filing date of March 5, 2010.
4. On May 19, 2010, the Office issued an order granting *inter partes* reexamination in the '528 proceeding, with an accompanying Office action on the merits.
5. On July 19, 2010, patent owner timely filed an amendment and response to the Office action.
6. On August 17, 2010, third party requester filed the instant petition entitled "PETITION TO SUSPEND RULE 37 CFR § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 CFR § 1.183." Third party requester timely filed a 37 CFR 1.947 comments submission concurrently with the petition.

### **DECISION**

#### **I. Relevant Regulations and Procedure**

##### **37 CFR 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

##### **37 CFR 1.943(b) provides:**

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

**MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:**

\*\*\*\*\*

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

## **II. Third Party Requester's Petition**

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on August 17, 2010 to address the May 19, 2010 non-final Office action and the July 19, 2010 patent owner response, and requests that the page limit be extended to approximately 83 pages.<sup>1</sup> In support of its request for waiver of the rule, third party requester argues that patent owner's amendments necessitated the addition of three prior art references and that granting petition is "consistent with the substantial interest of justice in order to effectively address each issue of patentability for the original nine claims, as well as the twelve new claims."<sup>2</sup>

## **III. Analysis and Findings**

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments pursuant to 37 CFR 1.947 in compliance with the 50-page limit, and submitting the resulting comments paper, which is in excess of 50 pages, concurrently with the instant petition for waiver of 37 CFR 1.943(b) with respect to the submitted response.

Third party requester asserts that it "has attempted in good faith to comply with the 50 page limit in preparing comments to the Non-Final Office Action and the Response." Pet. at 3. The third party requester comments paper (excluding 1 cover page, 3 pages of Table of Contents and 1 page of table of exhibits) consist of 83 pages of arguments, and six exhibits. Four of the six

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<sup>1</sup> Petition at page 3.

<sup>2</sup> *Id.*

exhibits (i.e., Exhibits PA-O, PA-P, PA-Q, and OTH-J) do not contain legal arguments and therefore do not count toward the page limit.

It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943. Thus, opinion evidence that goes beyond explaining the evidence - legal assertions and conclusions, e.g. assertions of obviousness and anticipation, are counted as remarks, and are thus part of the 50-page limit of 37 CFR 1.943.

Exhibits OTH-K and OTH-L are respectively, patent owner's claim construction brief filed in the concurrent litigation and a transcript of the claim construction hearing in the concurrent litigation. Third party requester relies on one page (page 39) from Exhibit OTH-K and two pages (pages 173 and 174) from Exhibit OTH-L to support its arguments on page 43 of the comments. Consequently, these three pages from Exhibits OTH-K and OTH-L supporting third party requester's arguments count toward the page limit.

Accordingly, third party requester's comments, *in toto*, is 86 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 36 pages of arguments in excess of 50 required to complete the third party requester's comments are not unreasonable in this instance, in view of the present facts and circumstances. The May 19, 2010 non-final Office action is 71 pages in length (excluding 4 cover sheets and 2 pages of correspondence information) and incorporates by reference a substantial number of pages of the request throughout the Office action.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present *inter partes* reexamination proceeding, the instant third party requester petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester's comments to run 86 pages in length is appropriate in the interest of justice.

Accordingly, the third party requester petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **36 pages** of the arguments portion of third party requester's August 17, 2010 comments submission that exceed the 50-page limit.

#### **PATENT OWNER'S ADDRESS**

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent and (2) the '528 proceeding. The current correspondence address of record **in the patent file** is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of KLAUBER & JACKSON, 411 HACKENSACK AVENUE, HACKENSACK, NJ 07601.

Accordingly, all future correspondence will be directed to KLAUBER & JACKSON, 411 HACKENSACK AVENUE, HACKENSACK, NJ 07601, unless patent owner changes the

correspondence address of record in the patent (the same address should be explicitly made of record in the reexamination proceeding).

As a one-time courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of KLAUBER & JACKSON, 411 HACKENSACK AVENUE, HACKENSACK, NJ 07601, will be used in future correspondence, unless the address of record is changed as set forth above.

### CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's comments after the May 19, 2010 Office action and the July 19, 2010 patent owner response not exceed 86 pages in length, excluding appendices of claims and reference materials, such as prior art references. This waiver makes the August 17, 2010 third party requester comments submission page-length compliant.
2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

/ Kenneth M. Schor/

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Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

10-15-10  
Kenpet8/





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,530	01/28/2010	7123708	019153-0001	4937

22850 7590 12/28/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 12/28/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
KELLEY DRYE & WARREN LLP  
3050 K STREET, N.W.  
SUITE 400  
WASHINGTON, D.C. 20007

Date:

**MAILED**

**DEC 28 2010**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000530  
PATENT NO. : 7123708  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension  
of Time in Reexamination**

Control No.: 95/000,530

1. THIS IS A DECISION ON THE PETITION FILED 23 December 2010.
2. THIS DECISION IS ISSUED PURSUANT TO:
  - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
  - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.  
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS  
Patent owner requests that the period for responding to the Office action mailed on 24 November 2010 which sets a one (1) month period for filing a response thereto, be extended by two (2) weeks
  - A. ☒ Petition fee per 37 CFR §1.17(g):
    - i. ☐ Petition includes authorization to debit a deposit account.
    - ii. ☐ Petition includes authorization to charge a credit card account.
    - iii. ☐ Other: \_\_\_\_\_.
  - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
  - C. ☒ Petition was timely filed.
  - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
  - A. ☒ Granted or ☐ Granted-in-part for two (2) weeks because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).  
☐ Other/comment: \_\_\_\_\_.
  - B. ☐ Dismissed because:
    - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
    - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
    - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
    - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
    - v. ☐ The petition is moot.
    - vi. ☐ Other/comment: \_\_\_\_\_.
5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611 .In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/  
[Signature]

SPE, AU 3992 Central Reexamination Unit  
(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,530	01/28/2010	7123708	019153-0001	4937
22850	7590	03/25/2011	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
KELLEY DRYE & WARREN LLP  
3050 K STREET, N.W.  
SUITE 400  
WASHINGTON, D.C. 20007

Date: **MAILED**

**MAR 25 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000530  
PATENT NO. : 7123708  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA VA 22314

MAILED

MAR 23 2011

CENTRAL REEXAMINATION UNIT

(For Requester)

KELLEY DRYE & WARREN LLP  
3050 K STREET, NW  
SUITE 400  
WASHINGTON, DC 20007

*In re:* Gavillet  
Reexamination Proceeding  
Control No. 95/000,530  
Request Deposited: January 28, 2010  
For: U.S. Patent No. 7,123,708

:  
:  
: **DECISION**  
:  
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This is a decision on the September 15, 2010 paper entitled "PETITION UNDER 37 C.F.R. § 1.181(a)(1) TO DENY ENTRY OF IMPROPER THIRD PARTY RESPONSE".

Initially, it is noted that the request was premature under 37 CFR 1.181 as the examiner had not yet taken action. Furthermore, the examiner took action on September 30, 2010 and found the comments to exceed the page limit set forth in 37 CFR 1.943.

Accordingly, the September 15, 2010 petition is dismissed as either premature or moot.

**CONCLUSION**

1. Petitioner's request to deny entry of the 3PR's comments is dismissed.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Application/Control Number: 95/000,530

Page 2

Art Unit: 3992

3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

A handwritten signature in cursive script, appearing to read "Eric Keasel", is written over a horizontal line.

Eric Keasel

SPE, AU 3992, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,530	01/28/2010	7123708	019153-0001	4937
2574	7590	09/20/2011	EXAMINER	
JENNER & BLOCK, LLP 353 N. Clark Street CHICAGO, IL 60654-3456			ART UNIT	PAPER NUMBER

DATE MAILED: 09/20/2011

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Inter Partes* Peerless Network, LLC

v.

Neutral Tandem, Inc.

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Reexamination Control No. 95/000,530

Patent No. 7,123,708

Technology Center 3900

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DECISION ON PETITION

This is a decision on the patent owner's "Petition Under 37 C.F.R. §§ 41.3, 41.68 and 1.182 Regarding a Non-compliant Respondent's Brief," filed on July 25, 2011 (petition). The petition requests that the requester's respondent brief of July 15, 2011, be rejected for not being compliant with 37 C.F.R. § 41.68(a)(3) because it is not limited to the arguments raised in the appellant's brief or 37 C.F.R. § 41.68(b)(2), because the brief introduces non-admitted evidence. The petition fee of \$400 has been charged to petitioner's deposit account on July 26, 2011, as authorized on the transmittal letter of the petition.

*Inter Partes* Reexamination Control No. 95/000,530  
Patent No. 7,123,708

This is also a decision on "Third Party Requester's Response to Patent Owner's Petition Under 37 C.F.R. §§ 41.3, 41.68 and 1.182 Regarding 'Non-compliant' Respondent's Brief," filed on August 5, 2011 (opposition). The opposition acknowledges that the inclusion of a new argument in the respondent brief was the result of oversight, but argues that no new evidence is introduced in the respondent brief. The petition fee of \$400 has been charged to petitioner's deposit account on August 9, 2011, as authorized on page 1 of the opposition.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

## FINDINGS

1. A request for *inter partes* reexamination of U.S. Patent No. 7,123,708 was filed on January 28, 2010, and was assigned control no. 95/000,530.
2. On March 26, 2010, reexamination was ordered, and a non-final Office action was mailed.
3. Prosecution was conducted and on March 11, 2011, a Right of Appeal Notice (RAN) was mailed.
4. Patent owner filed a Notice of Appeal on April 11, 2011, and requester filed a Notice of Cross-Appeal on April 15, 2011.
5. Both patent owner and requester filed an appellant brief on June 15, 2011.
6. Both patent owner and requester filed a respondent brief on July 15, 2011.
7. Patent owner filed the present petition on July 25, 2011.
8. Requester filed an opposition to the petition on August 5, 2011.

## DISCUSSION

The patent owner's petition requests that the requester's respondent brief of July 15, 2011, be rejected for not being compliant with 37 C.F.R. § 41.68(a)(3), because it is not limited to the arguments raised in the appellant's brief, or with 37 C.F.R. § 41.68(b)(2) because the brief introduces non-admitted evidence. The patent owner contingently requests that if the requester's respondent brief is entered as filed, then patent owner should be granted relief to introduce responsive evidence into the record. The patent owner further requests that, if the requester's respondent brief is entered as filed, and patent owner is not permitted to introduce responsive evidence, then prosecution should be reopened before the examiner. The requester's opposition acknowledges that the inclusion of a new argument in the respondent brief was the result of oversight and requester agrees to submit a revised respondent's brief removing this argument. The opposition contends that requester has not introduced any new evidence in the respondent brief, as the evidence was submitted by patent owner and entered into the reexamination file by the examiner, and therefore properly cited by the requester in this appeal.

## RELEVANT AUTHORITY

### **37 C.F.R. § 1.182 states:**

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

**37 C.F.R. § 41.3 states:**

(a) Deciding official. Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) Scope. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

(c) Petition fee. The fee set in § 41.20(a) must accompany any petition under this section except no fee is required for a petition under this section seeking supervisory review.

(d) Effect on proceeding. The filing of a petition does not stay the time for any other action in a Board proceeding.

(e) Time for action.

(1) Except as otherwise provided in this part or as the Board may authorize in writing, a party may:

(i) File the petition within 14 days from the date of the action from which the party is requesting relief, and

(ii) File any request for reconsideration of a petition decision within 14 days of the decision on petition or such other time as the Board may set.

(2) A party may not file an opposition or a reply to a petition without Board authorization.

**37 C.F.R. § 41.68(a)(3) states:**

The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

**37 C.F.R. § 41.68(b)(2) states:**

A respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

**ANALYSIS**

The petition and opposition have been considered fully. A petition under 37 C.F.R. § 1.182 to strike another party's submission is only appropriate if a submission is improper. A review of the record reveals that the patent owner's appellant brief of June 15, 2011, sets forth four (4) issues on appeal. The requester's respondent brief of July 15, 2011, states that respondent disputes appellant's issue 4 regarding commercial success, and discusses in the "Arguments" section, the evidence that they are relying upon. In the opposition, requester argues that requester has not introduced any new evidence in the respondent brief, as the evidence relied upon was submitted by patent owner and entered into the reexamination file by the examiner, and therefore properly cited by the requester in this appeal.

Pursuant to 37 C.F.R. § 41.68 (b)(2) "[a] respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavits or other evidence." A review of the record reveals that the evidence relied upon in

*Inter Partes* Reexamination Control No. 95/000,530  
Patent No. 7,123,708

the requester's respondent brief was submitted by the patent owner in notices of concurrent litigation on July 6, 2010, and July 26, 2010. Because the disputed evidence was submitted by the patent owner prior to appeal, it is not "new" evidence in the instant *inter partes* reexamination proceeding. Because the disputed evidence was entered into the record of the instant *inter partes* reexamination, and has not been found to be improper nor expunged, it is not "unentered" evidence. Therefore, the requester's respondent brief of July 15, 2011, is in compliance with 37 C.F.R. § 41.68(b)(2), but it is not in compliance with 37 C.F.R. § 41.68(a)(3), as conceded by requester in its opposition, and therefore is **not entered**.

Accordingly, the patent owner's petition is **granted**.

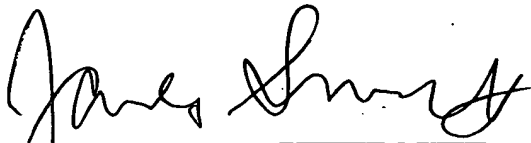
The patent owner's contingent requests for relief are moot in view of the non-entry of the respondent brief.

The requester's opposition is **granted-in-part**.

## CONCLUSION

The petition is GRANTED.

Requester hereby is given one opportunity to file a corrected respondent brief in compliance with 37 C.F.R. § 41.68(a)(3), within a non-extendable time period of one (1) month from the mailing date of this decision. If a compliant respondent brief is not timely received, then the appeal will proceed without consideration of a respondent brief.



James Donald Smith  
Chief Administrative Judge

*Inter Partes* Reexamination Control No. 95/000,530  
Patent No. 7,123,708

COUNSEL FOR PATENT OWNER:

JENNER & BLOCK, LLP

353 N. Clark Street

CHICAGO IL 60654-3456

COUNSEL FOR THIRD PARTY REQUESTER:

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3050 K Street, N.W.

Suite 400

Washington, D.C. 20007



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,533	02/11/2010	7113919	ETPH-0015	4063
23377	7590	02/22/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

ROBERT A. SALTZBERG  
MORRISON & FOERSTER LLP  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

**MAILED**

**FEB 22 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000533

PATENT NO. : 7113919

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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WOODCOCK WASHBURN LLP  
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2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

MORRISON & FOERSTER  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

(For Third Party Requester)

MAILED

FEB 22 2011

In re Norris et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,533  
Filed: February 11, 2010  
For: U.S. Patent No. 7,113,919

:  
: **DECISION**  
: **DISMISSING**  
: **PETITION**  
:  
:

CENTRAL REEXAMINATION UNIT

This is a decision on the third party requester's petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO INCREASE THE PAGE LIMIT FOR THIRD-PARTY REQUESTER'S CORRECTED COMMENTS," filed on December 8, 2010.

The third party requester petition is before the Office of Patent Legal Administration for consideration.

The third party requester petition under 37 CFR 1.183 is dismissed as moot, for the reasons set forth herein.

**DECISION**

**I. Relevant Authority**

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be

imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## II. Third Party Requester Petition Under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the October 15, 2010 third party requester corrected comments after patent owner's July 1, 2010 supplemental response,<sup>1</sup> and requests that the page limit be extended beyond the 400-page limit granted by the May 12, 2010 Office decision in the event that the text incorporated from the record into the corrected comments counts toward the page limit.<sup>2</sup>

## III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester's October 15, 2010 corrected comments submission includes a 371-page remarks section, a three-page declaration under 37 CFR 1.132 by Jeffrey Stein (the Stein declaration) and a 17-page declaration under 37 CFR 1.132 by Deborah L. McGuinness (the McGuinness declaration). It is noted that the remarks section incorporates documents already of record in the present proceeding.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see,

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<sup>1</sup> The October 15, 2010 corrected comments were filed in response to the September 30, 2010 decision entitled "Decision Dismissing Petition and *Sua Sponte* Expunging Improper Papers".

<sup>2</sup> Third party requester petition at 3.

e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The Stein declaration is determined to be free of legal argument.

The 371-page remarks section contains legal arguments. The documents already of record that are incorporated by reference into the remarks section do not count toward the page limit.

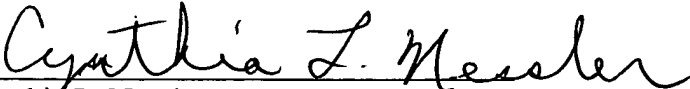
The 17-page McGuinness declaration is replete with legal argument. See e.g., the arguments regarding claim construction (paragraphs 11-14); arguments that the skilled artisan would “easily modify” the discussed references, or “easily incorporate” the teachings of a reference or common knowledge in the teachings of a primary reference (to achieve the subject matter of the patent claims), or that one of ordinary skill could have pursued any of these potential ways with a reasonable expectation of success (found throughout the declaration – see e.g., paragraphs 19, 23, 24, 28, 33, and 36).

Therefore, the 371-page remarks section and the 17-page McGuinness declaration, totaling 388 pages, are subject to and are within the requester’s 400-page limit.

Accordingly, the December 8, 2010 third party requester petition requesting waiver of 37 CFR 1.943(b) is **dismissed as moot**.

### CONCLUSION

1. Third party requester’s December 8, 2010 petition requesting waiver of 37 CFR 1.943(b) is **dismissed as moot**. Third party requester’s corrected comments submission filed on October 15, 2010 is deemed to be **page-length compliant**.
2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

  
Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration

2/22/11  
Cindypet8/IP/length



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

ROBERT A. SALTZBERG  
MORRISON & FOERSTER LLP  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

**MAILED**

**AUG 31 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000533  
PATENT NO. : 7113919  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

**MAILED**

**AUG 31 2011**

**CENTRAL REEXAMINATION UNIT**

MORRISON & FOERSTER  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

(For Third Party Requester)

*In re Norris et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,533  
Filed: February 11, 2010  
For: U.S. Patent No. 7,113,919

:  
:  
: **DECISION DISMISSING**  
: **PETITION**  
:  
:

The paper filed June 25, 2010 by Robert Saltzberg of Morrison & Foerster LLP in San Francisco CA, representing Third Party Requester in the reexamination proceeding, entitled "PETITION TO STRIKE PATENT OWNER'S RESPONSE" is before the Director of Technology Center (TC) 1600, who oversees the Central Reexamination Unit. The petition is being treated as a petition under 37 CFR 1.181.

The third party requester petition is dismissed as premature.



## BACKGROUND

1. On September 26, 2006, United States Patent No. 7,113,919 (“the ‘919 patent”) issued to Norris et al.
2. On February 11, 2010, a request for *inter partes* reexamination of the ‘919 patent was filed by a third party requester (requester), which request was assigned Reexamination Control No. 95/000,533 (the ‘533 proceeding).
3. On March 15, 2010, the Office mailed an order granting *inter partes* reexamination in the ‘533 proceeding.
4. Also on March 15, 2010, the Office mailed a non-final Office action on the merits in the ‘533 proceeding.
5. On March 30, 2010, the patent owner filed a petition under 37 CFR 1.183 entitled “Petition for Increase of Page Limit for Patent Owner’s Response Pursuant to 37 C.F.R. 1.183 and 1.943(b)” (the March 30, 2010 patent owner petition).
6. Also on March 30, 2010, the patent owner filed a request for a two-month extension of time to respond to the March 15, 2010 Office action.
7. On April 16, 2010, the Office mailed a decision granting in part patent owner’s March 30, 2010 request for extension of time, extending patent owner’s time period to respond to the March 15, 2010 Office action by one month.
8. On May 12, 2010, the Office mailed a decision granting the March 30, 2010 patent owner petition. The May 12, 2010 decision waived the page length requirements to the extent that patent owner’s response to the March 15, 2010 Office action not exceed 400 pages in length. The May 12, 2010 decision also sua sponte waived the page length requirements to the extent that any comments filed by the requester in response to patent owner’s response not exceed 400 pages in length.
9. On May 27, 2010, the patent owner filed a petition entitled “Petition to Vacate the Order Granting Reexamination.”
10. On June 10, 2010, the requester filed a petition paper entitled “Opposition Petition to Patent Owner’s Petition to Vacate the Order Granting Reexamination.”
11. On June 15, 2010, the patent owner timely filed a response to the March 15, 2010 Office action (the June 15, 2010 response). The response is 158 pages in length.
12. On June 25, 2010, the requester filed a petition entitled “Petition to Strike Patent Owner’s Response.”

13. On July 1, 2010, the patent owner filed a supplemental response to the March 15, 2010 Office action, which is apparently a substantial duplicate of the June 15, 2010 patent owner response, with the exception that the supplemental response corrects typographical and formatting errors found in claim amendment portion of the June 15, 2010 patent owner response, and includes an additional 5-page chart providing support for the claim amendments (the July 1, 2010 supplemental response).
14. To date, the examiner has not acted upon the June 15, 2010 response and the replacement July 1, 2010 supplemental response.


### DECISION

As pointed out, the third party requester filed a June 25, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the patent owner response, dated June 15, 2010. However, there has been no decision by the examiner if the patent owners June 15, 2010 response is in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the June 15, 2010 response because the examiner has not made his or her decision. Thus, the third party requester's June 25, 2010 petition is premature, and it is dismissed.

In addition, if the examiner accepts the patent owner's July 1, 2010 supplemental response in place of the June 15, 2010 response, third party requester's June 25, 2010 petition would be rendered moot.

### CONCLUSION

1. The June 25, 2010 requester petition is **dismissed as premature**.
2. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

  
\_\_\_\_\_  
Irem Yucel, Director  
Technology Center 1600



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ROBERT A. SALTZBERG  
MORRISON & FOERSTER LLP  
425 MARKET STREET  
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Date:

**MAILED**

**AUG 31 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000533

PATENT NO. : 7113919

TECHNOLOGY CENTER : 3999

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If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

**MAILED**

**AUG 31 2011**

**CENTRAL REEXAMINATION UNIT**

MORRISON & FOERSTER  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

(For Third Party Requester)

*In re Norris et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,533  
Filed: February 11, 2010  
For: U.S. Patent No. 7,113,919

:  
: **DECISION DISMISSING**  
: **PETITION**  
:  
:

The patent owner paper, filed May 27, 2010, entitled "PETITION TO VACATE THE ORDER GRANTING REEXAMINATION" and the third party requester's paper, filed June 10, 2010, entitled "OPPOSITION PETITION TO PATENT OWNER'S PETITION TO VACATE THE ORDER GRANTING REEXAMINATION" are before the Director of Technology Center (TC) 1600, who oversees the Central Reexamination Unit. The petition and opposition are being treated as petitions under 37 CFR 1.181. The petition and opposition contain issues related to petitions under 37 CFR 1.181, 1.182, and 1.183, which does not comply with the requirements of 37 CFR 1.4. The petition states, in part, that the order granting reexamination in the proceeding should be vacated because the request is not confined to issues raising a substantial new question of patentability. Only this portion of the petition is being addressed.

The patent owner's petition to strike is dismissed as untimely.

The third party requester's opposition is dismissed.

## BACKGROUND

1. On September 26, 2006, United States Patent No. 7,113,919 (“the ‘919 patent”) issued to Norris et al.
2. On February 11, 2010, a request for *inter partes* reexamination of the ‘919 patent was filed by a third party requester (requester), which request was assigned Reexamination Control No. 95/000,533 (the ‘533 proceeding).
3. On March 15, 2010, the Office mailed an order granting *inter partes* reexamination in the ‘533 proceeding.
4. Also on March 15, 2010, the Office mailed a non-final Office action on the merits in the ‘533 proceeding.
5. On March 30, 2010, the patent owner filed a petition under 37 CFR 1.183 entitled “Petition for Increase of Page Limit for Patent Owner’s Response Pursuant to 37 C.F.R. 1.183 and 1.943(b)” (the March 30, 2010 patent owner petition).
6. Also on March 30, 2010, the patent owner filed a request for a two-month extension of time to respond to the March 15, 2010 Office action.
7. On April 16, 2010, the Office mailed a decision granting in part patent owner’s March 30, 2010 request for extension of time, extending patent owner’s time period to respond to the March 15, 2010 Office action by one month.
8. On May 12, 2010, the Office mailed a decision granting the March 30, 2010 patent owner petition. The May 12, 2010 decision waived the page length requirements to the extent that patent owner’s response to the March 15, 2010 Office action not exceed 400 pages in length. The May 12, 2010 decision also *sua sponte* waived the page length requirements to the extent that any comments filed by the requester in response to patent owner’s response not exceed 400 pages in length.
9. On May 27, 2010, the patent owner filed a petition entitled “Petition to Vacate the Order Granting Reexamination.”
10. On June 10, 2010, the requester filed a petition paper entitled “Opposition Petition to Patent Owner’s Petition to Vacate the Order Granting Reexamination.”

### STATEMENT OF RELEVANT AUTHORITY

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within **two months** of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. **This two-month period is not extendable.** (Emphasis added.)

...

### DECISION

The patent owner (petitioner) requests that the reexamination proceeding be vacated. The petitioner considers the action taken by the Office by granting the Order to reexamine the patent as an *ultra vires* or improper action by the Office.

The request to vacate the reexamination proceeding is dismissed, as untimely.

The patent owner brings before the Office a petition under 37 CFR § 1.181(a)(3) to vacate an ordered reexamination proceeding because allegedly contains issues not limited to whether a substantial new question of patentability is raised. The patent owner filed the petition on May 27, 2010. The action from which relief is requested is the order granting reexamination, which was mailed on March 15, 2010. Therefore, the petition was filed **over two months** from the mailing date of the action from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two months** from the mailing date of the action from which relief is requested and that such time period is not extendable.

While it is noted that the patent owner's petition includes a statement that "[t]o the extent that entry and consideration of this petition requires suspension of the rules, such as 37 C.F.R. §§ 1.181 and 1.939, suspension is requested pursuant to 37 C.F.R. § 1.183," such a statement is not a proper and grantable petition under 37 CFR 1.183. As noted above, 37 CFR 1.4(a) requires separate papers for different issues. In addition, 37 CFR 1.183 requires a showing that waiver of the rules is necessary to justly address an extraordinary situation. Therefore, the petition is subject to the requirements of 37 CFR 1.181(f) and is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

The requester's opposition petition of September 13, 2010 is dismissed because patent owner's petition is determined to be untimely, without addressing the merits.

### CONCLUSION

1. The August 31, 2010 patent owner petition is **dismissed as untimely** without consideration of the merits.
2. The September 13, 2010 requester opposition petition is **dismissed**.
3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.



---

Irem Yucel, Director  
Technology Center 1600





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TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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WOODCOCK WASHBURN, LLP  
CIRA CENTRE, 12<sup>TH</sup> FLOOR  
2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

**MAILED**

**AUG 31 2011**

**CENTRAL REEXAMINATION UNIT**

MORRISON & FOERSTER  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

(For Third Party Requester)

*In re Norris et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,533  
Filed: February 11, 2010  
For: U.S. Patent No. 7,113,919

:  
: **DECISION DISMISSING**  
: **PETITION**  
:  
:

The patent owner paper, filed August 31, 2010, entitled "PETITION TO STRIKE REQUESTER'S SUPPLEMENTAL RESPONSE" and the third party requester's paper, filed September 13, 2010, entitled "OPPOSITION TO PATENT OWNER'S PETITION TO STRIKE REQUESTER'S SUPPLEMENTAL RESPONSE" are before the Director of Technology Center (TC) 1600, who oversees the Central Reexamination Unit. The petition and opposition are being treated as petitions under 37 CFR 1.181.

The patent owner's petition to strike is dismissed as moot.

The third party requester's opposition is dismissed.

## **BACKGROUND**

1. On September 26, 2006, United States Patent No. 7,113,919 (“the ‘919 patent”) issued to Norris et al.
2. On February 11, 2010, a request for inter partes reexamination of the ‘919 patent was filed by a third party requester (requester), which request was assigned Reexamination Control No. 95/000,533 (the ‘533 proceeding).
3. On March 15, 2010, the Office mailed an order granting inter partes reexamination in the ‘533 proceeding.
4. Also on March 15, 2010, the Office mailed a non-final Office action on the merits in the ‘533 proceeding.
5. On March 30, 2010, the patent owner filed a petition under 37 CFR 1.183 entitled “Petition for Increase of Page Limit for Patent Owner’s Response Pursuant to 37 C.F.R. 1.183 and 1.943(b)” (the March 30, 2010 patent owner petition).
6. Also on March 30, 2010, the patent owner filed a request for a two-month extension of time to respond to the March 15, 2010 Office action.
7. On April 16, 2010, the Office mailed a decision granting in part patent owner’s March 30, 2010 request for extension of time, extending patent owner’s time period to respond to the March 15, 2010 Office action by one month.
8. On May 12, 2010, the Office mailed a decision granting the March 30, 2010 patent owner petition. The May 12, 2010 decision waived the page length requirements to the extent that patent owner’s response to the March 15, 2010 Office action not exceed 400 pages in length. The May 12, 2010 decision also sua sponte waived the page length requirements to the extent that any comments filed by the requester in response to patent owner’s response not exceed 400 pages in length.
9. On May 27, 2010, the patent owner filed a petition entitled “Petition to Vacate the Order Granting Reexamination.”
10. On June 10, 2010, the requester filed a petition paper entitled “Opposition Petition to Patent Owner’s Petition to Vacate the Order Granting Reexamination.”
11. On June 15, 2010, the patent owner timely filed a response to the March 15, 2010 Office action (the June 15, 2010 response). The response is 158 pages in length.
12. On June 25, 2010, the requester filed a petition entitled “Petition to Strike Patent Owner’s Response.”

13. On July 1, 2010, the patent owner filed a supplemental response to the March 15, 2010 Office action, which is apparently a substantial duplicate of the June 15, 2010 patent owner response, with the exception that the supplemental response corrects typographical and formatting errors found in claim amendment portion of the June 15, 2010 patent owner response, and includes an additional 5-page chart providing support for the claim amendments (the July 1, 2010 supplemental response).
14. On July 15, 2010 the requester filed a comments submission, including an 841-page comments section, a three-page declaration under 37 CFR 1.132 by Jeffrey Stein (the Stein declaration), and a 26-page declaration under 37 CFR 1.132 by Deborah I. McGuinness (the McGuinness declaration).
15. Also on July 15, 2010, the requester filed a petition entitled "Petition for Increase of Page Limit for Third Party Requester Comments Pursuant to 37 C.F.R. §§ 1.183 and 1.943(b)" (the July 15, 2010 requester petition).
16. On July 26, 2010, the requester filed a supplemental comments submission, including an 880-page comments section, and copies of the Stein and McGuinness declarations originally submitted on July 15, 2010.
17. Also on July 26, 2010, the requester filed a petition entitled "Petition for Increase of Page Limit for Third Party Requester Supplemental Comments Pursuant to 37 C.F.R. §§ 1.183 and 1.943(b)" (the July 26, 2010 requester petition).
18. On August 5, 2010, the patent owner filed an opposition paper entitled "Opposition Petition to Petitions for Increase of Page Limit for Third Party Requester Comments Pursuant to 37 C.F.R. §§ 1.182 and 1.943(b)" (the August 5, 2010 patent owner opposition).
19. On August 31, 2010, the patent owner filed a petition entitled "Petition to Strike Requester's Supplemental Response."
20. On September 13, 2010, the requester filed an opposition paper entitled "Opposition Petition to Patent Owner's Petition to Strike Requester's Supplemental Response."
21. On September 30, 2010, the Office mailed a decision on the third party requester's July 15, 2010 and July 26, 2010 petitions and the patent owner's August 5, 2010. The decision expunged the third party requester's comments of July 15, 2010 and July 26, 2010 and gave the requester's 15 days to supply a replacement comments.
22. On October 15, 2010, the third party requester submitted replacement comments.

### DECISION

As pointed out, the patent owner filed an August 31, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the July 26, 2010 supplemental comments. On September 30, 2010, Office mailed a decision, which addressed other petitions and found the July 26, 2010 supplemental comments to be improper papers. The decision expunged the July 26, 2010 supplemental comments from the proceeding record. Accordingly, the relief requested by the August 31, 2010 patent owner petition has already been granted. Thus, the patent owner's August 31, 2010 petition is moot, and thereby dismissed. The third party requester's September 13, 2010 opposition is dismissed for the same reasons the July 26, 2010 supplemental comments have been held to be improper papers as set forth in the September 30, 2010 decision.

### CONCLUSION

1. The August 31, 2010 patent owner petition is **dismissed as moot**.
2. The September 13, 2010 requester opposition petition is **dismissed**.
3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.



---

Irem Yücel, Director  
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,533	02/11/2010	7113919	ETPH-0015	4063
23377	7590	08/31/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ROBERT A. SALTZBERG  
MORRISON & FOERSTER LLP  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

Date:

**MAILED**

**AUG 31 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000533

PATENT NO. : 7113919

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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CIRA CENTRE, 12<sup>TH</sup> FLOOR  
2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

**MAILED**

**AUG 31 2011**

**CENTRAL REEXAMINATION UNIT**

MORRISON & FOERSTER  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

(For Third Party Requester)

*In re Norris et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,533  
Filed: February 11, 2010  
For: U.S. Patent No. 7,113,919

:  
: **DECISION DISMISSING**  
: **PETITION**  
:  
:

The patent owner paper, filed November 24, 2010, entitled "PETITION TO STRIKE AND EXPUNGE REQUESTER'S CORRECTED COMMENTS" and the third party requester's paper, filed December 8, 2010, entitled "OPPOSITION TO PATENT OWNER'S PETITION TO STRIKE AND EXPUNGE REQUESTER'S CORRECTED COMMENTS" are before the Director of Technology Center (TC) 1600, who oversees the Central Reexamination Unit. The petition and opposition are being treated as petitions under 37 CFR 1.181.

The patent owner's petition to strike is dismissed as premature.

The third party requester's opposition is dismissed as premature.

## BACKGROUND

1. On September 26, 2006, United States Patent No. 7,113,919 (“the ‘919 patent”) issued to Norris et al.
2. On February 11, 2010, a request for *inter partes* reexamination of the ‘919 patent was filed by a third party requester (requester), which request was assigned Reexamination Control No. 95/000,533 (the ‘533 proceeding).
3. On March 15, 2010, the Office mailed an order granting *inter partes* reexamination in the ‘533 proceeding.
4. Also on March 15, 2010, the Office mailed a non-final Office action on the merits in the ‘533 proceeding.
5. On March 30, 2010, the patent owner filed a petition under 37 CFR 1.183 entitled “Petition for Increase of Page Limit for Patent Owner’s Response Pursuant to 37 C.F.R. 1.183 and 1.943(b)” (the March 30, 2010 patent owner petition).
6. Also on March 30, 2010, the patent owner filed a request for a two-month extension of time to respond to the March 15, 2010 Office action.
7. On April 16, 2010, the Office mailed a decision granting in part patent owner’s March 30, 2010 request for extension of time, extending patent owner’s time period to respond to the March 15, 2010 Office action by one month.
8. On May 12, 2010, the Office mailed a decision granting the March 30, 2010 patent owner petition. The May 12, 2010 decision waived the page length requirements to the extent that patent owner’s response to the March 15, 2010 Office action not exceed 400 pages in length. The May 12, 2010 decision also *sua sponte* waived the page length requirements to the extent that any comments filed by the requester in response to patent owner’s response not exceed 400 pages in length.
9. On May 27, 2010, the patent owner filed a petition entitled “Petition to Vacate the Order Granting Reexamination.”
10. On June 10, 2010, the requester filed a petition paper entitled “Opposition Petition to Patent Owner’s Petition to Vacate the Order Granting Reexamination.”
11. On June 15, 2010, the patent owner timely filed a response to the March 15, 2010 Office action (the June 15, 2010 response). The response is 158 pages in length.
12. On June 25, 2010, the requester filed a petition entitled “Petition to Strike Patent Owner’s Response”.

13. On July 1, 2010, the patent owner filed a supplemental response to the March 15, 2010 Office action, which is apparently a substantial duplicate of the June 15, 2010 patent owner response, with the exception that the supplemental response corrects typographical and formatting errors found in claim amendment portion of the June 15, 2010 patent owner response, and includes an additional 5-page chart providing support for the claim amendments (the July 1, 2010 supplemental response).
14. On July 15, 2010 the requester filed a comments submission, including an 841-page comments section, a three-page declaration under 37 CFR 1.132 by Jeffrey Stein (the Stein declaration), and a 26-page declaration under 37 CFR 1.132 by Deborah I. McGuinness (the McGuinness declaration).
15. Also on July 15, 2010, the requester filed a petition entitled "Petition for Increase of Page Limit for Third Party Requester Comments Pursuant to 37 C.F.R. §§ 1.183 and 1.943(b)" (the July 15, 2010 requester petition).
16. On July 26, 2010, the requester filed a supplemental comments submission, including an 880-page comments section, and copies of the Stein and McGuinness declarations originally submitted on July 15, 2010.
17. Also on July 26, 2010, the requester filed a petition entitled "Petition for Increase of Page Limit for Third Party Requester Supplemental Comments Pursuant to 37 C.F.R. §§ 1.183 and 1.943(b)" (the July 26, 2010 requester petition).
18. On August 5, 2010, the patent owner filed an opposition paper entitled "Opposition Petition to Petitions for Increase of Page Limit for Third Party Requester Comments Pursuant to 37 C.F.R. §§ 1.182 and 1.943(b)" (the August 5, 2010 patent owner opposition).
19. On August 31, 2010, the patent owner filed a petition entitled "Petition to Strike Requester's Supplemental Response."
20. On September 13, 2010, the requester filed an opposition paper entitled "Opposition Petition to Patent Owner's Petition to Strike Requester's Supplemental Response."
21. On September 30, 2010, the Office mailed a decision on the third party requester's July 15, 2010 and July 26, 2010 petitions and the patent owner's August 5, 2010. The decision expunged the third party requester's comments of July 15, 2010 and July 26, 2010 and gave the requester's 15 days to supply a replacement comments.
22. On October 15, 2010, the third party requester submitted replacement comments.
23. On November 24, 2010, the patent owner submitted a petition entitled "Petition to Strike and Expunge Third Party Requester's Corrected Comments."

24. On December 8, 2010, the third party requester submitted an opposition to patent owner's November 24, 2010 petition.
25. To date, the examiner has not acted upon the October 15, 2010 replacement comments.

### DECISION

As pointed out, the patent owner filed a November 24, 2010 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the October 15, 2010 replacement comments. On December 8, 2010, requester filed an opposition to patent owner's November 24, 2010 petition. However, there has been no decision by the examiner if the requester's October 15, 2010 replacement comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the October 15, 2010 replacement comments because the examiner has not made his or her decision. Thus, the patent owner's November 24, 2010 petition and third party requester's December 8, 2010 opposition are premature, and they are dismissed.

### CONCLUSION

1. The November 24, 2010 patent owner petition is **dismissed as premature**.
2. The December 8, 2010 requester opposition petition is **dismissed as premature**.
3. Telephone inquiries related to this decision should be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.



---

Irem Yucel, Director  
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,534	02/11/2010	7,422,053	4352.02REX01	4641
27896	7590	11/23/2010	EXAMINER	
EDEL, SHAPIRO & FINNAN, LLC 1901 RESEARCH BOULEVARD SUITE 400 ROCKVILLE, MD 20850			ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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ATTN: BRADLEY J. THORSON  
4800 IDS CENTER, 80 SOUTH 8TH STREET  
MINNEAPOLIS, MN 55402-2100

Date:

**MAILED**

**NOV 23 2010**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000534  
PATENT NO. : 7422053  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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EDELL, SHAPIRO & FINNAN, LLC  
1901 RESEARCH BOULEVARD  
SUITE 400  
ROCKVILLE, MD 20850

(For Patent Owner)

**MAILED**

**NOV 23 2010**

PATTERSON, THUENTE, SHAAR  
& CHRISTENSEN, P.A.  
ATTN: BRADLEY J. THORSON  
4800 IDS CENTER  
80 SOUTH 8TH STREET  
MINNEAPOLIS, MN 55402-2100

(For Third Party Requester) **CENTRAL REEXAMINATION UNIT**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,534  
Filed: February 11, 2010  
For: U.S. Patent No. 7,422,053

:  
: **DECISION**  
: **DISMISSING**  
: **PETITIONS**  
:

This is a decision on third party requester's August 23, 2010 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182 TO SET ASIDE THE U.S.P.T.O.'S UNLAWFULLY PROMULGATED 'NEW TECHNICAL TEACHING RULE' AND TO VACATE AND REMAND THE INSTANT REEXAMINATION ORDER FOR A NEW DETERMINATION," and the concurrently filed petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND 37 C.F.R. 1.915(b)(3), THE 'NEW TECHNICAL TEACHING RULE' OF MPEP 2616, AND 37 C.F.R. § 1.939(a)."

The third party requester petitions are before the Office of Patent Legal Administration.

A petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to requester's credit card on August 24, 2010, and a petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 was also charged to requester's credit card on August 24, 2010.

The third party requester petitions under 37 CFR 1.182 and 1.183 are dismissed, for the reasons set forth herein.

## BACKGROUND

1. On September 9, 2008, United States Patent No. 7,422,053 ("the '053 patent") issued to Siu.

2. On February 11, 2010, a request for *inter partes* reexamination of claims 1-25 of the '053 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/000,534 ("the '534 proceeding").
3. On April 26, 2010, the Office issued an order in the '534 proceeding granting *inter partes* reexamination of claims 8, 11-17, and 22 of the '053 patent, accompanied by a non-final Office action on the merits.<sup>1</sup>
4. On May 26, 2010, third party requester filed a petition under 37 CFR 1.181 requesting supervisory review of the examiner's determination that the request for *inter partes* reexamination failed to establish a substantial new question of patentability (SNQ) for claims 1-7, 9-10, 18-21, and 23-25 of the '053 patent.
5. On June 23, 2010, the Office issued a decision denying third party requester's May 26, 2010 petition under 37 CFR 1.181.
6. On August 23, 2010, third party requester filed the following petition papers:
  - (1) "PETITION UNDER 37 C.F.R. § 1.182 TO SET ASIDE THE U.S.P.T.O.'s UNLAWFULLY PROMULGATED 'NEW TECHNICAL TEACHING RULE' AND TO VACATE AND REMAND THE INSTANT REEXAMINATION ORDER FOR A NEW DETERMINATION" ("the instant petition under 37 CFR 1.182");
  - (2) "PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND 37 C.F.R. 1.915(b)(3), THE 'NEW TECHNICAL TEACHING RULE' OF MPEP 2616, AND 37 C.F.R. § 1.939(a)" ("the instant petition under 37 CFR 1.183"); and
  - (3) "PETITION UNDER 37 C.F.R. § 1.181(a)(3) FOR SUPERVISORY REVIEW OF THE DECISION OF CRU DIRECTOR GREGORY MORSE DENYING MICROLOOPS' PETITION UNDER 37 C.F.R. § 1.927" ("the petition under 37 CFR 1.181").

## DECISION

### I. Relevant Authority

35 U.S.C. § 312 provides:

(a) REEXAMINATION.— Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

---

<sup>1</sup> No patent owner response was filed on or before the July 26, 2010 due date. See June 22, 2010 "Decision Granting Petition For Extension of Time [37 CFR 1.956(c)]."



(b) RECORD.— A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.

(c) FINAL DECISION.— A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the *inter partes* reexamination fee required under section 311.

37 CFR 1.181(a) provides:

Petition may be taken to the Director:

- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
- (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.915(b) provides:

A request for *inter partes* reexamination must include the following parts:

- (1) An identification of the patent by patent number and every claim for which reexamination is requested.

- (2) A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.
- (3) A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.

37 CFR 1.927 provides:

The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing to order *inter partes* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

37 CFR 1.939 provides:

- (a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.
- (b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

## II. Third Party Requester Petition Under 37 CFR 1.182

On page 5 of the instant petition under 37 CFR 1.182, third party requester petitions for the following relief:

1. That the Office withdraw and set aside its "New Technical Teaching Rule," unlawfully promulgated in MPEP 2616 in the July 2008 revision of the MPEP.
2. That the Determination and Order for reexamination and the Non-Final Office Action issued in this case on April 26, 2010, be vacated in their entirety, as they were decided using the unlawful "New Technical Teaching Rule."
3. That the instant reexamination Request be remanded to the Central Reexamination Unit ("CRU") for a new determination as to the existence of SNQs relative to the subject patent based on the entirety of the "Statement Pointing Out Substantial New Question of Patentability" contained in Microloops' Request at pages 17-56.
4. That the CRU be instructed upon remand to refrain from application of the "New Technical Teaching Rule" to ignore arguments presented in Microloops' SNQ statement, but instead to consider all arguments presented in the Request, to consider whether there is "a substantial likelihood that a reasonable examiner would consider [each] prior art patent or printed

publication important in deciding whether or not the [subject claim] is patentable," and to order reexamination of the subject claim if the answer to that inquiry is in the affirmative.

35 U.S.C. 312(c) provides that "[a] determination by the Director under subsection (a) shall be final and non-appealable." Petitioner cannot circumvent that provision of the statute by filing the present petition. Any request to re-address the June 23, 2010 Office decision denying third party requester's May 26, 2010 petition under 37 CFR 1.181 is barred by statute. Requester may, however, file a new request for reexamination of claims 1-7, 9-10, 18-21, and 23-25 of the '053 patent with an explanation of the new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application, and an application of the art to the claims, if a proper a substantial new question of patentability affecting any claim of the '053 patent can be raised.

In addition, in this instance, the requester has concurrently pursued an alternative avenue of relief via a 37 CFR 1.181 petition. The relief requested in the present petition under § 1.182 would be moot, should relief be granted under § 1.181. Since the matter is in the process of being addressed through § 1.181, consideration of this situation under § 1.182 would be premature, even if there were a statutory basis to re-address the June 23, 2010 Office decision denying third party requester's May 26, 2010 petition under 37 CFR 1.181.

Accordingly, the instant petition under 37 CFR 1.182 is dismissed.

### **III. Third Party Requester Petition Under 37 CFR 1.183**

On page 6 of the instant petition under 37 CFR 1.183, third party requester petitions for the following relief:

1. That the Office suspend 37 CFR 1.915(b)(3), to the extent it is interpreted by the Office as including the requirements of the "New Technical Teaching Rule."
2. That the Office suspend the "New Technical Teaching Rule" promulgated in the July 2008 revision to the MPEP.
3. That the Office suspend 37 CFR 1.939 to the extent the Office deems it necessary to enable consideration of Microloops' petitions under 37 C.F.R. §§ 1.181(a)(3) and 182, filed on even date herewith.

With respect to the request for waiver of 37 CFR 1.939, which prohibits unauthorized papers in *inter partes* reexamination, for entry and consideration of the concurrently filed petition under 37 CFR 1.181, as pointed out above, 35 U.S.C. 312(c) provides that the determination by the CRU Director is final and non-appealable. Petitioner cannot circumvent that provision of the statute by filing the present petition. Since any request to re-address the June 23, 2010 Office decision denying third party requester's May 26, 2010 petition under 37 CFR 1.181 is barred by statute, waiver of 37 CFR 1.939 cannot be provided.

It is also noted that 37 CFR 1.183 provides that “[i]n an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party...” (emphasis added by underlining). 37 CFR 1.915(b)(3) cannot be waived to the extent that it promulgates a requirement of the statute – in this instance, 35 U.S.C. § 312(a). 35 U.S.C. § 312(a) provides that “the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.” To implement this statute, 37 CFR 1.915(b)(3) provides that a request for *inter partes* reexamination must include “[a] statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.” The Office was given jurisdiction in 1999 to conduct *inter partes* reexamination of a patent when prior patents or printed publications in a request for reexamination raise a “substantial new question of patentability” by presenting to the Office new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application and any subsequent proceeding involving the resulting patent. Therefore, it is a fundamental statutory requirement that every request for reexamination of a patent include a detailed statement as to the cited prior patents and printed publications that explains the new technological teachings it provides that were not previously considered by the Office, and are not cumulative to teachings previously considered by the Office.

With respect to the request for waiver of the July 2008 revision of the MPEP, 37 CFR 1.183 permits waiver of any requirement of the regulations in this part in an extraordinary situation when justice requires. The MPEP is not a rule in Title 37 of the Code of Federal Regulations.<sup>2</sup> Accordingly, 37 CFR 1.183 is inapplicable to waiver of an examination procedure set forth in the MPEP. In this instance, the MPEP is merely explaining the statutory requirement for raising a substantial new question of patentability as to patent claims.

For the foregoing reasons, the instant petition under 37 CFR 1.183 is dismissed.

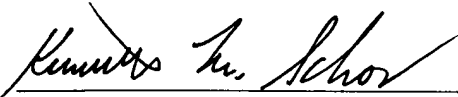
### CONCLUSION

1. Third party requester’s August 23, 2010 petition under 37 CFR 1.182 is dismissed.
2. Third party requester’s August 23, 2010 petition under 37 CFR 1.183 is dismissed.
3. Requester may file a new request for reexamination of claims 1-7, 9-10, 18-21, and 23-25 of the ‘053 patent, with an explanation of the new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application, and an application of the art to the claims, if a proper substantial new question of patentability affecting any claim of the ‘053 patent can be raised.

---

<sup>2</sup> See MPEP at Forward (stating “the MPEP contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application.”)

4. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.

A handwritten signature in black ink, appearing to read "Kenneth M. Schor", is written over a horizontal line.

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

11-23-10  
Kenpet8/deny or grant reex



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,534	02/11/2010	7,422,053	4352.02REX01	4641
27896	7590	03/23/2011	EXAMINER	
EDEL, SHAPIRO & FINNAN, LLC 1901 RESEARCH BOULEVARD SUITE 400 ROCKVILLE, MD 20850			ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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ATTN: BRADLEY J. THORSON  
4800 IDS CENTER, 80 SOUTH 8TH STREET  
MINNEAPOLIS, MN 55402-2100

Date: **MAILED**

**MAR 23 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000534  
PATENT NO. : 7422053  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Suite 400  
Rockville, MD 20850

(For Patent Owner)

MAILED

MAR 23 2011

CENTRAL REEXAMINATION UNIT

Patterson, Thuente, Skaar & Christensen, P.A.  
Attn: Bradley J. Thorson  
4800 IDS Center, 80 South 8<sup>th</sup> Street  
Minneapolis, MN 55402-2100

(For Requester)

In re Siu  
Reexamination Proceeding  
Control No. 95/000,534  
Filed: February 11, 2010  
For: U.S. Patent No. 7,422,053

:  
: **DECISION ON**  
: **PETITION**  
: **(37 CFR 1.927)**  
:

The paper filed by requester on August 23, 2010, styled as "Petition Under 37 CFR § 1.181(a)(3) for Supervisory Review of the Decision of CRU Director Gregory Morse Denying Microloops' Petition Under 37 CFR § 1.927" is before the Group Director overseeing the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the CUR Director's decision, mailed June 23, 2010, denying a petition filed under 37 CFR § 1.927. Specifically, petitioner requests that the decision of the CRU Director be vacated and the petition remanded to an appropriate official to be decided or, alternatively, to vacate the reexamination order and non-final Office action issued in the 95/000,534 reexamination and remand the matter to the CRU for a new determination by a different examiner.

The petition is denied for the reasons set forth below.



### REVIEW OF FACTS

1. The '053 patent issued on September 9, 2008. The '053 patent is a continuation of application no. 10/390,773, filed March 9, 2003, which is now abandoned.
2. On February 11, 2010, the third party requested deposited a request for *inter partes* reexamination, and the resulting reexamination proceeding was assigned Control No. 95/000,534 (hereinafter, the '534 proceeding).
3. Reexamination was requester for claims 1-25 of the '053 patent.
4. A Notice of Reexamination Request Filing Date was issued on March 8, 2010.
5. An order granting the request for reexamination for claims 8, 11-17 and 22 was issued on April 26, 2010.
6. On May 26, 2010, the third party requested filed a petition under 37 CFR § 1.927.
7. On June 23, 2010, a decision was mailed denying the petition filed May 26, 2010.
8. On August 23, 2010, the third party requester filed the instant petition under 37 CFR § 1.181(a)(3).

### Petitioner's Grounds in Support of the Requested Relief

Petitioner advances the following grounds in support of his position that the denial of the petition filed June 23, 2010 should be reversed by the Group Director:

1. Petitioner argues that the CRU Director refused to consider all Substantial New Questions of Patentability (SNQs) presented in the request.
2. Petitioner argues that the CRU Director failed to address issues raised by the examiner's use of an incorrect standard for assessing SNQs.
3. Petitioner argues that the CRU Director failed to address obvious logical errors in the examiner's determination.

## DECISION

### I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The Group Director's review on petition is *de novo*. Therefore, the review will determine whether the CRU Director's decision in the decision mailed June 23, 2010 was proper.

### II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." Questions relating to grounds of rejection other than those based on prior art patents or printed publications should **not** be included in the request and will not be considered by the examiner if included. A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,<sup>1</sup> Congress stated:

“Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application.** H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462.” [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office’s conclusion based on that old information was erroneous.

In accordance with this legislative history, MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be “presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request.” This new light must be in terms of how to interpret the state of the “pre-existing technology,” as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a “new light” if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

### III. Analysis of the Request for Reexamination

The following is repeated from the June 23, 2010 petition decision, as the Group Director concurs with the decision of the CRU Director.

A. The request fails to raise a substantial new question of patentability regarding claims 1-7, 9-10, 18-21 and 23-25 of the ‘053 patent. The examiner appropriately applied the provisions of the MPEP, specifically MPEP 2640, in deciding whether or not an SNQ exists. For example, regarding Japanese Patent App. Pub. No.

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<sup>1</sup> Public Law 96-517, enacted on December 12, 1980.

H07-208884 (hereinafter "JP 884"), the examiner correctly noted that all of claims 1, 5, 6, 19 and 21 include the "wicking power limitation" (see paragraph 2b of the order granting reexamination) and that requester, in the request, discussed the claim interpretation of "wicking power", suggesting that it may be reasonably interpreted as "a structure having an increased quantity of wicking material or the ability to exert capillary force (see pages 27-29 and chart A of the request and paragraph 2bi of the order granting reexamination). The examiner then correctly notes that requester was suggesting that the wicking structure of JP 884 has an increased wicking power in the evaporation region because of the presence of the centermost first wick (see paragraphs 2bi and 2bii of the order granting reexamination). The examiner then correctly analyzes this proposal of requester's noting that "it is unclear how the centermost first wick 13, by itself, can be considered to be in the evaporation area. Since there is a layer of a material (second wick 14) having a relatively weak capillary force between the layer having a stronger capillary force (first wick 13) and the evaporation region 11a. . ." (see paragraph 2biv of the order granting reexamination). The examiner then correctly concludes that it is unclear how JP 884 discloses the wicking power limitation (see paragraph 2biv of the order granting reexamination).

The examiner then goes on to correctly state that requester suggests that JP 884 raises an SNQ because it meets the wicking power limitation (see paragraph 2bvii of the order granting reexamination). The examiner then correctly notes that U.S. Patent No. 6,460,612 to Sehmbe (hereinafter "Sehmbe"), which was considered and applied during the previous reexamination, teaches the wicking power limitation (see paragraphs 2bv and 2bvii of the order granting reexamination). Accordingly, the examiner correctly concludes that it has not been demonstrated that JP 884 presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record (see paragraph 2bvii of the order granting reexamination). The examiner correctly applied MPEP 2616. The examiner's analysis of the prior art presented by the requester was sound and without error. Requester's argument that the examiner's substitution of "one skilled in the art" for "reasonable examiner" in the syntax of the decision resulted in a fatal error in the examiner's analysis is thus faulty. There is no indication from the record that the examiner was applying a "prima facie case of unpatentability" standard in determining whether an SNQ exists. Accordingly, the examiner appropriately denied the request for reexamination for claims 1-7, 9-10, 18-21 and 23-25.

Petitioner advances that the CRU Director did not consider all SNQs presented in the request. It is assumed that requester makes this argument based upon the above review, which notes a particular reference (JP 884) and its analysis by the examiner. However, as required by the rules, a review of the entire record was conducted. The above example was intended as just that: an example of the

examiner's correct determination of the record. Petitioner should not assume that the record was not reviewed in its entirety just because an example was given by the CRU Director pertaining to one of the cited references. As to petitioner argument that the CRU Director did not address issues raised by the examiner's use of an incorrect standard for assessing SNQs, as noted in the previous decision, this is not an issue for consideration in a petition filed under 37 CFR § 1.181. Instead, it is an issue for consideration in a petition filed under either/both 37 CFR § 1.182 and 37 CFR § 1.183. As petitioner has filed both a petition under 1.182 and a petition under 1.183 concurrently with the instant petition, petitioner will received due consideration of this argument. As to petitioner's argument that the CRU Director did not address obvious logical errors in the examiner's determination, this argument is addressed above by the Group Director's determination that the examiner did indeed decide the issue of whether an SNQ exists correctly.

### REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *inter partes* reexamination of the '053 patent, requester may wish to consider filing a new and complete request for *inter partes* reexamination, (which new request includes the missing information identified above). This decision is without prejudice to the right of the requester to file a new request for reexamination to address the issues noted. The requester is not barred from filing a new request for *inter partes* reexamination as argued by the petitioner because the estoppel provision of 35 U.S.C. 317(b) to not attach since the reexamination has not been instituted. The request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in the '534 proceeding.

The requester can file a new request for *inter partes* reexamination and provide an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.915(b)(3). Each substantial new question of patentability or proposed ground of rejection ("SNQ/proposed rejection") must be identified separately. The patent claims applying to each identified SNQ/proposed rejection must be listed. Then, for each identified SNQ/proposed rejection, the request must explain how the cited documents identified for that SNQ/proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified SNQ/proposed rejection. Where references are applied in combination, each combination must be individually identified, and the basis for forming the identified combination of references must be supplied.

### CONCLUSION

1. Given the facts involved in this proceeding, the request for *inter partes* reexamination of claims 1-7, 9-10, 18-21 and 23-25 of the '053 patent is denied.
2. Accordingly, the PETITION is DENIED.
3. A partial refund of the filing fee for the request for reexamination will be made to the third party requester in due course. See 35 U.S.C. 312(c) and 37 CFR 1.26(c).
4. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Special Program Examiner, at (571) 272-4361, or in their absence to the undersigned at (571) 272-1596.



---

Irem Yucel, Director  
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,534	02/11/2010	7,422,053	0375.0001L	4641
27896	7590	03/30/2012	EXAMINER	
EDEL, SHAPIRO & FINNAN, LLC 1901 RESEARCH BOULEVARD SUITE 400 ROCKVILLE, MD 20850			ART UNIT	PAPER NUMBER

DATE MAILED: 03/30/2012

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ATTN: BRADLEY J. THORSON  
4800 IDS CENTER, 80 SOUTH 8TH STREET  
MINNEAPOLIS, MN 55402-2100

Date:

**MAILED**

**MAR 30 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000534  
PATENT NO. : 7422053  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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Rockville, MD 20850

(For Patent Owner)

**MAILED**

**MAR 30 2012**

Patterson, Thunte, Skaar & Christensen, P.A.  
4800 IDS Center  
80 South 8<sup>th</sup> Street  
Minneapolis, MN 55402

(For Requester)

**CENTRAL REEXAMINATION UNIT**

*In re* Siu  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,534  
Filed: February 11, 2010  
For: U.S. Patent No. 7,422,053

:  
: **DECISION**  
: **DISMISSING PETITION**  
: **AS MOOT**  
:

This is a decision on the February 9, 2012 petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE 37 C.F.R. 1.953(c) TO ENABLE ENTRY OF PATENT OWNER'S AMENDMENT CANCELLING ALL LIVE CLAIMS IN THIS PROCEEDING." The instant petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

In this instance, petitioner requests waiver of 37 CFR 1.953(c) to enable entry of the patent owner's amendment filed on August 3, 2011, cancelling all of the claims subject to reexamination in the instant proceeding. In view of the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) issued by the Office on March 29, 2012, entering patent owner's August 3, 2011 claim amendment, the instant petition under 37 CFR 1.183 is dismissed as moot.

*Pinchus M. Laufer*

Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

03-30-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,538	02/17/2010	6374289	9843-2027	7327
758	7590	10/05/2011	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			ART UNIT	PAPER NUMBER

DATE MAILED: 10/05/2011

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4 PARK PLAZA, SUITE 1600  
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Date:

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**OCT 05 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000538  
PATENT NO. : 6374289  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Fenwick & West  
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801 California Street  
Mountain View, CA

: (For Patent Owner)

MAILED

OCT 05 2011

CENTRAL REEXAMINATION UNIT

Orrick, Herrington, & Sutcliffe, LLP  
IP Prosecution Department  
4 Park Plaza, Suite 1600  
Irvine, CA 92614-2558

: (For Third Party Requester)

*In re Delaney et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,538  
Filed: February 17, 2010  
For: U.S. Patent No. 6,374,289

:  
: **DECISION**  
: **DISMISSING PETITION**  
: **UNDER 37 C.F.R. § 1.182**  
:

This is a decision on the July 1, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 FOR CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

## BACKGROUND

- On February 17, 2010, a request for *inter partes* reexamination of claims 1, 3, 4, 5, 9, 15, 16, 19, 20, 22, and 23 of U.S. Patent Number 6,374,289, having 23 claims, was deposited by the third party requester. The resulting reexamination proceeding was assigned control number 95/000,538 ("the '538 proceeding").
- On March 26, 2010, reexamination was ordered.
- On April 1, 2010, an Office action rejecting claims 1, 3, 4, 5, 9, 15, 16, 19, 20, 22, and 23 was issued. The Office action set forth a 2 month period for patent owner's response.
- On June 1, 2010, patent owner submitted a response addressing the April 1, 2010 Office action. No claim amendments were made.

- On December 21, 2010, an Office action rejecting claims 1, 3, 4, 5, 9, 15, 16, 19, 20, 22, and 23 was issued. The Office action set forth a 2 month period for patent owner's response.
- On February 16, 2011, patent owner submitted a response addressing the December 21, 2010 Office action. No claim amendments were made.
- On June 3, 2011, an Action Closing Prosecution (ACP) was issued, rejecting claims 1, 3, 4, 5, 9, 15, 16, 19, 20, 22, and 23, and confirming claim 15.
- On June 1, 2011, patent owner filed the following papers:
  - A paper entitled "RESPONSE TO ACTION CLOSING PROSECUTION," which includes proposed new claims 24-33. All of the remaining original patent claims remain unamended.
  - The instant petition entitled "PETITION UNDER 37 CFR § 1.182 FOR CONTINUED REEXAMINATION," requesting entry of the amendment and remarks filed on the same date.

## **RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE**

### **37 C.F.R. § 1.182 provides:**

All **situations not specifically provided** for in the regulations of this part will be decided in **accordance with the merits** of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

### **37 C.F.R. § 1.181 provides, in pertinent part:**

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

### **37 C.F.R. § 1.951(a) provides:**

After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to

whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

## DECISION

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."<sup>1</sup> Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances. Any action by the Office in an *inter partes* reexamination proceeding, including action taken in response to a petition under § 1.182, must be consistent with its mandate under 35 U.S.C. 314 that reexamination proceedings must be conducted "with special dispatch within the Office."

### 1. Other Avenues For Seeking Entry of the Claim Amendments Are Available

37 C.F.R. § 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, § 1.182 is not, according to the terms of the regulation, the appropriate mechanism for relief. 37 C.F.R. § 1.951(a) provides for the entry of comments and amendment after an ACP during the 1 month time period set for response in the ACP, subject to the criteria of 37 C.F.R. § 1.116. Since patent owner's submission may be addressed through § 1.951, i.e., relief is still possible under one of the rules of practice, consideration of the present petition under 37 C.F.R. § 1.182 is premature.

The July 1, 2011, patent owner petition is filed under 37 C.F.R. § 1.182 requesting entry of amendments and remarks submitted on the same date therewith. As of the time of filing the petition under 37 C.F.R. § 1.182, the Office had not yet rendered a decision on the entry of the submission under 37 C.F.R. § 1.951(a), or under any other applicable section. Since the Office has not denied entry of the submission, the request for continuation of prosecution fails "to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution," as required for the procedure set forth in the March 2005 Notice.

For the instant petition to be proper for consideration and not premature, the instant petition must be filed (1) after the time for response under 37 C.F.R. § 1.951, (2) after entry of the amendment

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<sup>1</sup> 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

has been denied by the examiner in an action, and (3)(a) without a petition under 37 C.F.R. § 1.181 that could moot the petition under 37 C.F.R. § 1.182, or (3)(b) after, within two months after, such a petition is dismissed (and reconsideration is not requested) or denied. Since other avenues for entry of the amendment exist under the regulations, relief under § 1.182 which is designed for situations not otherwise provided for would not be appropriate under the facts and circumstances of the instant proceeding.

## 2. The Amendment Must Advance, Not Delay, the Proceeding

Patent owner's petition does not does not present persuasive reasons why the Office should act to delay the proceeding in spite of its statutory mandate to handle reexamination proceedings with special dispatch. In accordance with the special dispatch requirement on the Office's handling of the proceeding, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate.

Patent owner's arguments, in the instant petition, are that that the ACP included new arguments and that the examiner has not previously fully addressed the issues raised by petitioner in response to the examiner's rejections.

With respect to the first rationale that the ACP included new rejections for the first time for which patent owner should have a chance to respond through entry of claim amendments by reopening of prosecution, such rationale is not persuasive. Although the ACP included new rejections, patent owner's proposed amendment is not alleged to address only those new rejections (with an explanation of how they are addressed) and thereby simplify and advance the proceeding. Patent owner does not propose to amend the two patent claims for which new rejections were applied in the ACP; thus, entry of the proposed amendments would not act to reduce or simplify any issues currently in the proceeding. Furthermore, the proposed amendment adds new claims, introducing new issues into this proceeding, while retaining the claims under rejection without change.

With respect to the second rationale, that the examiner has not fully addressed issues raised by petitioner, such rationale is not persuasive as to relief under § 1.182. This rationale goes towards whether a specific action taken by an examiner, not related to the substantive merits of a claim, was proper in this proceeding. Such an argument is addressable by a petition under § 1.181, and is therefore not addressable in a petition under § 1.182.

On balance, entry of the proposed amendment would not act to define the issues for appeal, or the issuance of a reexamination certificate. For this reason also, action by the Office to reopen the prosecution under § 1.182 would not be in furtherance of the Office's handling of the proceeding with special dispatch, and thus would not be appropriate under the facts and circumstances of the instant proceeding.

In summary, relief under § 1.182 is inappropriate as (1) the situation is not one that is "not

specifically provided for” as required under § 1.182, and (2) Office action to grant such relief would have the effect of adding new issues, yet not resolving the current issues, such that the proceeding would in the aggregate be delayed rather than advanced by entry of the desired amendment and subsequent reopening of prosecution in the reexamination proceeding. Accordingly, the petition is dismissed.

### CONCLUSION

1. The instant petition under 37 C.F.R. § 1.182 is dismissed.
2. Prosecution is not being reopened by this decision.
3. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan  
Legal Advisor  
Office of Patent Legal Administration

October 4, 2010





# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,542	04/15/2010	7,591,844 B2	512868-1035	8264
45511	7590	10/21/2010	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 10/21/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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WOODCOCK WASHBURN LLP  
CIRA CENTRE, 12TH FLOOR  
2929 ARCH STREET  
PHILADELPHIA, PA 19104-2891

(For Patent Owner)

WILLIAM F. LAWRENCE, ESQUIRE  
FROMMER LAWRENCE & HAUG LLP  
745 FIFTH AVENUE  
NEW YORK, NY 10151

(For Third Party Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filing Date: April 15, 2010  
For: U.S. Patent No. 7,591,844

: **DECISION**  
: **DISMISSING**  
: **PETITION**  
:

This is a decision on the August 30, 2010 patent owner petition entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)."

The patent owner petition is before the Office of Patent Legal Administration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 has been paid.

The petition is dismissed as moot.

### REVIEW OF THE RELEVANT FACTS

1. On September 22, 2009, United States Patent Number 7,591,844 (the '844 patent) issued.
2. On April 15, 2010, a request for *inter partes* reexamination of the '844 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/000,542 ("the '542 proceeding").
3. On June 30, 2010, the Office issued an order granting *inter partes* reexamination in the '542 proceeding, with an accompanying Office action on the merits.

MAILED  
OCT 21 2010  
CENTRAL REEXAMINATION

4. On August 30, 2010, patent owner filed the instant petition entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)." Patent owner concurrently filed a timely response to the Office action.
5. On September 29, 2010, the third party requester timely filed comments after patent owner's response.

## **DECISION**

### **37 CFR 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

### **37 CFR 1.943(b) provides:**

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### **MPEP 2667(I), provides in pertinent part:**

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count

## **I. Patent Owner's Petition**

In the instant petition, patent owner requests suspension of 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner response to the June 30, 2010 non-final Office action, and

requests that “the page limit for Patent Owner’s response be increased to an amount sufficient to include both the 24-page response and any pages from the Mikos Declaration that the Office determines should be counted against the 50-page limit.”<sup>1</sup> In support of its request for waiver of the rule, patent owner argues that “the Office Action sets forth 11 separate outstanding grounds for rejection under 35 U.S.C. § 102 (based on seven different references, supported by an additional five references).” Patent owner further argues that “the Declaration is needed not only to address technical issues that are raised by the rejections and the prior publications upon which they are based, but also to provide a full and complete story of the claimed inventions in the context of the relevant technical field.”<sup>2</sup>

## II. Analysis and Findings

The present petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. In this instance, the petitioner has made a showing in support of its request for waiver of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the response entitled “Patent Owner’s Response Pursuant to 37 C.F.R. §1.945” on August 30, 2010.

The August 30, 2010 patent owner response is accompanied by ten exhibits and by the declaration of Antonios Mikos. The response includes a “Remarks” section that consists of 23 pages. This results from the fact that the following sections of the response are not included in the page limit count: the cover page, the three pages of claim appendices, and the certificate of service page.

The declaration of Mikos comprises 40 pages. It is noted that, any portion of an affidavit/declaration that does not strictly adhere to presenting and explaining the evidence is subject to the 50-page limit of 37 CFR 1.943(b). Thus, opinion evidence that goes beyond explaining the evidence - legal arguments, e.g. assertions of obviousness and anticipation, are counted as remarks, and are thus part of the 50-page limit of 37 CFR 1.943(b). Of these 40 pages of the Mikos declaration, 24 pages contain legal argument and thus are counted toward the page limit. Examples of legal arguments in the Mikos declaration, which are not exhaustive, that count toward the page limit are: On page 9, declarant states: “...there was no reason or motivation for a person of ordinary skill in the art to combine the cited prior art to make the inventions of claims 1-24 of the ‘844 patent.” On page 10, declarant states: “To the contrary, the ordinary skilled person reading Lo would have been led in a direction far removed from the medical applications claimed in the ‘844 Patent...”<sup>3</sup>

The August 30, 2010 submission’s ten exhibits that do not contain any legal arguments do not count toward the page limit.

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<sup>1</sup> Petition at page 1.

<sup>2</sup> Petition at page 2.


<sup>3</sup> Other examples of legal arguments are on pages 11, 12, 15, and 20-38.

Therefore, a total of 47 pages of the patent owner response are counted toward the page-limit, which is within the 50 page limit of 37 CFR 1.943(b).

Accordingly, patent owner's petition under 37 CFR 1.183 is **dismissed as moot**, as the response of August 30, 2010 to the June 30, 2010 non-final Office action is page-length compliant.

### CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is **dismissed as moot**, as patent owner's August 30, 2010 response to the June 30, 2010 non-final Office action is page-length compliant.
2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

Kenpet8  
10-21-2010



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,542 ; 95/000,552 45511	04/15/2010  7590 11/26/2010	7,591,844 B2	CRDS-0116	8264
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
EXAMINER				
ART UNIT			PAPER NUMBER	

DATE MAILED: 11/26/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE  
10th FLOOR  
NEW YORK, NY 10151

Date:

**MAILED**

**NOV 26 2010**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000542 ; 95/000,552  
PATENT NO. : 7591844  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Woodcock Washburn LLP  
Cira Centre, 12<sup>th</sup> Floor  
2929 Arch Street  
Philadelphia, Pennsylvania 19104-2891

(For Patent Owner)

**MAILED**

**NOV 26 2010**

**CENTRAL REEXAMINATION UNIT**

William F. Lawrence, Esquire  
Frommer Lawrence & Haug LLP  
745 Fifth Avenue  
New York, New York 10151

(For 95/000,542 Requester)

Mark D. Sweet  
Finnegan, Henderson, Farabow,  
Garrett & Dunner  
901 New York Avenue N.W.  
Washington, DC 20001-4413

(For 95/000,552 Requester)

In re Llanos et al  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No. 7,591,844

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: **DECISION,**  
: ***SUA SPONTE,***  
: **MERGING**  
: ***INTER PARTES***  
: **PROCEEDINGS**  
:  
:  
:

In re Llanos et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 CFR 1.989 at this time.



## REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 7,591,844 (the '844 patent) issued to Llanos et al. on September 22, 2009, with 24 claims.
2. A first request for *inter partes* reexamination, assigned Reexamination Control No. 95/00,542 ('542 proceeding), was filed by a third party requester on April 15, 2010. Boston Scientific SCIMED, Inc is identified as the real party in interest.
3. A second request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,552 ('552 proceeding), was filed by another third party requester on June 14, 2010. Abbott Laboratories is identified as the real party in interest.
4. On June 30, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '542 reexamination proceeding. An Office action containing at least one rejection of each of claims 1-24 of the '844 patent in the '542 reexamination proceeding was mailed on the same date.
5. On August 25, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '552 reexamination proceeding.
6. On August 30, 2010, patent owner timely filed a response to the Office action in the '542 proceeding, retaining original patent claims 1-24 as unamended.
7. On September 29, 2010, third party requester timely filed comments in the '542 proceeding, pursuant to 37 CFR 1.947.
8. To date, no Office action has been mailed, and no amendments to the claims have been made in the '552 *inter partes* reexamination proceeding.

## PERTINENT AUTHORITY

### 35 U.S.C. § 314(c) states:

SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office. (emphasis added)

### 37 CFR 1.989 states, in pertinent part:

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the

merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

**MPEP 2682.01(IV) states, in pertinent part:**

Pursuant to 35 U.S.C. 314(c), “[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section...shall be conducted with special dispatch within the Office.” This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory “special dispatch” requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster “special dispatch.” The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis. (emphasis added)

## DECISION

### I. MERGER OF PROCEEDINGS

As evidenced by the above review of facts, both the ‘542 and the ‘552 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the ‘542 and ‘552 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the ‘542 and ‘552 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

## II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

### B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "Inter Partes Reexam"  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP 2666.01, which in turn references the guidelines of MPEP 2250.

37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

#### E. Citation of Patents and Printed Publications:

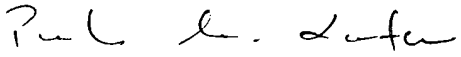
Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

#### F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,542 and *inter partes* Reexamination Control No. 95/000,552 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Susy Tsang-Foster, at (571) 272-7711, or in her absence, to the undersigned at (571) 272-7726.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

November 24 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 14 2011

CENTRAL REEXAMINATION UNIT

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No. 7,591,844

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: **DECISION**  
: **DISMISSING**  
: **PETITIONS**

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

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This is a decision on the patent owner paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURUANT TO 37 CFR §§ 1.183 AND 1.943(b)," filed on March 21, 2011. This is also a decision on the 95/000,552 third party requester's paper entitled "PETITION SEEKING WAIVER OF 37 CFR § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947," filed on April 20, 2011.

The patent owner petition under 37 CFR 1.183 and the 95/000,552 third party requester's petition, which is also a petition under 37 CFR 1.183, are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are dismissed for the reasons set forth herein.

### BACKGROUND

1. U.S. Patent Number 7,591,844 (the '844 patent) issued to Llanos *et al.* on September 22, 2009, with claims 1-24.
2. A first request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,542 (the '542 proceeding), was filed by a first third party requester (the '542 requester) on April 15, 2010. Boston Scientific SCIMED, Inc (Boston Scientific) is identified as the real party in interest.
3. A second request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,552 (the '552 proceeding), was filed by a second third party requester (the '552 requester) on June 14, 2010. Abbott Laboratories (Abbott) is identified as the real party in interest.
4. On June 30, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '542 reexamination proceeding, and was accompanied by a non-final Office action.
5. On August 25, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '552 reexamination proceeding.
6. On November 26, 2010, the Office mailed a decision, *sua sponte*, merging the '542 and the '552 *inter partes* reexamination proceedings (the merged proceeding).
7. On January 21, 2011, the Office mailed a non-final Office action in the merged proceeding.
8. On March 21, 2011, patent owner filed the instant "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§ 1.183 AND 1.943(b)" (patent owner's petition under 37 CFR 1.183), concurrently with a "PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §1.945" (patent owner's response submission).
9. On April 20, 2011, the '542 requester Boston Scientific filed "THIRD-PARTY REQUESTER BOSTON SCIENTIFIC'S SECOND COMMENTS UNDER 37 C.F.R. § 1.947" (Boston Scientific's comments submission).
10. Also on April 20, 2011, the '552 requester Abbott filed the instant "PETITION SEEKING WAIVER OF 37 CFR § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947" (Abbott's petition under 37 CFR 1.183), concurrently with "COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947" (Abbott's comments submission).

## DECISION

### I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Patent Owner's March 21, 2011 Petition under 37 CFR 1.183

On March 21, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed response submission. Patent owner asserts that the March 21, 2011 response submission is 42 pages long, excluding the listing of claims.<sup>1</sup> Patent owner further asserts that "[a]ccompanying the response is a Declaration of Antonios G. Mikos, Ph.D., which presents testimony relevant to the issues raised in the Office Action" (the Mikos declaration) and "[t]o the extent that the Office is of the view that more than 8 pages of Dr. Mikos' declaration testimony should count against the 50-page limit for Patent Owner's response, Patent Owner respectfully requests a corresponding increase in that page limit."<sup>2</sup>

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

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<sup>1</sup> Patent owner petition under 37 CFR 1.183 at page 1.

<sup>2</sup> *Id.*



In the instant patent owner petition under 37 CFR 1.183, patent owner asserts that waiver of the 50-page limit is “necessitated by the fact that the Office Action is nearly 100 pages long and sets forth 50 separate outstanding grounds of rejection under 35 U.S.C. § 103 (based on twenty different references)” and that “the two underlying Requests from which the rejections have been adopted total over 400 pages in length....”<sup>3</sup> Patent owner further asserts that the Mikos declaration “is needed not only to address technical issues that are raised by the rejections and the prior publications upon which they are based, but also to provide a full and complete story of the claimed inventions in the context of the relevant technical field.”<sup>4</sup> Thus, patent owner requests, “given the numerous and complex issues embodied in the outstanding Office action and the cited prior publications, that the page limit for Patent Owner’s response be increased to an amount sufficient to include both the 42-page response and any pages from the Mikos Declaration that the Office determines should be counted against the 50-page limit.”<sup>5</sup> Additionally, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages.<sup>6</sup>

### Analysis and Findings

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

*See, generally,* 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission.

In this instance, the remarks portion of patent owner’s March 21, 2011 response submission satisfies the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), but the entire Mikos declaration does not. Accordingly, patent owner’s March 21, 2011 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is dismissed.

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<sup>3</sup> Id at page 2.

<sup>4</sup> Id.

<sup>5</sup> Id.

<sup>6</sup> The remarks portion of patent owner’s March 21, 2011 response submission is 42 pages long and appears to be one-and-a-half or double-spaced. The Mikos declaration is 60 pages long and is single-spaced.

Patent owner is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth herein; otherwise, patent owner's March 21, 2011 response submission will be deemed defective as not being page-length compliant and will not be considered. In the event patent owner files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

### **Additional Discussion**

It is noted that, in the event patent owner files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a response submission, the content of which is identical to that of the March 21, 2011 response submission, with the exception that the entire Mikos declaration complies with the formatting guidelines set forth herein, such renewed petition would be grantable. In this instance, the specific facts set forth in patent owner's March 21, 2011 petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, and the individual facts and circumstances of this case, such as, *e.g.*, the incorporation by reference, in the January 21, 2011 Office action, of a substantial number of pages from the April 15, 2010 and June 14, 2010 requests for *inter partes* reexamination, demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b).

It is also noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.<sup>7</sup>

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<sup>7</sup> It is noted that, in this instance, 41 pages of the remarks portion of patent owner's March 21, 2011 response submission would be counted toward the page limit (*i.e.*, pages 2-42), and at least Section VIII of the Mikos declaration, spanning pages 13-59, appears to include arguments directed to how an outstanding or proposed rejection is overcome.

### III. The '552 Requester's (Abbott) April 20, 2011 Petition under 37 CFR 1.183

On April 20, 2011, the '552 requester Abbott filed the instant petition under 37 CFR 1.183 for waiver of the page limit of 37 CFR 1.943(b), concurrently filed with its comments submission. Abbott's April 20, 2011 comments submission will not be considered, because, given that the March 21, 2011 patent owner response submission has not been entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requester statutorily has no comment right under 35 USC § 314(b)(2). Further, because Abbott's April 20, 2011 comments submission is not being considered for the reasons set forth herein, Abbott's April 20, 2011 petition under 37 CFR 1.183 is dismissed as moot.

Given that requester statutorily has no comment right to file a comments submission, Abbott's April 20, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding. If patent owner timely files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37 CFR 1.947, Abbott may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant. Any renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) should accompany Abbott's comments submission that complies with the formatting guidelines set forth herein.<sup>8</sup> In the event Abbott files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

It is noted that, in the event Abbott files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a comments submission, the content of which is identical to that of the April 20, 2011 comments submission, such renewed petition would be grantable.<sup>9</sup> Abbott asserts on page 2 of the April 20, 2011 petition under 37 CFR 1.183:

In its 49-page Comments, Abbott appropriately limited its argumentation to issues raised in the Office Action and in Cordis' response. All of the legal arguments in the Comments are fully presented and developed in its Comments document. The Helmus Declaration was submitted to provide factual support for the legal arguments set forth in the Comments. To the extent that the Helmus Declaration discusses the prior art, the same discussion is contained in Abbott's Comments. Because the Helmus Declaration is relied upon for factual support for the arguments presented in Abbott's Comments, the Helmus Declaration should be considered a "reference material" that does not count toward the page limit

<sup>8</sup> Abbott's April 20, 2011 comments submission comprises 49 pages of remarks and appears to be one-and-a-half or double-spaced. The accompanying declaration by Michael N. Helmus, Ph. D., contains 86 pages and also appears to be one-and-a-half or double-spaced.

<sup>9</sup> This guidance is predicated on patent owner filing a grantable renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a response submission, the content of which is identical to that of the March 21, 2011 response submission, with the exception that the entire Mikos declaration complies with the formatting guidelines set forth in section II above.

requirement under 37 C.F.R. 1.943. Abbott's submission, therefore, complies with the page limit requirements of 37 C.F.R. § 1.943(b).

Nonetheless, Abbott requests that its April 20, 2011 petition be granted "[t]o the extent the Office were to deem that any portions of the Helmus Declaration should be counted toward the Rule 1.943 page limit and that, as a result, the limit would be exceeded."<sup>10</sup> Abbott further asserts "that the Rule 1.943 page limit be waived because it is not required by statute and justice requires that Abbott be permitted to fully and fairly address all of the issues raised in the 99-page Office Action and in Cordis' 42-page Response and 60-page, single-spaced Mikos Declaration" and that "[n]o inequities are raised by the Helmus Declaration given that its language regarding the prior art is already contained in Abbott's Comments."<sup>11</sup> Additionally, Abbott has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, which are in excess of 50 pages.<sup>12</sup>

In this instance, the specific facts set forth in Abbott's April 20, 2011 petition under 37 CFR 1.183, Abbott's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, which are in excess of 50 pages, and the individual facts and circumstances of this case, demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b).

#### **IV. The '542 Requester's (Boston Scientific) April 20, 2011 Comments Submission**

On April 20, 2011, the '542 requester Boston Scientific filed comments to the January 21, 2011 Office action and patent owner's March 21, 2011 response submission. For the same reasons set forth in section III above, Boston Scientific's April 20, 2011 comments submission will not be considered, because, given that the March 21, 2011 patent owner response submission has not been entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requester statutorily has no comment right under 35 USC § 314(b)(2).

Given that requester statutorily has no comment right to file a comments submission, Boston Scientific's April 20, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding. If patent owner timely files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37

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<sup>10</sup> Abbott's April 20, 2011 petition under 37 CFR 1.182 at page 2.

<sup>11</sup> Id.

<sup>12</sup> It is noted that, in this instance, 49 pages of the remarks portion of Abbott's April 20, 2011 comments submission would be counted toward the page limit (i.e., pages 1-49). The pages of the Helmus declaration drawn to Dr. Helmus' curriculum vitae, work experience and publications are not counted towards the regulatory page limit; however, at least Section V, spanning pages 33-69, appears to contain arguments as to how an outstanding or proposed rejection is supported. Abbott is advised to set forth, in any renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the comments submission. See section II above, providing guidance on how to make such determination.

CFR 1.947, Boston Scientific may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant.

### CONCLUSION

1. Patent owner's March 21, 2011 petition under 37 CFR 1.183 is dismissed.
2. Patent owner is given a time period of fifteen (15) days from the mailing date of this decision to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth herein; otherwise, patent owner's March 21, 2011 response submission will be deemed defective as not being page-length compliant and will not be considered.
3. If patent owner files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37 CFR 1.947, both the '542 and '552 requesters may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant.
4. The '552 requester's (Abbott) April 20, 2011 petition under 37 CFR 1.183 is dismissed as moot.
5. The '542 requester's (Boston Scientific) and the '552 requester's (Abbott) April 20, 2011 comments submissions will not be considered, because, given that the March 21, 2011 patent owner response submission has not been entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requesters statutorily have no comment right under 35 USC § 314(b)(2). Requesters' April 20, 2011 comments submissions are being expunged from the record. Because these papers have been scanned into the Office's IFW system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.
6. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
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*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No. 7,591,844

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: **DECISION**  
: **GRANTING**  
: **PETITION**

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

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This is a decision on the patent owner paper entitled "RENEWED PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" (the renewed petition under 37 CFR 1.183), filed on June 28, 2011.

The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

## DECISION

### I. Patent Owner's June 28, 2011 Renewed Petition under 37 CFR 1.183

On January 21, 2011, the Office mailed a non-final office action in the instant merged proceeding. On March 21, 2011, patent owner filed a petition under 37 CFR 1.183, requesting waiver of the page limit for its concurrently-filed response submission. On June 14, 2011, the Office mailed a decision dismissing patent owner's March 21, 2011 petition under 37 CFR 1.183 (the June 14, 2011 decision). On June 28, 2011, patent owner filed the instant renewed petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response to the January 21, 2011 Office action.

Patent owner states that the renewed petition under 37 CFR 1.183 is responsive to the June 14, 2011 decision, dismissing patent owner's March 21, 2011 petition for waiver of the page limit requirements of 37 CFR 1.943(b) for patent owner's March 21, 2011 response submission.<sup>2</sup> The June 14, 2011 decision states that to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that adheres to the formatting guidelines set forth therein to enable the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission.<sup>3</sup> The decision further states that "the remarks portion of patent owner's March 21, 2011 response submission satisfies the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), but the entire Mikos declaration does not."<sup>4</sup> The decision set a time period of 15 days from the mailing date of the decision for patent owner to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth in the decision.<sup>5</sup>

The June 14, 2011 decision also states:

[I]n the event patent owner files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a response submission, the content of which is identical to that of the March 21, 2011 response submission, with the exception that the entire Mikos declaration complies with the formatting guidelines set forth herein, such renewed petition would be grantable. In this instance, the specific facts set forth in patent owner's March 21, 2011 petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case, such as, *e.g.*, the incorporation by reference, by the January 21, 2011 Office action, of a substantial number of pages from the April

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<sup>1</sup> See the renewed petition under 37 CFR 1.183 at page 1.

<sup>2</sup> *Id.*

<sup>3</sup> June 14, 2011 decision at page 4.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* at page 5.

15, 2010 and June 14, 2010 requests for *inter partes* reexamination, demonstrate an extraordinary situation in which justice requires suspension the 50-page limit of 37 CFR 1.943(b).<sup>6</sup> [Emphasis added.]

Concurrently with the instant renewed petition under 37 CFR 1.183, patent owner submitted “a Second Mikos Declaration, which Patent Owner certifies is substantively identical to the previous Declaration, except that the formatting has been revised to comply with the [the June 14, 2011 decision’s formatting] guidelines.”<sup>7</sup> Patent owner states that “Patent Owner’s response, not including the appendix (a listing of claims), is 42 pages long” and that “[a]ccompanying the response is a corrected Declaration of Antonios G. Mikos, Ph.D, which presents testimony relevant to the issues raised in the Office Action.”<sup>8</sup> Patent owner further states that “[t]o the extent that the Office if [sic] of the view that more than eight pages of Dr. Mikos’ declaration testimony should count against the 50-page limit for Patent Owner’s response, Patent Owner respectfully requests a corresponding increase in that page limit.”<sup>9</sup> Additionally, patent owner reiterates reasons, previously set forth in patent owner’s March 21, 2011 petition for waiver of 37 CFR 1.943(b), why patent owner deems the additional pages are necessary.<sup>10</sup>

The corrected Mikos declaration, submitted concurrently with the instant petition under 37 CFR 1.183 and the content of which patent owner has certified is identical to that of the March 21, 2011 Mikos declaration, is being entered as a substitute declaration for the March 21, 2011 Mikos declaration, which did not comply with the formatting guidelines set forth in the June 14, 2011 decision. Thus, patent owner’s corrected response submission to the January 21, 2011 Office action is deemed to comprise: (1) the 42 pages of remarks, the 3-page “Appendix A” listing of the claims, and Exhibits 4 and 7 (reference materials) of patent owner’s March 21, 2011 response submission, and (2) the June 28, 2011 80-page corrected Mikos declaration.

The portions of patent owner’s corrected response submission that count toward the regulatory page limit satisfy the formatting guidelines set forth in the June 14, 2011 decision and exceed the regulatory page limit by up to 71 pages.<sup>11</sup> For the reasons previously set forth in the June 14, 2011 decision, the individual facts and circumstances of this case demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b) for patent owner’s corrected response submission. Accordingly, patent owner’s June 28, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s corrected response submission to exceed the regulatory page limit by up to 71 pages for the reasons set forth in the decision of June 14, 2011. **This waiver makes patent owner’s corrected response submission page-length compliant.**

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<sup>6</sup> Id.

<sup>7</sup> The renewed petition under 37 CFR 1.183 at page 2 (also stating in FN 1 that “[s]ince Patent Owner’s Response filed March 21, 2011 was found to comply with the formatting guidelines, it has not been resubmitted.”)

<sup>8</sup> Id. [Footnote omitted.]

<sup>9</sup> Id.

<sup>10</sup> See id.

<sup>11</sup> Included in the regulatory page count are 41 pages of patent owner’s March 21, 2011 remarks (the cover page is excluded), as well as portions of the June 14, 2011 corrected Mikos declaration (e.g., at least Section VIII of the corrected Mikos declaration, spanning pages 17-79, presenting arguments directed to how outstanding rejections are overcome).



## II. The '552 Requester's (Abbott) Comments Submission

In the June 14, 2011 decision, the Office dismissed as moot the '552 requester's (Abbott) April 20, 2011 petition under 37 CFR 1.183 for waiver of the 37 CFR 1.943(b) page limit requirement with respect to requester's April 20, 2011 comments submission and expunging requester's April 20, 2011 comments submission from the record of the instant proceeding.<sup>12</sup> However, the June 14, 2011 decision states:

If patent owner timely files a grantable petition under 37 CFR 1.183 in response to the decision, then under 37 CFR 1.947, Abbott may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant. Any renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) should accompany Abbott's comments submission that complies with the formatting guidelines set forth herein. In the event Abbott files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

It is noted that, in the event Abbott files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a comments submission, the content of which is identical to that of the April 20, 2011 comments submission, such renewed petition would be grantable.<sup>13</sup> [Footnotes omitted.]

In view of the instant decision granting patent owner's June 28, 2011 renewed petition under 37 CFR 1.183 and entering patent owner's corrected response submission as page-length compliant, the '552 requester may once file written comments under 37 CFR 1.183 within 30 days of the mailing date of this decision.

## III. The '542 Requester's (Boston Scientific) Comments Submission

The June 14, 2011 decision stated that the '542 requester's (Boston Scientific) April 20, 2011 comments submission will not be considered.<sup>14</sup> However, the June 14, 2011 decision further states:

If patent owner timely files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37 CFR 1.947, Boston Scientific may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant.<sup>15</sup>

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<sup>12</sup> See June 14, 2011 decision at page 6.

<sup>13</sup> Id.

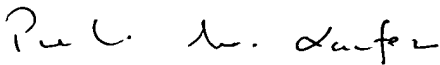
<sup>14</sup> Id. at page 7.

<sup>15</sup> Id. at pages 7-8.

In view of the instant decision granting patent owner's June 28, 2011 renewed petition under 37 CFR 1.183 and entering patent owner's corrected response submission as page-length compliant, the '542 requester may once file written comments under 37 CFR 1.183 within 30 days of the mailing date of this decision.<sup>16</sup>

### CONCLUSION

1. Patent owner's June 28, 2011 renewed petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's corrected response submission to exceed the regulatory page limit by up to 71 pages. **This waiver makes patent owner's corrected response submission page-length compliant.**
2. Both the '552 and '542 requesters may once file written comments, limited to issues raised by the January 21, 2011 Office action or the patent owner's corrected response submission, **within 30 days from the mailing date of this decision.**
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

8-2-2011

<sup>16</sup> Any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany Boston Scientific's comments submission that complies with the formatting guidelines set forth in the June 14, 2011 decision.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,542 <del>95/000,542</del> 95/00552	04/15/2010	7,591,844 B2	CRDS-0116	8264
45511	7590	12/07/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 12/07/2011

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Date: 12-7-11

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NEW YORK, NY 10151

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000542 95/000552  
PATENT NO. : 7591844  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**MAILED** (For Patent Owner)

**DEC 07 2011**

**CENTRAL REEXAMINATION UNIT**

Frommer Lawrence & Haug, LLP  
745 Fifth Avenue – 10<sup>th</sup> Floor  
New York, NY 10151

(For *Inter Partes* '542 Requester)

Finnegan, Henderson, Farabow, Garrett,  
& Dunner, LLP  
901 New York Avenue, N.W.  
Washington, D.C. 20001-4413

(For *Inter Partes* '552 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No.: 7,591,844

**DECISION  
DENYING  
PETITION**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

This decision addresses the following:

1. The October 7, 2011 patent owner petition entitled "Petition Under 37 C.F.R. § 1.182", filed on October 7, 2011" (the October 7, 2011 patent owner petition under 1.182);
2. The November 2, 2011 opposition petition by the *inter partes* '552 requester entitled "Requester Abbott's Petition to Respond to Patent Owner's October 7, 2011 Petition Under 37 C.F.R. § 1.182 Seeking Unprecedented Discovery in *Inter Partes* Reexamination Proceedings" (the November 2, 2011 opposition by the *inter partes* '552 requester); and
3. The November 3, 2011 opposition petition by the *inter partes* '542 requester entitled "Third Part [*sic*] Requester Boston Scientific's Opposition Under 37 C.F.R. § 1.182 To Patent Owner's Petition for Discovery" (the November 3, 2011 opposition by the *inter partes* '542 requester).

The October 7, 2011 patent owner petition under 37 CFR 1.182, the November 2, 2011 opposition by the *inter partes* '552 requester, the November 3, 2011 opposition by the *inter partes* '542 requester, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

## SUMMARY

Patent owner's October 7, 2011 petition under 37 CFR 1.182 is **denied**. Discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings.

Patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is **denied**.

This decision is designated as a final agency action under 5 U.S.C. § 704.

## DECISION

The patent owner requests that the Office "clarify" its rules as they relate to the service of a subpoena under 35 U.S.C. 24 in *inter partes* reexamination proceedings. Specifically, the patent owner requests that the Office "confirm that its current rules impose no requirement that parties seeking to enforce subpoenas under § 24 must obtain the Office's authorization". Alternatively, the patent owner requests:

if the Office takes the position that such authorization is required for the enforcement of § 24 subpoenas, . . . that the Office grant such authorization so that Patent Owner may (i) obtain important information relevant to nonobviousness that is in the possession of the Third Party Requesters (TPRs) in these merged reexaminations, and (ii) cross-examine expert witnesses whose declarative testimony has been entered into the record of these consolidated *inter partes* reexaminations by TPRs.

35 U.S.C. 24 provides, in pertinent part (emphasis added):

The clerk of any United States court for the district wherein testimony is to be taken for use in *any contested case in the Patent and Trademark Office*, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office....

The *inter partes* reexamination statute, however, does not authorize discovery in *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Optional *inter partes* reexamination was enacted in the American Inventors Protection Act of 1999 (the AIPA). See Public Law 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999), codified at 35 U.S.C. 311–318. 35 U.S.C. 311–318 provide for the filing of a request for *inter partes* reexamination, the Office's decision on such a request, an examination stage including Office actions on the merits, patent owner responses to the Office actions, and third-party requester comments (where patent owner responds) addressing issues raised by the Office action and/or the patent owner's response, an appeal stage, and the issuance of a certificate at the

conclusion of the proceedings. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the Board of Patent Appeals and Interferences (BPAI) adverse to patent owner to the United States Court of Appeals for the Federal Circuit (Federal Circuit). However, as originally enacted, the AIPA did not permit a third party requester of the *inter partes* reexamination to appeal an adverse decision of the BPAI to the Federal Circuit, and did not provide for third-party-requester participation in an appeal taken by the patent owner to the Federal Circuit. Subsequently, the *21st Century Department of Justice Appropriations Authorization Act* (see Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002)) via section 13106, granted the third party requester the rights to (a) appeal an adverse decision of the BPAI to the Federal Circuit (in which appeal the patent owner may participate), and (b) be a party to a patent owner appeal to the Federal Circuit. **Such is the extent of third party participation in an *inter partes* reexamination proceeding, as provided by the 1999 and 2002 enactments.**

35 U.S.C. 314 prescribes the procedure for the conduct of *inter partes* reexamination proceedings. 35 U.S.C. 314(a) provides, in pertinent part:

Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

35 U.S.C. 132 and 133, which govern initial examination, do not provide for a discovery practice. In addition, the initial examination of a patent application is not a “contested case in the Patent and Trademark Office” within the meaning of 35 U.S.C. 24. 35 U.S.C. 132 and 133 address initial examination, and not adjudication, and accordingly do not provide any basis for the authorization of discovery under 35 U.S.C. 24. Moreover, 35 U.S.C. 305, which includes corresponding provisions governing *ex parte* reexamination, similarly specifies that *ex parte* reexamination “will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.” The fact that the same language is used to describe the conduct of *ex parte* reexamination proceedings, which do not provide for discovery, suggests that discovery practice is not within the scope of any reexamination proceeding, whether *inter partes* or *ex parte*. Cf. *Rules to Implement Optional Inter Partes Reexamination Proceeding*, 65 Fed. Reg. 76,756, 76,763 (December 7, 2000) (final rule) (“In a very real sense, the intent of reexamination is to start over and reexamine the patent and examine new and amended claims *as they would have been examined in the original application of the patent.*”) (emphasis added).

35 U.S.C. 314(b) provides for service of parties and for the submission of written comments by the third party requester after a patent owner response during the examination stage. Third party requester’s written comments must be filed within thirty days of the date of service of patent owner’s response. There is no authorization for discovery. Furthermore, as argued by the third party requester in the ‘542 proceeding,<sup>1</sup> it would be impracticable, if not impossible, for the parties to conduct discovery, for the court to resolve any discovery disputes, and for the third party requester to prepare and submit its written comments within the thirty-day period set by statute. The fact that Congress required the third party requester to file written comments within

<sup>1</sup> See the November 3, 2011 opposition by the third party requester, Boston Scientific, of *inter partes* reexamination proceeding 95/000,542.

a thirty-day period provides evidence that Congress did not intend to authorize discovery practice in *inter partes* reexamination proceedings.

Both 35 U.S.C. § 314(c), which governs *inter partes* reexamination, and 35 U.S.C. § 305, which governs *ex parte* reexamination, provide that reexamination in *inter partes* reexamination and in *ex parte* reexamination proceedings, respectively, will be conducted with “special dispatch” within the Office. Neither the statute nor the regulations define special dispatch; however, in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit explained:

“Special dispatch” is not defined by statute. . . . According to Webster’s New World Dictionary, special means distinctive, unique, exceptional or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary and common meaning of special dispatch envisions some type of unique, extraordinary or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that ‘reexamination proceedings will be “special” through their pendency’ in the office and provides for an accelerated schedule. MPEP § 2261.

*Ethicon*, 849 F.2d at 1426.

Any provision for discovery would necessarily prolong proceedings before the Office. If Congress had intended for discovery to be permitted in *inter partes* reexamination proceedings, rather than in *ex parte* reexamination proceedings, Congress would have expressly provided for such a practice, and it would have circumscribed the discovery in a manner consistent with the statutory requirement for “special dispatch.” Thus, the statutory requirement for special dispatch clearly provides evidence that Congress did not contemplate discovery for *inter partes* reexamination proceedings. Regarding the sole exception to the “special dispatch” requirement, i.e., a finding of “good cause” by the Director, the Office has not authorized an exception to the “special dispatch” provision for the purposes of permitting discovery, and is not authorized to do so, given the above-discussed provisions of 35 U.S.C. 314(a).

The above interpretation of the *inter partes* reexamination provisions is consistent with their legislative history. The legislative history makes no mention of discovery, and consistently expresses a concern for providing a low-cost, efficient alternative to litigation, in which a third party requester has the ability to participate by submitting comments, in writing, to the examiner, in response to arguments made by the patentee. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did “not subject the patent to any greater challenge in scope than currently exists today” but “merely allows a reexam requestor the option to further explain why a particular patent should not have been granted”); H.R. Rep. No. 106-287, 106th Cong., 1st Sess. 31, (1999) (Submitted by Rep. Coble) (“The existing patent reexamination system is an ineffective means for bringing relevant prior art unavailable to examiners during their search to the attention of the PTO due to the *ex parte* nature of the proceeding.”); 145 Cong. Rec. S14720, (Nov. 17, 1999) (Statement of Senator Lott) (“Subtitle F is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing *ex parte* reexamination in Chapter 30 of title 35, the option of *inter partes* reexamination proceedings in the USPTO. Congress enacted legislation to authorize *ex parte* reexamination of



patents in the USPTO in 1980, but such reexamination has been used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the USPTO. Subtitle F provides that opportunity as an option to the existing *ex parte* reexamination proceedings.”).

The Office has implicitly understood that the *inter partes* reexamination provisions do not authorize discovery. In response to a reporting requirement of the AIPA (*see* AIPA, Pub. L. 106-113, 1501A-571, § 4606 (1999)), the Office conducted a “round table meeting” to receive views on the effectiveness and possible improvement of *inter partes* reexamination and then drafted a report to Congress. The report points out that “the lack of such procedural mechanisms as discovery and cross-examination that would be available in litigation has apparently resulted in challengers being unwilling to invoke *inter partes* reexamination and risk its estoppel effect.” United States Patent And Trademark Office Report To Congress On Inter Partes Reexamination (2004) (available at [http://www.uspto.gov/web/offices/dcom/olia/reports/reexam\\_report.htm](http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm)), at 4; *see also* Transcript of February 17, 2004 Roundtable Meeting (available at [http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round\\_tbl\\_transcript.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round_tbl_transcript.pdf)) at 20-21 (discussing the lack of discovery in *inter partes* reexamination). The report contrasts *inter partes* reexamination to a proposed “post-grant review process,” in which “[c]losely controlled discovery and cross-examination would be available in the review, upon the challenger’s presenting sufficient grounds that one or more of the patent claims are unpatentable.” *Id.* at 8. Accordingly, the public and the Office understood that discovery was not available in *inter partes* reexamination, and that additional legislation would be required to provide for such discovery.

On September 16, 2011, Congress enacted The America Invents Act (the AIA), which, replaces *inter partes* reexamination with a new proceeding titled *inter partes* review, effective September 16, 2012. The statute expressly provides for discovery in newly enacted 35 U.S.C. § 316 (Conduct of *inter partes* review), which instructs the Director to “prescribe regulations . . . setting forth standards and procedures for discovery of relevant evidence, including that such discovery will be limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is necessary in the interests of justice.” *See* Pub. L. No. 112-29, Section 6. The legislative history of the new proceeding confirms that Congress intended to provide discovery where none had previously been available:

The Act converts *inter partes* reexamination from an examinational to an adjudicative proceeding, and renames the proceeding “*inter partes* review.” The Act also makes the following improvements to this proceeding:

- Discovery. Parties may depose witnesses submitting affidavits or declarations and seek such discovery as the Patent Office determines is otherwise necessary in the interest of justice.

H. Rep. No. 112-98 (Part 1) 112th Cong., 1st Sess., at 46-47 (2011) (available at <http://www.gpo.gov/fdsys/pkg/CRPT-112hrpt98/pdf/CRPT-112hrpt98-pt1.pdf>).

Congress's characterization of the provision for limited discovery in *inter partes* review as an "improvement" over *inter partes* reexamination settles any dispute concerning the proper interpretation of the *inter partes* reexamination statute. The AIPA does not authorize discovery in *inter partes* reexamination proceedings.

The patent owner argues that case law relating to discovery in patent interferences supports the ability to obtain discovery under 35 U.S.C. 24 without prior Office approval. However, the enactment of the *inter partes* review discovery provision of the AIA, which sets limits on permissible discovery in *inter partes* review, confirms that the patent owner cannot rely on 35 U.S.C. 24 in isolation to provide authorization for discovery in Office proceedings. The anomalous result of patent owner's argument would be that because the *inter partes* reexamination statute failed to provide for discovery, more discovery would be available under *inter partes* reexamination than under *inter partes* review. That result is plainly contrary to Congress's intent.

Furthermore, 35 U.S.C. 24 applies to contested cases within the Patent and Trademark Office. However, an *inter partes* reexamination proceeding is not a contested case, also as argued by the third party requester of the '552 proceeding.<sup>2</sup> The Office's interpretation of 35 U.S.C. 314 to exclude authorization for discovery in *inter partes* reexamination proceedings, including the interpretation that *inter partes* reexamination proceedings are not "contested cases" within the meaning of 35 U.S.C. 24, is confirmed by the Office's promulgation of rules specifically governing discovery for interferences, while none were drafted for *inter partes* reexamination proceedings. See, e.g., 37 CFR 41.150(a), which states: "[a] party is not entitled to discovery except as authorized in this subpart". Finally, if Congress intended to permit discovery in *inter partes* reexamination proceedings, it would have modeled those proceedings on "contested cases" such as interferences, and not on proceedings such as initial examination or *ex parte* reexamination, which are not contested cases, and which do not include discovery. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did "not subject the patent to any greater challenge in scope than currently exists today" but "merely allows a reexam requestor the option to further explain why a particular patent should not have been granted").

In summary, discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Accordingly, patent owner's October 7, 2011 petition under 37 CFR 1.182 is **denied**. For the same reasons, patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is also **denied**.

This decision constitutes the Office's final decision concerning whether discovery is permissible in *inter partes* reexamination proceedings.

---

<sup>2</sup> See the November 2, 2011 opposition by the third party requester, Abbott Laboratories, of *inter partes* reexamination proceeding 95/000,552.

### CONCLUSION

- Patent owner's October 7, 2011 petition under 37 CFR 1.182 is denied.
- Patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is denied.
- This decision is designated as a final agency action under 5 U.S.C. § 704.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



---

Brian E. Hanlon  
Director  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,542 - 45/000,552	04/15/2010	7,591,844 B2	CRDS-0116	8264
45511	7590	12/30/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2011

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Date: 12-30-11

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000542 95/000552  
PATENT NO. : 7591844  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

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If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**CENTRAL REEXAMINATION UNIT** (For Patent Owner)

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(For 95/000,542 Third Party Requester)

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Finnegan, Henderson, Farabow,  
Garrett & Dunner, LLP  
901 New York Avenue, N.W.  
Washington, DC 20001-4413

(For 95/000,552 Third Party Requester)

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No. 7,591,844

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: **DECISION**  
: **GRANTING**  
: **PETITION**

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

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This is a decision on the 95/000,552 third party requester, Abbott Laboratories (Abbott), paper entitled "RENEWED PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 CFR §1.947" (the renewed petition under 37 CFR 1.183), filed on August 30, 2011.

The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

## DECISION

### I. Background

On January 21, 2011, the Office mailed a non-final office action in the instant merged 95/000,542 and 95/000,552 proceeding (the merged proceeding). On March 21, 2011, patent owner filed a petition under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit for its concurrently-filed response submission. On April 20, 2011, Abbott filed a petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its concurrently-filed comments submission. On June 14, 2011, the Office mailed a decision dismissing patent owner's March 21, 2011 petition and not entering patent owner's response submission, and dismissing as moot Abbott's April 20, 2011 petition and not entering Abbott's comments submission (the June 14, 2011 decision).

On June 28, 2011, in accordance with the June 14, 2011 decision, patent owner filed a renewed petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its concurrently-filed corrected response submission. On August 3, 2011, the Office mailed a decision granting patent owner's June 28, 2011 petition and entering patent owner's June 28, 2011 corrected response submission, giving Abbott and the 95/000,542 requester 30 days from the mailing date of that decision to file written comments limited to issues raised by the January 21, 2011 Office action or the patent owner's corrected response submission. On August 30, 2011, Abbott filed the instant renewed petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its concurrently-filed comments submission.<sup>1</sup>

### II. Abbott's August 30, 2011 Renewed Petition under 37 CFR 1.183

Requester Abbott states that the instant renewed petition under 37 CFR 1.183 is responsive to the June 14, 2011 and August 3, 2011 decisions.<sup>2</sup> The June 14, 2011 decision states that to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that adheres to the formatting guidelines set forth therein to enable the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission.<sup>3</sup> The August 3, 2011 decision reiterates the June 14, 2011 decision in stating that "[i]n the event Abbott files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a comments submission, the content of which is identical to that of the April 20, 2011 comments submission, such renewed petition would be grantable."<sup>4</sup>

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<sup>1</sup> See the renewed petition under 37 CFR 1.183 at page 1.

<sup>2</sup> Id. It is noted that Abbott refers to the August 3, 2011 decision as "the August 2, 2011 decision"; the decision was signed on August 2, 2011 and mailed on August 3, 2011.

<sup>3</sup> June 14, 2011 decision at page 6.

<sup>4</sup> August 3, 2011 decision at page 4. It is noted that Abbott's August 30, 2011 comments submission was not required to be identical in content to its June 14, 2011 comments submission because the entry of patent owner's corrected response on August 3, 2011 started a new statutory time period for requester comments submissions.

In the instant renewed petition under 37 CFR 1.183, Abbott states that the August 30, 2011 comments “are very similar to its previous submission”, but notes the following changes:

... a change in the font size from 11 to 12; the addition of the text “both used in repairing arteries” at the end of the first full paragraph on page 4; the addition of a short section bridging pages 7 and 8 to address the new information submitted by Cordis in its August 8, 2011, Information Disclosure Statement; the addition of two lines of text to the last paragraph on page 15; the addition of less than six lines of text at the end of the second paragraph on page 16; and formatting, typographical, and grammatical changes to the text. Abbott also submits that the Helmus Declaration is nearly identical to the previously submitted Helmus Declaration except for formatting, typographical, and grammatical changes.<sup>5</sup>

In this instance, Abbott requests waiver of the regulatory page limit so that “Abbott be permitted to fully and fairly address all of the issues raised in the 99-page Office Action and in Cordis’s 42-page Response and 80-page Mikos Declaration” and “specifically requests an increase in the regulatory page limit by 55 pages.”<sup>6</sup>

Abbott’s August 30, 2011 comments comprise 59 pages of remarks that count toward the regulatory page limit (the cover page, table of contents and list of attachments are excluded from the page count). Additionally, at least portions of the 72-page declaration of Michael N. Helmus, Ph.D., are deemed to be an extension of the arguments of counsel and count toward the regulatory page limit.<sup>7</sup>

Although the content of Abbott’s August 30, 2011 comments submission differs slightly from that of Abbott’s April 20, 2011 comments submission, the reasons previously set forth in the June 14, 2011 decision supporting waiver of the regulatory page limit for Abbott’s April 20, 2011 comments submission are equally applicable to Abbott’s August 30, 2011 comments submission. Thus, the individual facts and circumstances of this case demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b) for Abbott’s August 30, 2011 comments submission. Accordingly, Abbott’s August 30, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of Abbott’s August 30, 2011 comments submission for the reasons set forth in the decision of June 14, 2011. **This waiver makes Abbott’s August 30, 2011 comments submission page-length compliant.**

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<sup>5</sup> The renewed petition under 37 CFR 1.183 at page 3.


<sup>6</sup> Id. at pages 3-4 and FN 3 (stating, “Abbott’s Comment comprises 59 pages. The accompanying Helmus Declaration contains 69 pages. However, the pages including Dr. Helmus’ curriculum vitae, work experience and publications were not counted towards the page limit. In accordance with the Office, Abbott believes that only Section V, spanning pages 33-69 contain argument as to how an outstanding or proposed rejection is supported. Although Abbott believes pages 24-33 merely provide background factual information, in an abundance of caution, Abbott has also included those pages in counting the regulatory page limit. Therefore, Abbott believes that 46 pages of the Helmus Declaration should count toward the regulatory page limit for a total of 105 pages and the corresponding request for a 55 page increase in the page limit.”).

<sup>7</sup> See, e.g., Section IV of the Helmus declaration, spanning pages 24-69.



### CONCLUSION

1. Requester Abbott Laboratories' August 30, 2011 renewed petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of Abbott's August 30, 2011 comments submission. **This waiver makes Abbott's August 30, 2011 comments submission page-length compliant.**
2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

12-27-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,542 <del>4 95/000,552</del>	04/15/2010	7,591,844 B2	CRDS-0116	8264
45511	7590	02/23/2012	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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NEW YORK, NY 10151

Date: 2-23-12

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000542 + 95/000552  
PATENT NO. : 7591844  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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WOODCOCK WASHBURN LLP      FEB 23 2012      (For Patent Owner)  
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<i>In re Llanos et al.</i>	:	
<i>Inter Partes</i> Reexamination Proceeding	:	
Control No. 95/000,542	:	DECISION ON PETITION
Filed: April 15, 2010	:	UNDER 37 CFR 1.181
For: U.S. Patent No. 7,591,844	:	AND OPPOSITION
	:	THEREFOR
<i>Inter Partes</i> Reexamination Proceeding	:	FOR WITHDRAWAL OF
Control No. 95/000,552	:	THE ACTION CLOSING
Filed: June 14, 2010	:	PROSECUTION
For: U.S. Patent No. 7,591,844	:	

This is a decision addressing Patent Owner's petition, filed February 6, 2012 under 37 CFR 1.181, and a third party Requester's petition, filed February 14, 2012, in opposition to Patent Owner's petition. The petitions concern whether the Action Closing Prosecution was proper.

The petitions are before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit for decision.

Patent Owner's petition is DENIED.

Requester's opposition petition is GRANTED to the extent that Patent Owner's petition is denied.

### BACKGROUND

1. U.S. Patent Number 7,591,844 (the '844 patent) issued to Llanos et al. on September 22, 2009, with 24 claims.
2. A first request for *inter partes* reexamination, assigned Reexamination Control No. 95/00,542 ("the '542 proceeding"), was filed by a third party requester on April 15, 2010. Boston Scientific SCIMED, Inc. is identified as the real party in interest.
3. A second request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,552 ("the '552 proceeding"), was filed by another third party requester on June 14, 2010. Abbott Laboratories is identified as the real party in interest.
4. On June 30, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '542 reexamination proceeding. An Office action containing at least one rejection of each of claims 1-24 of the '844 patent in the '542 reexamination proceeding was mailed on the same date.
5. On August 25, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '552 reexamination proceeding.
6. On August 30, 2010, patent owner timely filed a response to the Office action in the '542 proceeding, retaining original patent claims 1-24 as unamended. The response included a first declaration under 37 CFR 1.132 by Antonios G. Mikos, to support patent owner's arguments pertaining the rejections, such as contentions that there are no reasons to combine the prior art teachings.
7. On September 29, 2010, third party requester timely filed comments in the '542 proceeding, pursuant to 37 CFR 1.947, including a declaration under 37 CFR 1.132 by Chris Scott.
8. On November 26, 2010, a decision merging the '542 and '552 proceedings ("merged proceedings") were mailed.
9. On January 21, 2011, an Office action on the merits was mailed in the merged proceedings. The Office action contained obviousness rejections for claims 1-24. The Office action also addressed the August 30, 2010 response, including the Mikos declaration and the September 29, 2010 comments, including the Scott declaration. See, e.g., pages 78-93 of the Office action.
10. On March 21, 2011, Patent Owner filed a response to the Office action. The response included a second declaration under 37 CFR 1.132 by Antonios G. Mikos, to support patent owner's arguments pertaining the obviousness rejections, such as contentions that there are no reasons to combine the prior art teachings.
11. On April 20, 2011, Requester, Boston Scientific, in the '542 proceeding filed comments in response to Patent Owner's response and submitted a declaration by Gary L. Loomis in support of the rejections of the claims. On the same day, Requester, Abbott Laboratories, in the '552

proceeding filed comments in response to Patent Owner's response and submitted a declaration by Michael N. Helmus in support of the rejections of the claims.

12. Due to the eventual grant of petitions under 37 CFR 1.183 requesting that the Office waive the page limit of 37 CFR 1.943(b), Patent Owner and both Requesters were able to file replacement response and comments, respectively. See the August 8, 2011 decision.

13. On February 1, 2012, the Office mailed an Action Closing Prosecution.

11. On February 6, 2012, Patent Owner filed the petition under 37 CFR 1.181.

12. On February 14, 2012, Requester filed the opposition petition under 37 CFR 1.181 requesting that the Office deny Patent Owner's petition filed on February 6, 2012.

### DECISION

In the February 6, 2012 petition, Patent Owner argues that the examiner substantially modified her positions in the Action Closing Prosecution (ACP) by the alleged improper reliance on declarations submitted by the Requesters in the merged proceedings. For these reasons, Patent Owner requests that the ACP be withdrawn. Patent Owner also requests that a new examiner be assigned to the proceedings.

In response to Patent Owner's arguments for reopening prosecution in this reexamination proceeding, the Director finds there are not good and sufficient reasons to do so for the reasons set forth below. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an action closing prosecution.

Turning to the facts in this proceeding, Patent Owner asserts that the examiner's response to arguments and evidence essentially resulted in new grounds of rejection, which requires that prosecution be reopened. Specifically, Patent Owner argues that the examiner has modified her position in several obviousness rejections by relying on the declarations and evidence filed by the Requesters in their comments. This argument is not persuasive for the following reasons. Specifically, upon review of the record, it is noted that the ACP maintained the rejections (Grounds 4-15, 29-41, 48-53, and 69-83) that were applied in the January 21, 2011 non-final Office action. See pages 93-96 in the January 21, 2011 Office action and pages 4-7 in the ACP. Therefore, no new grounds of rejections were set forth in the ACP. As explained above, reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. The record clearly shows that the examiner set forth the *exact* same rejections as in the non-final Office action of January 21, 2011. The basis for which petitioner requests reopening of prosecution is the examiner's response to arguments and evidence pertaining to obviousness issues presented in the Patent Owner's response to the January 21, 2011 Office action. To reiterate, in the ACP, the examiner was addressing arguments and evidence of the Patent Owner

by referring to the arguments and evidence filed in the Requester's comments, and did not modify or alter the grounds of rejection.

As discussed in more detail below, the Requesters are permitted to file comments, including the filing of declarations to support their comments, on the obviousness issues raised by the Patent Owner and the Office action. In accordance with Office procedures, the examiner considered both the Patent Owner's and third party Requesters' arguments and evidence and addressed such in the ACP. It is noted that the examiner followed the same procedure in the January 21, 2011 Office action. Specifically, the examiner addressed both the first Mikos declaration and Scott declaration as part of her response. See, e.g., pages 79-85. For example, in addressing the arguments/evidence for Ground 5, the examiner supported her position with a citation to the Scott declaration on pages 79 and 82 of the January 21, 2011 Office action. Petitioner points to pages 65-66 of the ACP as an example of showing that the examiner *de facto* introduced a new ground of rejection. However, it is noted that pages 65-66 of the ACP also addresses arguments pertaining to Ground 5 and applies the declaration evidence of record in substantially similar manner as that applied in the January 21, 2011 Office action. In fact, all the pages alleged to have new grounds of rejection are part of the examiner's response to issues raised by the Patent Owner and the Requesters. Upon review of the record, the examiner followed Office policy and procedures by stating agreement or disagreement with the positions of the Patent Owner and third party Requesters and providing reasons for the examiner's position. It would be impossible to ever close prosecution if the examiner could not to do so because he or she addressed evidence filed by the parties after a non-final Office action. The statutory requirement of special dispatch is clear that prosecution is not meant to continue without end. Upon review of the record, the examiner's rebuttal is consistent with the prior position taken by the examiner, and therefore does not constitute a *de facto* new ground of rejection by addressing the arguments and evidence submitted in response to the January 21, 2011 Office action. There is no new ground of rejection where the basic thrust of the examiner's rejection remains the same. See MPEP 1207.03 (III). Therefore, no new grounds of rejection were made, and Office policies and procedures do not require reopening of prosecution. See MPEP 2673.01. For these reasons, the issuance of the ACP is in accordance with Office rules and procedures.

In regard to Patent Owner's arguments that they have been prejudiced, as stated above, the rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an ACP. As discussed above, the record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP, and did not categorically deprive the patent owner of its statutory rights to present amendments and arguments in reexamination proceedings.

Patent Owner also generally asserts that the evidence filed by the Requesters was improperly entered into the reexamination records and considered by the examiner because there is no procedural basis for a Requester to file a declaration in support of their comments on the Patent Owner's response.

Patent Owner's position is not supported by statute, regulation, or the guidance of the MPEP. MPEP 2617(II) states:

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in any reexamination.

Furthermore, MPEP 2658, which describes the scope of reexamination proceedings, states in subsection IV.G.:

Affidavits under 37 CFR 1.131 and 1.132 may be utilized in a reexamination proceeding.

The guidance provided above in the MPEP is grounded in the statutes that established *inter partes* reexamination, including 35 U.S.C. 314, which states, in part:

(a) **IN GENERAL.**- Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for **initial examination under the provisions of sections 132 and 133**. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(b) **RESPONSE.**-

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the *inter partes* reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the **third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto**, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response. (emphasis added in bold).

As pointed out in the decision of *In re Chambers*, 20 USPQ2d 1470 (Comr. Pats. 1991), the reexamination statute provides for evidentiary affidavits and declarations to help define the scope and content of the prior art. See also *In re Baxter Travenol Labs*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1992) that applied the *Chambers* principle and found that affidavits and declarations are proper to help define the scope and content of the prior art. While the legal precedent was addressing *ex parte* reexamination, it also applies to *inter partes* reexamination, established after the decisions were rendered. Moreover, there is no provision in the statutes and regulations that prohibits a requester from filing a declaration as part of its comments on a patent owner's response to an Office action. In fact, the statutes, regulations, and guidance make it clear that declaration practice is permitted in *inter partes* reexamination proceedings.

The declarations filed by the Requesters clearly fall within the scope of what is permissible as set forth in the laws, regulations, and guidance cited above. Specifically, the declarations address the patentability issues raised by the Patent Owner in their response. For example, the declarations speak to the issues of whether there is a reason to combine the prior art teachings and the level of skill and knowledge in the art. For these reasons, the Patent Owner's petition failed to show that



the third party Requesters' comments, including the declarations and evidence, were not compliant with 37 CFR 1.947, which proscribes the requirements for a third party requester's comments.

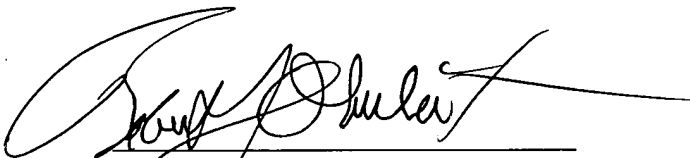
In summary, the examiner appropriately followed Office rules and procedures in deciding to issue the ACP, and closed prosecution in the interest of "special dispatch" in accordance with Office rules and procedures. For the reasons set forth above, the examiner followed Office rules and procedures and did not abuse her discretion in deciding to issue an ACP.

In regard to Patent Owner's request for a new examiner to be assigned to the proceeding, the request is respectfully declined. Patent Owner has not shown that the assignment of the merged proceedings to this examiner has violated the policies and procedures set forth in MPEP 2636. In the interest of special dispatch and the best use of resources, Patent Owner's request is not granted.

Accordingly, good and sufficient reasons to reopen prosecution and to assign a new examiner to the reexamination proceedings have not been provided and the Patent Owner's petition is denied.

#### CONCLUSION

1. Patent Owner's petition filed February 6, 2012 is **DENIED** for the reasons discussed above.
2. Requester's petition filed February 14, 2012 is **GRANTED** to the extent that patent owner's petition is denied.
3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.



Robert J. Oberleitner,  
Assistant Deputy Commissioner for Patent Operations and  
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,543	05/24/2010	6,993,661	ESTL001USRE	5339
58293	7590	04/14/2011	EXAMINER	
FORTKORT & HOUSTON P.C. 9442 N. CAPITAL OF TEXAS HIGHWAY ARBORETUM PLAZA ONE, SUITE 500 AUSTIN, TX 78759			ART UNIT	PAPER NUMBER

DATE MAILED: 04/14/2011

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Date:

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**APR 14 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000543  
PATENT NO. : 6993661  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APR 14 2011

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*Inter Partes* Reexamination Proceeding  
Control No. 95/000,543  
Filed: May 24, 2010  
For: U.S. Patent No. 6,993,661

:  
: **DECISION**  
: **DISMISSING**  
: **PETITION**  
:

This is a decision on the January 5, 2011 third party requester's petition paper entitled "PETITION PURSUANT 37 C.F.R. § 1.182, OR ALTERNATIVELY 37 C.F.R. § 1.183 TO WAIVE OR SUSPEND THE PAGE LIMITATION OF C.F.R. § 1.943".

The petition is before the Office of Patent Legal Administration for decision.

The petition is **dismissed as moot**, for the reasons set forth below.

### DECISION

In the instant petition, third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on January 5, 2011. On April 5, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of non-compliance), stating that patent owner's December 6, 2010 response submission is defective and setting a time period of 15 days for patent owner to file a corrected response submission. Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] improper patent owner submission would also not be considered, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules. If a response to the Notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to the Notice, within 30 days from the date of service of the patent owner's response to the Notice." Accordingly, requester's January 5, 2011 petition requesting waiver of 37 CFR 1.943(b) for its concurrently filed comments submission is moot, and requester's January 5, 2011 petition is **dismissed as moot**.

### CONCLUSION

1. Third party requester's January 5, 2011 petition paper entitled "PETITION PURSUANT 37 C.F.R § 1.182, OR ALTERNATIVELY 37 C.F.R § 1.183 TO WAIVE OR SUSPEND THE PAGE LIMITATION OF C.F.R. § 1.943" is dismissed as moot.
2. Telephone inquiries with regard to this decision should be directed to Maria Nuzzolillo, at 571-272-8150 or Nicole Dretar Haines, Office of Patent Legal Administration, at (571) 272-7717.

/Kenneth M. Schor/

---

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

04-11-2011  
Kenpet8



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,543	05/24/2010	6,993,661	ESTL001USRE	5339
58293	7590	07/21/2011	EXAMINER	
FORTKORT & HOUSTON P.C. 9442 N. CAPITAL OF TEXAS HIGHWAY ARBORETUM PLAZA ONE, SUITE 500 AUSTIN, TX 78759			ART UNIT	PAPER NUMBER

DATE MAILED: 07/21/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
CESARI AND MCKENNA, LLP  
88 BLACK FALCON AVENUE  
BOSTON, MA 02210

Date: **MAILED**

**JUL 21 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000543  
PATENT NO. : 6993661  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Austin, TX 78759

(For Patent Owner)

MAILED

JUL 21 2011

CENTRAL REEXAMINATION UNIT

Cesari and McKenna, LLP  
88 Black Falcon Avenue  
Boston, MA 02210

(For Third Party Requester)

*In re Garfinkel*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,543  
Filed: May 24, 2010  
For: U.S. Patent No. 6,993,661

:  
: **DECISION**  
: **GRANTING**  
: **PETITION**  
:

This is a decision on the third party requester's paper entitled "PETITION PURSUANT 37 C.F.R. §1.182, OR ALTERNATIVELY 37 C.F.R. §1.183 TO WAIVE OR SUSPEND THE PAGE LIMITATION OF 37 C.F.R. §1.943" (the petition under 37 CFR 1.183), filed on May 18, 2011.

The third party requester petition is being treated under 37 CFR 1.183 and is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is granted, for the reasons set forth herein.

**BACKGROUND**

1. U.S. Patent Number 6,993,661 (the '661 patent) issued to *Garfinkel* on January 31, 2006, with claims 1-41.
2. On February 9, 2010, an *Ex Parte* Reexamination Certificate (7362nd) issued for the 90/009,152 *ex parte* reexamination proceeding, stating that claims 1-3, 5-10, 16, 18-21, 29-31, 40 and 41 are cancelled, new claims 42-53 are added and determined to be patentable, and claims 4, 11-15, 22-28 and 32-39 were not reexamined.
3. A request for *inter partes* reexamination of the '661 patent was deposited by a third party requester on May 24, 2010, which request was assigned Reexamination Control No. 95/000,543 (the '543 proceeding). NetApp, Inc. is identified as the real party in interest.



4. On July 28, 2010, an order granting *inter partes* reexamination of claims 42-53 of the '661 patent was mailed for the '543 proceeding.
5. On October 6, 2010, the Office mailed a non-final Office action in the '543 proceeding.
6. On December 6, 2010, patent owner filed a response after the October 6, 2010 Office action, including an amendment to the claims.<sup>1</sup>
7. On January 5, 2011, third party requester filed a paper entitled "PETITION PURSUANT 37 C.F.R. §1.182, OR ALTERNATIVELY 37 C.F.R. §1.183 TO WAIVE OR SUSPEND THE PAGE LIMITATION OF 37 C.F.R. §1.943," requesting waiver of the page limit for third party requester's concurrently-submitted comments submission.
8. On April 5, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of non-compliance), stating that patent owner's December 6, 2010 response does not comply with regulatory page limit and giving patent owner a time period of 15 days to make an appropriate correction.
9. On April 14, 2011, the Office mailed a decision dismissing third party requester's January 5, 2011 petition paper as moot.
10. On April 18, 2011, patent owner filed a corrected response submission, responsive to the April 5, 2011 notice of non-compliance.
11. On May 18, 2011, third party requester filed the instant petition under 37 CFR 1.183, concurrently with its comments submission.

## DECISION

### I. Relevant Statutes, Regulations and Procedures

#### **37 CFR 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

#### **37 CFR 1.943(b) provides:**

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

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<sup>1</sup> Patent owner filed a corrected claim amendment on December 8, 2010. In the claim amendment, patent owner amended claims 46-53 and presented new claims 54-69.

## II. Third Party Requester May 18, 2011 Petition under 37 CFR 1.183

On May 18, 2011, third party requester filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of a comments submission of up to 61 pages.<sup>2</sup>

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of resulting comments that are in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such comments can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments: (1) for justification that more pages are needed to complete the comments, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the comments.

In support of waiver of the rule, requester asserts that in its response, patent owner presents 16 new claims and has amended 8 claims.<sup>3</sup> Requester also asserts that it “has made a serious effort to economize by reducing the number of pages included in its previous January 5, 2011 submission” and that “[n]otably, Requester’s Comments as concurrently filed are 24 pages in length, which is a reduction of 6 pages as compared with Requester’s previous submission.”<sup>4</sup> Additionally, requester has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, and accompanying declaration and claim charts, which in total exceed 50 pages.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that

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<sup>2</sup> Third party requester petition under 37 CFR 1.183 at page 2 (stating that “Requester petitions for leave to file up to 11 additional pages for a total of up to 61 pages including Requester’s Comments, the Declaration Under 37 C.F.R. § 1.132 of Paul C. Clark, Ph.D., ... and Proposed New Grounds of Rejection Under 37 C.F.R. § 1.948(a)(2) for Amended Claims 46-53 and New Claims 54-69 (claim charts), but excluding reference materials such as prior art references.”)

<sup>3</sup> *Id.* at 5.

<sup>4</sup> *Id.*

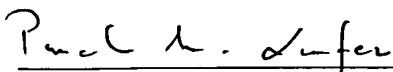
swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, the May 18, 2011 comments submission includes 24 pages of remarks. Additionally the comments submission includes a 13-page declaration by Dr. Paul C. Clark (the Clark declaration) and a 24-page claim chart entitled "Proposed New Grounds of Rejection under 37 CFR 1.948(a)(2) for Amended Claims 46-53 and New Claims 54-69" (the claim chart). Based on the guidance set forth above, the Clark declaration is deemed to include legal argument (*e.g.*, as to the obviousness of the claims) and is subject to the regulatory page limit count. The claim chart is also subject to the regulatory page limit count. Based on the individual facts and circumstances of this case such as, for example, the 16 claims newly added by patent owner, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that third party requester's May 18, 2011 comments submission exceeds the regulatory page limit by up to 11 pages.

Accordingly, requester's May 18, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting third party requester's May 18, 2011 comments submission to exceed the regulatory page limit by up to 11 pages. This waiver makes third party requester's May 18, 2011 comments submission page-length compliant.

### CONCLUSION

1. Third party requester's May 18, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's May 18, 2011 comments submission to exceed the page limit by up to 11 pages. This waiver makes requester's May 18, 2011 comments submission page-length compliant.
2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

07-19-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR ,	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,544	06/16/2010	6,663,738		7451
27885	7590	10/27/2010	EXAMINER	
FAY SHARPE LLP 1228 Euclid Avenue, 5th Floor The Halle Building Cleveland, OH 44115			ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

STEVEN J. GROSSMAN

GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC

55 SOUTH COMMERICAL STREET

MANCHESTER, NH 03101

Date:

**MAILED**

**OCT 27 2010**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000544

PATENT NO. : 6663738

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FAY SHARPE LLP  
1228 EUCLID AVENUE, 5th FLOOR  
THE HALLE BUILDING  
CLEVELAND, OH 44115

(For Patent Owner)

**MAILED**

**OCT 27 2010**

**CENTRAL REEXAMINATION UNIT**

STEVEN J. GROSSMAN  
GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC  
55 SOUTH COMMERICAL STREET  
MANCHESTER, NH 03101

(For Requester)

*In re Ohlinger et al.*  
Reexamination Proceeding  
Control No. 95/000,544  
Filed: June 16, 2010  
For: U.S. Patent No. 6,663,738

:  
: DECISION ON  
: PETITION UNDER  
: 37 CFR 1.927  
:

The third party Requester filed a paper on August 25, 2010, entitled "Request For Review Of Denial Of Petition Under 37 CFR 1.927" (hereinafter the petition). The petition is before the Director of the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Ex Parte* Reexamination mailed July 27, 2010. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references and other evidence cited.

The Petition is **DENIED**.

## REVIEW OF FACTS

1. U.S. Patent No. 6,663,738 (hereinafter, the '738 patent) issued on December 16, 2003.
2. A request for *ex parte* reexamination was filed on June 16, 2010. The resulting reexamination proceeding was assigned Control No. 95/000,544. Reexamination was requested for claims 1-11 of the '738 patent.
3. A Notice of Reexamination Request Filing Date was issued on June 21, 2010.
4. An order denying the request for reexamination was mailed on July 27, 2010.
5. On August 25, the third party requester filed the present petition under 37 CFR § 1.181.

## **Petitioner's Grounds in Support of the Requested Relief**

Petitioner (the third party requester) alleges that the examiner's denial of the request for reexamination is improper because the examiner improperly concluded that the Scholz reference is not being considered in a new light.

## DECISION

### I. Standard of Review

37 CFR 1.515(c) and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *ex parte* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-11 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-11 of the '738 patent. Consideration is limited to whether the cited patents and printed publications raise a substantial new question of patentability (SNQ) to patent claims 1-11. The review will not consider evidence not of record at the time of the request for reexamination (e.g., evidence made of record for the first time in the petition) nor any additional SNQs proposed for the first time in the petition.

### II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.510 shows that *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *ex parte* reexamination of the patent is issued.

In order to raise a SNQ for old art, the old art must be presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. A SNQ is not raised by the old prior art, however, if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,<sup>1</sup> Congress stated:

"Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old

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<sup>1</sup> Public Law 96-517, enacted on December 12, 1980.



information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination. Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request."<sup>2,3</sup> This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *ex parte* reexamination of the patent is issued. MPEP 2247 provides guidelines for such an order, and requires that the examiner's decision in the order state, for each patent and printed publication cited in the request, why the citation is:

- (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
- (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
- (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or
- (D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2242 subsection II. A.

Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester, which is based on patents or printed publications.

<sup>2</sup> See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

<sup>3</sup> For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al.*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, \*\*16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

### III. Analysis of the Request for Reexamination

Requester considers claims 1-28 unpatentable over Scholz, alone or in combination with McKay or Deanin.

Scholz discloses a method for production of a deep-drawn article from a partially crystalline polymeric material. The method appears very similar to the method claimed in the '738 patent, but Scholz is silent with regard to the degree of gel formation produced by the irradiation process.

McKay is cited in the Request for its teaching that varying exposure to radiation can control the gel content of a polymer.

Deanin is an excerpt from a textbook which shows that the physical properties of thermoset plastics are affected by the degree of crosslinking between polymer strands.

The Request also provides the declaration of Dr. Srinivas Sitaram, which purports to show that Scholz inherently anticipates claim 1 of the '738 patent.

MPEP 2112 states that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

The evidence provided in the Sitaram declaration does not meet this criterion. Dr. Sitaram conducted a limited number of experiments "pursuant to the teaching of the '335 patent" in which a product meeting the limitations of claim 1 of the '738 patent was produced. This does not amount to a showing that all possible combinations of starting materials and reaction conditions encompassed by the Scholz disclosure will necessarily yield a product meeting the limitations of claim 1, which would establish inherent anticipation. Nor is it clear that Dr. Sitaram followed a procedure identical to one of Scholz's working examples, which also could establish inherent anticipation.

The Sitaram declaration argues that the '738 patent teaches that embossing stability is only achieved when gel content is 15 – 65% and, since Scholz observed embossing stability, Scholz must have produced a foil with gel content of 15-65%. This argument is not persuasive because the cited portion of the '738 patent indicates that the foil should be irradiated to achieve a gel content of 5-80%. Therefore it appears that foils with gel content of 5-15% or 65-80% should also exhibit embossing stability, and Dr. Sitaram's premise is incorrect. The declaration does not provide any empirical evidence on this point.

Scholz was considered during prosecution of the '738 patent. If there were convincing evidence that Scholz inherently anticipates the '738 patent claims, then the reference would be viewed in a new light because this possibility was not previously considered. But since the Sitaram declaration does not provide such evidence, and neither McKay nor Deanin address this issue, inherency has not been established and there is no SNQ. Requester is reminded that the evidence newly submitted with the instant petition has not been considered.

Turning to the petition, Requester argues that the Office was incorrect to focus on the method by which gel content was measured. This argument is not persuasive because, regardless of how gel content is measured, the limited experimental data provided in the Sitaram declaration is not sufficient to support a conclusion of inherent anticipation for the reasons discussed above.

Requester further argues that the Office did not consider the technical reasoning provided in the Sitaram declaration. This argument is not persuasive because the '738 patent specification simply does not say that embossed grain retention requires a foil gel content of 15-65%, as noted above.

## CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is DENIED.
2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.
3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535, or in her absence to the undersigned at (571) 272-3838.

---

Gregory A. Morse, Director  
Central Reexamination Unit

Scholz was considered during prosecution of the '738 patent. If there were convincing evidence that Scholz inherently anticipates the '738 patent claims, then the reference would be viewed in a new light because this possibility was not previously considered. But since the Sitaram declaration does not provide such evidence, and neither McKay nor Deanin address this issue, inherency has not been established and there is no SNQ. Requester is reminded that the evidence newly submitted with the instant petition has not been considered.

Turning to the petition, Requester argues that the Office was incorrect to focus on the method by which gel content was measured. This argument is not persuasive because, regardless of how gel content is measured, the limited experimental data provided in the Sitaram declaration is not sufficient to support a conclusion of inherent anticipation for the reasons discussed above.

Requester further argues that the Office did not consider the technical reasoning provided in the Sitaram declaration. This argument is not persuasive because the '738 patent specification simply does not say that embossed grain retention requires a foil gel content of 15-65%, as noted above.

## CONCLUSION

1. Based on a *de novo* review of the record as a whole, the PETITION is DENIED.
2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.
3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.



---

Irem Yucel, Director  
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,545	05/11/2010	RE40220	2986.001REX0	7676
26111	7590	02/17/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-17-11

Michael J. Mallie

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

1279 Oakmead Parkway

Sunnyvale, CA 94085-4040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000545

PATENT NO. : re40220

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FEB 17 2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For Patent Owner)  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP (For Third Party Requester)  
1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040

In re *Nichols et al.* :  
*Inter Partes* Reexamination Proceeding : **DECISION**  
Control No. 95/000,545 : **DISMISSING**  
Filing Date: May 11, 2010 : **PETITION**  
For: U.S. Patent No. RE 40,220 E :

This is a decision on the November 30, 2010 patent owner petition under 37 C.F.R. §§ 1.182 and 1.987, requesting that the above-captioned *inter partes* reexamination proceeding be suspended. This decision also treats the December 14, 2010 third party requester<sup>1</sup> opposition under 37 C.F.R. § 1.182 to patent owner's petition requesting suspension of the *inter partes* reexamination proceeding.

The patent owner petition and the third party requester opposition are before the Office of Patent Legal Administration for consideration.

For the reasons set forth below, the patent owner petition requesting suspension of the reexamination proceeding is **dismissed**.

**BACKGROUND**

1. U.S. Patent No. RE 40,220 E (the '220 patent) issued to Nichols et al. on April 8, 2008.
2. The '220 patent is the subject of concurrent litigation captioned *LML Patent Corp. v. JP Morgan Chase & Co. et al.*, (U.S. Dist. E.D. Tex.), Case No. 2:08-cv-00448-DF. The complaint was filed on November 19, 2008, a copy of which is attached as Exhibit A to the patent owner petition filed on November 30, 2010.

<sup>1</sup> The real parties in interest pursuant to 37 C.F.R. § 1.915(b)(8) are M&I Marshall & Ilsley Bank, Deutsche Bank Trust Co. Americas, the Bank Of New York Mellon Corp., and PayPal, Inc., which are collectively referred to herein as "the third party requester."

3. On May 11, 2010, a request for *inter partes* reexamination of claims 67-70, 72, 74-80, 82-84, and 93 of the '220 patent was filed by a third party requester, which proceeding was assigned Control no. 95/000,545 (the '545 proceeding). The real parties in interest are M&I Marshall & Ilsley Bank, Deutsche Bank Trust Co. Americas, the Bank Of New York Mellon Corp., and PayPal, Inc., all of which are parties to the concurrent civil litigation.
4. On July 26, 2010, reexamination was ordered in the '545 proceeding. Concurrently, a first Office action was mailed, rejecting claims 67-70, 72, 74-80, 82-84, and 93 of the '220 patent. Claims 5-66, 71, 73, 81, 85-92, and 94-103 of the '220 patent were not and are not subject to reexamination.
5. On September 8, 2010, patent owner filed a petition under 37 C.F.R. § 1.956, requesting a one month extension of time to file its response to the Office action.
6. On September 15, 2010, the Office mailed a decision granting the patent owner petition under 37 C.F.R. § 1.956 for a one month extension of time. The time for filing a patent owner's response to the Office action was extended to October 26, 2010.
7. On October 26, 2010, the patent owner filed a response to the July 26, 2010 Office action.
8. On November 26, 2010, the third party requester filed written comments after the October 26, 2010 patent owner response.
9. On November 30, 2010, the patent owner filed the instant petition entitled "Patent Owner Petition Under 37 C.F.R. §§ 1.182 & 1.987 to Suspend Reexamination Proceedings Pending Litigation."
10. On December 14, 2010, the third party requester filed the instant opposition entitled "Requester's Opposition under 37 C.F.R. § 1.182 to Patent Owner's Petition to Suspend *Inter Partes* Reexamination Proceeding."

## DECISION

### I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 314(c) states:

SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

35 U.S.C. § 317(b) states:

FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent



claim in suit or if final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.

37 C.F.R. § 1.907(b) states:

Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

37 C.F.R. § 1.937(a) states:

All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

37 C.F.R. § 1.987 states:

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

The Manual of Patent Examining Procedure (MPEP) § 2686.04, subsection V, states (in part):

\*\*\*\*\*

The statute thus authorizes the Director of the USPTO to suspend (stay) reexamination proceedings, where there is good cause to do so, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite

statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding. Any such fact situation is resolved on a case-by-case basis.

In any *inter partes* reexamination where the requester (or its privies) is also a party to ongoing or concluded litigation as to the patent for which reexamination has been requested, the potential for this statutory estoppel to attach must be considered.

\*\*\*\*\*

Taking the above into account, the following factors are to be considered in determining whether it is appropriate to refuse to order an *inter partes* reexamination, terminate the reexamination, or suspend action in the reexamination, based on litigation in which the reexamination requester is a party to the litigation.

(A) The 35 U.S.C. 317(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. The estoppel does not apply to non-litigated patent claims. Where there are non-litigated claims for which reexamination had been requested in the *inter partes* reexamination request, the reexamination proceeding is to go forward based on those non-litigated claims. If, however, during the reexamination proceeding, the patent owner disclaimed all the non-litigated claims, leaving only litigated claims, the proceeding is to be referred to the Office of Patent Legal Administration (OPLA).

(B) The 35 U.S.C. 317(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. The estoppel does not apply where new issues are raised in the request. If the request provides new art/issues not raised in the litigation (civil action), and which could not have been so raised, then estoppel does not attach. The patent owner has the burden of showing that the art and issues applied in the request was available to the third-party requester and could have been placed in the litigation.

(C) The 35 U.S.C. 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued. If there remains any time for an appeal, or a request for reconsideration, from a court (e.g., District Court or Federal Circuit) decision, or such action has already been taken, then the decision is not final, and the estoppel does not attach. A stay/suspension of action may be appropriate for the reexamination proceeding if the litigation has advanced to a late enough stage and there is sufficient probability that a final decision will be adverse to the requester; however, that is a matter to be discussed with the OPLA in any such instance.

(D) Is there a concurrent *ex parte* reexamination proceeding for the patent?

## II. DISCUSSION

### A. Patent Owner Requests Suspension of the '545 Proceeding

Petitioner patent owner asserts that good cause exists to suspend the '545 proceeding for the following reasons: (1) the civil litigation is at an advanced stage, while the '545 proceeding is in its early stages;<sup>2</sup> (2) the third party requester in the '545 proceeding is a party to the civil litigation;<sup>3</sup> (3) all of the references relied upon by the third party requester in requesting reexamination were asserted as invalidating references in the civil litigation, and the requester has therefore raised substantially identical invalidity arguments in the reexamination as those in the concurrent litigation;<sup>4</sup> and (4) substantially identical claims are involved in both the civil litigation and the '545 proceeding.<sup>5</sup>

Further as to reason (4), petitioner contends that "[i]ndependent claims 67, 75, and 83, as well as dependent claims 68 and 77," which are not currently asserted in the litigation, "are still effectively asserted in the litigation because claims that depend from each are still asserted in the litigation, thereby incorporating by reference each of the claimed features."<sup>6</sup> Petitioner acknowledges that only claim 76 is not currently asserted, either directly or indirectly through claim dependency, in the litigation and that petitioner is "willing to stipulate that the patentability of claim 76 in the reexamination rises and falls with the fate of claim 75 in the litigation if a reexamination suspension is granted."<sup>7</sup>

In addition, petitioner points to *Sony Computer Entertainment America Inc. v. Dudas*, No. 05-01447, 2006 U.S. Dist. LEXIS 36856 (E.D. Va. May 22, 2006) to support its request for suspension. Petitioner asserts that the court in *Sony* "explained that, in light of the *inter partes* estoppel provisions, the Office may properly suspend reexamination where concurrent litigation is at a more advanced stage."<sup>8</sup>

Finally, petitioner contends that suspending the reexamination will not unfairly prejudice the third party requester since the requester "created the circumstances that make a suspension of reexamination appropriate by waiting more than a year and a half after the filing of the Texas litigation to commence this reexamination."<sup>9</sup>

Accordingly, petitioner requests that the Office suspend the '545 proceeding pending final resolution of the concurrent litigation.<sup>10</sup>

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<sup>2</sup> Petition at 2 and 3.

<sup>3</sup> *Id.* at 2.

<sup>4</sup> *Id.* at 2 and 4.

<sup>5</sup> *Id.* at 5.

<sup>6</sup> *Id.* at 3 n.1. Claims 67-70, 72, 74-80, 82-84, and 93, the same as those currently under reexamination, were originally asserted in the litigation; the currently asserted claims in the litigation are 69, 70, 72, 74, 78-80, 82, 84, and 93, as stated on page 3 of the patent owner petition.

<sup>7</sup> *Id.* at 3.

<sup>8</sup> *Id.* at 5.

<sup>9</sup> *Id.* at 6-7.

<sup>10</sup> *Id.* at 7.

## B. Findings and Analysis

### 1. Factors to be Considered in Determining Whether Suspension is Appropriate

The factors to be considered in determining whether it is appropriate to suspend or terminate action in an *inter partes* proceeding based on litigation in which the third party requester is a party to the civil litigation are detailed in MPEP 2686.04, subsection V, reproduced above.

Factor (A) in MPEP 2686.04 states that 35 U.S.C. § 317(b) estoppel applies only to patent claims that were litigated in the suit, i.e., litigated claims. In this instance, the concurrent litigation and the '545 proceeding do not involve the same claims of the '220 patent. Petitioner's argument that non-litigated claims 67, 68, 75, 77, and 83 are still effectively asserted in the litigation, directly or indirectly through claim dependencies of the asserted claims, is unpersuasive for at least the following reason: The district court's finding that the narrower, asserted claims are valid does not mean that the broader, non-asserted claims from which the asserted claims depend, are also valid. The district court will not decide the issue of validity for the non-asserted claims, including non-asserted claim 76. Petitioner's offer to stipulate the validity of claim 76 to the fate of asserted claim 75 in the litigation does not remove claim 76 from the patent. In order to meet Factor (A), the petitioner must statutorily disclaim non-litigated claims 67, 68, 75-77, and 83.

Assuming, *arguendo*, that the 35 U.S.C. § 317(b) estoppel provisions were to attach to the asserted (litigated) claims in this instance, the reexamination proceeding would nevertheless go forward based on the non-asserted (non-asserted) claims for which reexamination had been requested. The estoppel provisions of 35 U.S.C. § 317(b) attach on a claim-by-claim basis and do not attach to claims that were not subject to the litigation. No final decision, let alone any decision, will be reached regarding the validity of the non-asserted claims.

Factor (B) in MPEP 2686.04 states that the 35 U.S.C. § 317(b) estoppel applies only to issues which the requester or its privies raised or could have raised in the civil action. In this instance, the petitioner has not presented any evidence that the third party requester has applied the same prior art in the same manner in both the reexamination proceeding and the concurrent litigation, and that third party requester has raised or could have raised the same issues in the civil action that are now raised in the reexamination proceeding. The petitioner's argument that the third party requester has raised substantially identical invalidity arguments in the reexamination proceeding as in the litigation because the same references applied in the reexamination proceeding were asserted in the litigation is unpersuasive.<sup>11</sup> The third party requester's reliance on the same prior art references in both the reexamination proceeding and in the civil litigation does not mean that the same issues were raised or could have been raised in both proceedings.<sup>12</sup> Third party requester asserts, in its opposition to the present petition, that the district court will be using a claim interpretation that is narrower than the broadest reasonable interpretation standard which the Offices uses in reexamination.<sup>13</sup> Therefore, the requester contends that issues of claim patentability decided in the district court and in the '545 reexamination proceeding will not be duplicative.<sup>14</sup>

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<sup>11</sup> *Id.* at 4.

<sup>12</sup> It is further noted that petitioner patent owner merely alleges that the issues are the same without any reference to the record of the litigation and the instant reexamination proceeding to establish that prior art and issues are the same in both the reexamination proceeding and in the concurrent litigation.

<sup>13</sup> Opposition at 6.

<sup>14</sup> *Id.* at 6-7.

Absent probative evidence from the petitioner that the requester has raised or could have raised the same issues in the litigation as those presented by the requester in the reexamination proceeding, the petitioner has not met Factor (B).

Factor (C) in MPEP 2686.04 states that the 35 U.S.C. § 317(b) estoppel applies only in a situation where a final decision adverse to the requester has already been issued. A final decision comes only after all appeals have been exhausted. In this situation, the litigation information presented in the petition shows that the concurrent litigation is in its pretrial stages, with jury selection set to begin on March 8, 2011.<sup>15</sup> There has been no decision on the claims and there is no indication from the course of the proceedings thus far that makes it probable that the final decision would be adverse to the requester. Furthermore, any final decision that could be rendered would not bear on all of the claims that are under reexamination in this proceeding, which are claims 67-70, 72, 74-80, 82-84, and 93, since invalidity is only asserted for claims 69, 70, 72, 74, 78-80, 82, 84, and 93 of the '220 patent in the concurrent litigation. Since the concurrent litigation is in its pretrial stages, there is no evidence of sufficient probability that a final decision will be adverse to the requester.

With respect to Factor (D) in MPEP 2686.04, there is no concurrent *ex parte* proceeding for the '220 patent.

In view of the above, the present facts and circumstances in this instance do not satisfy Factors (A)-(C) in MPEP 2686.04 that are relevant to this reexamination proceeding. Therefore, it is not appropriate to suspend the present reexamination proceeding at this time.

## 2. The *Sony* Decision Does Not Support Petitioner's Request For Suspension of the Present Proceeding

The petitioner argues that the *Sony* decision provides support for its request to suspend the present proceeding.<sup>16</sup> However, the facts and circumstances of this proceeding do not even parallel those in *Sony*, in which the district court affirmed the Office's finding of good cause to suspend two *inter partes* reexamination proceedings. Unlike the present situation, the asserted claims and the claims of the two patents under reexamination (after the patent owner had statutorily disclaimed the non-asserted claim in each of the two patents involved in the litigation) in *Sony* were identical.<sup>17</sup> The relative stages of the concurrent litigation and the reexamination proceeding in this situation also differ from those in *Sony*. In *Sony*, the Federal Circuit appeal was nearing its conclusion whereas the reexamination proceedings were at their beginning stages (i.e., the Office's work had been limited to only a finding that the requests for reexamination had raised a substantial new question of patentability).

The relative stages between the concurrent litigation and the reexamination proceeding in this situation are much closer. In this instance, the litigation is in its pretrial stages as evidenced by the information provided by the petitioner,<sup>18</sup> and a final decision either adverse to requester or patent owner is not expected any time soon. According to the petitioner, the court entered a Markman order on August 4, 2010 and that jury selection is set to begin on March 8, 2011. It is uncertain at this point in the concurrent litigation whether the district court's decision, or even a final decision will be adverse to the third party requester; at this

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<sup>15</sup> Petition at 2.

<sup>16</sup> *Id.* at 5.

<sup>17</sup> *Sony*, 2006 U.S. Dist. LEXIS 3856, at \* 6.

<sup>18</sup> Petition at 2 and 6.

point, a broad range of possible outcomes exists for the concurrent litigation. It is entirely possible that the district court may decide that only some of the asserted claims are valid or it may not reach the issue of claim validity if the infringement rulings are dispositive. Furthermore, if the third party requester were to appeal the district court's decision, the Federal Circuit could reverse or vacate and remand the case back to the district court in the far distant future.

Furthermore, the present reexamination proceeding has advanced significantly beyond the beginning stages, as compared to the situation in *Sony*. Specifically, in this reexamination proceeding, the Office has issued a non-final Office action, the patent owner has filed a response to the Office action, and the third party requester has filed comments after the patent owner response. Thus, patentability issues have been defined and argued by the parties, and the Office's work in this proceeding is not limited to merely finding that the requests for reexamination raised a substantial new question of patentability (at which point a patentability determination has not yet been made).

Moreover, the third party requester's timing in filing this present proceeding does not compare to the situation in *Sony*.<sup>19</sup> In this instance, the third party requester has filed its reexamination request much earlier than the third party requester in *Sony* and before any decision has been made by the court in the concurrent litigation. In *Sony*, the third party requester filed its requests for *inter partes* reexamination after three years of litigation and only after the district court entered its judgment in patent owner's favor.<sup>20</sup> The third party requester's delay in *Sony* was the reason that the two reexamination proceedings could very well be mooted before any reexamination decision issued.<sup>21</sup> In this instance, jury selection (scheduled to begin on March 8, 2011) and trial have not even started. The present reexamination proceeding was filed on May 11, 2010, and not after a decision adverse to the requester had been issued in the concurrent litigation. Since the race in the concurrent litigation is far from over in this instance, there is no potential in the near future for the estoppel provisions of 35 U.S.C. § 317(b) to moot the present reexamination proceeding.

Finally, the petitioner's assertion that "[s]uspending this reexamination is consistent with the principal that a party should not be allowed "to run both horses in [validity] races" is at odds with the statute.<sup>22</sup> The statute clearly permits a party to pursue both *inter partes* review from the Office and litigation.<sup>23</sup> While Congress desired that the creation of an *inter partes* reexamination option would lead to a reduction in expensive patent litigation, it nonetheless also provided in the statute that a court validity challenge and *inter partes* reexamination of a patent may occur simultaneously; but once one proceeding finally ends in a manner adverse to a third party, then the issues raised (or that could have been raised) with respect to the validity of a claim in that proceeding would have estoppel effect on the same issues in the other proceeding. See MPEP 2686.04, Section V.

### 3. Good Cause For Suspension Has Not Been Shown

In *Ethicon v. Quigg*,<sup>24</sup> the Federal Circuit addressed the propriety of the Office suspending reexamination proceedings. The court considered whether the Commissioner had "authority

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<sup>19</sup> *Id.* at 6.

<sup>20</sup> *Sony*, 2006 U.S. Dist. LEXIS 3856, at \*4.

<sup>21</sup> *Id.* at \* 22.

<sup>22</sup> Petition at 6.

<sup>23</sup> *Sony*, 2006 U.S. Dist. LEXIS 3856, at \*19.

<sup>24</sup> *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988).

to stay reexamination pending the outcome of district court litigation."<sup>25</sup> The Federal Circuit held that an indefinite suspension, granted under the authority of 37 C.F.R. § 1.565(b) was not consistent with the statutory requirement of 35 U.S.C. § 305 of conducting reexamination proceedings in the Office with special dispatch.

"Special dispatch" is not defined in the statute. However, "a fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning." *Perrin v. United States*, 444 US. 37, 42, 62 L. Ed. 2d 199, 100 S. Ct. 311 (1979); see *LSI Computer Systems, Inc. v. United States Int'l Trade Comm'n*, 832 F. 2d 588, 590, 4 USPQ2d 1705, 1707 (Fed. Cir. 1987). According to Webster's New World Dictionary, special means distinctive, unique, exceptional, or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary, and common meaning of special dispatch envisions some type of unique, extraordinary, or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that "reexamination proceedings will be 'special' throughout their pendency" in the office, and provides for an accelerated schedule. MPEP § 2261. ***Whatever else special dispatch means, it does not admit of an indefinite suspension of reexamination proceedings pending conclusion of litigation.*** If it did, one would expect to find some intimation to that effect in the statute, for it would suggest the opposite of the ordinary meaning. But there is none. [Emphasis added] (*Ethicon*, at 1426.)

Petitioner has requested an indefinite suspension in this *inter partes* reexamination proceeding, which also must be conducted with special dispatch in the same manner as *ex parte* reexamination proceedings must be conducted with special dispatch. The *inter partes* reexamination statute (35 U.S.C. § 314(c)) does provide an exception to the special dispatch mandate where "otherwise provided by the Director for good cause"; thus, a suspension may be granted for "good cause." However, in view of the discussion above, the facts and circumstances of this case do not support a finding of good cause pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 1.987 to suspend the '545 proceeding. Therefore, the petition is dismissed, and the reexamination proceeding will be continued with special dispatch within the Office.

## CONCLUSION

1. The patent owner petition for suspension filed on November 30, 2010 is dismissed.
2. All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

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<sup>25</sup> *Id.* at 1425.

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Central Reexamination Unit

By hand: Customer Service Window  
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401 Dulany Street  
Alexandria, VA 22314

For EFS-Web transmissions, 37 C.F.R. §§ 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 C.F.R. §§ 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to the present decision should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711, or, in her absence, Pinchus M. Laufer, Senior Legal Advisor, at 571-272-7726.

/Kenneth M. Schor/

---

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

2-15-11  
Kenpet8/





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,546	05/11/2010	7289386	19473-0052RX1	8688
20995	7590	10/29/2010	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 10/29/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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P.O. BOX 1022

Minneapolis, MN 55440-1022

Date:

**MAILED**

**OCT 29 2010**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000546

PATENT NO. : 7289386

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE CA 92614

(For Patent Owner)

**MAILED**

**OCT 29 2010**

FISH & RICHARDSON P.C.  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440

**CENTRAL REEXAMINATION UNIT**  
(For Third Party Requester)

In re Bhakta. *et al.*

*Inter Partes* Reexamination Proceeding

Control No: 95/000,546

Filing Date: May 11, 2010

For: U.S. Patent No.: 7,289,386 B2

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**DECISION DISMISSING  
PETITION TO SUSPEND  
INTER PARTES PROCEEDING**

This is a decision on the patent owner petition filed on August 23, 2010, entitled "Petition To Stay *Inter Partes* Reexamination of U.S. Patent No. 7,289,386 Under 35 U.S.C. § 314(C)." A third party requester opposition to the petition was filed on September 1, 2010, and entitled "Opposition to Petition to Stay Reexamination."

The petition and opposition are before the Office of Patent Legal Administration for consideration as to whether the relief requested by patent owner is to be granted.

37 CFR 1.987 provides that "[I]f a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding." Thus, 37 CFR 1.987 provides authority for suspension of an *inter partes* reexamination proceeding where the patent being reexamined "is or becomes involved in litigation." The mechanism for requesting such a suspension, however, is not provided by the rules. Accordingly, the present petition is taken as a petition under 37 CFR 1.182. It is noted that the requisite petition fee of \$400 (for a petition under 37 CFR 1.182) has been paid by patent owner. The patent owner petition was accompanied by the petition fee under 37 C.F.R. § 1.17(f) of \$400.

The third party opposition is taken as a petition under 37 C.F.R. § 1.182 for entry and consideration of the opposition, and the petition fee under 37 C.F.R. § 1.17(f) of \$400 has been

charged to Deposit Account No. 06-1060, referencing docket no. 19473-0052RX1, as authorized at page 3 of the opposition paper.<sup>1</sup>

The patent owner's petition is **dismissed** for the reasons below, and reexamination will continue with special dispatch.

## BACKGROUND

1. Patent number 7,289,386 (the '386 patent) issued on October 30, 2007, with claims 1-13.
2. On August 29, 2008, the '386 patent became the subject of a concurrent proceeding styled *Google v. Netlist, Appeal No. 2008-4144*, U.S. District Court for the Northern District of California (*hereinafter* "District Court proceeding").
3. On May 11, 2010, a third party, Google, filed a complete request for *inter partes* reexamination of claims 1-12 that was assigned control no. 95/000,546 (the '546 proceeding).
4. On August 9, 2010, reexamination was ordered in the '546 proceeding for claims 1-12 of the '386 patent.
5. On August 23, 2010, patent owner filed the instant petition under 35 U.S.C. § 314(c) to suspend the '546 proceeding, entitled "Petition To Stay *Inter Partes* Reexamination of U.S. Patent No. 7,289,386 Under 35 U.S.C. § 314(C)."
6. On August 27, 2010, the Office mailed a non-final action rejecting claims 1-12 of the '386 patent.
7. On September 1, 2010, third party requester filed a paper opposing patent owner's petition to stay the proceeding, entitled "Opposition to Petition to Stay Reexamination."

## DECISION

### I. Pertinent Regulations

#### **35 U.S.C. § 314(c)**

(c) SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the

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<sup>1</sup> The opposition paper is taken as a petition under 37 C.F.R. § 1.182 since no entry right is otherwise provided in the regulations for such a paper that is not a written comment to a patent owner's response to an Office action on the merits.

Office.

**35 U.S.C. 317 *Inter partes* reexamination prohibited**

(a) ORDER FOR REEXAMINATION. — Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) FINAL DECISION. — Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an *inter partes* reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or *inter partes* reexamination proceeding, and an *inter partes* reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the *inter partes* reexamination proceedings.

**37 CFR § 1.907 *Inter partes* reexamination prohibited.**

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

**37 CFR § 1.987 Suspension of *inter partes* reexamination proceeding due to litigation.**

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

**37 CFR § 1.937 Conduct of *inter partes* reexamination.**

- (a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.
- (b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided.
- (c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

**II. Findings and Analysis**

Petitioner patent owner requests that this *inter partes* reexamination proceeding be suspended pending completion of the concurrent District Court proceeding.<sup>2</sup> The action at the district court remains ongoing, with the trial scheduled to begin on November 1, 2010.<sup>3</sup>

In *Ethicon v. Quigg*,<sup>4</sup> the Federal Circuit addressed the propriety of the Office suspending reexamination proceedings. The court considered whether the Commissioner had "authority to stay reexamination pending the outcome of district court litigation."<sup>5</sup>

The Federal Circuit held that an indefinite suspension, granted under the authority of 37 CFR 1.565(b) was not consistent with the statutory requirement of 35 U.S.C. 305 of conducting reexamination proceedings in the Office with special dispatch.

"Special dispatch" is not defined in the statute. However, "a fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning." *Perrin v. United States*, 444 U.S. 37, 42, 62 L. Ed. 2d 199, 100 S. Ct. 311 (1979); see *LSI Computer Systems, Inc. v. United States Int'l Trade Comm'n*, 832 F.2d 588, 590, 4 USPQ2d 1705, 1707 (Fed. Cir. 1987). According to Webster's New World Dictionary, special means distinctive, unique, exceptional, or extraordinary, and

<sup>2</sup> *Google v. Netlist*, Appeal No. 2008-4144, U.S. District Court for the Northern District of California.

<sup>3</sup> "Order for Pretrial Preparation," Patent owner petition at Exhibit E.

<sup>4</sup> *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988).

<sup>5</sup> *Id.* at 1425.

dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary, and common meaning of special dispatch envisions some type of unique, extraordinary, or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that "reexamination proceedings will be 'special' throughout their pendency" in the office, and provides for an accelerated schedule. MPEP § 2261. ***Whatever else special dispatch means, it does not admit of an indefinite suspension of reexamination proceedings pending conclusion of litigation.*** If it did, one would expect to find some intimation to that effect in the statute, for it would suggest the opposite of the ordinary meaning. But there is none. [Emphasis added] (*Ethicon*, at 1426.)

Patent owner petitioner has requested an "indefinite suspension" in this *inter partes* reexamination proceeding, which also must be conducted with special dispatch in the same manner as *ex parte* reexamination proceedings must be. The *inter partes* reexamination statute (35 U.S.C. 314(c)) does provide an exception to the special dispatch mandate where "otherwise provided by the Director for good cause"; however, a suspension may only be granted for "good cause."

Patent owner asserts that termination or suspension of this proceeding is proper because the reexamination request was filed one year after suit was filed for declaratory judgment of invalidity and non-infringement of the '386 patent, and that the lawsuit is now at an advanced stage whereas the reexamination is at an early stage.<sup>6</sup> In the present case, however, good cause has not been shown; accordingly, the requested relief will not be granted.

There has been no final decision on all of the claims under reexamination. A final decision comes into being after an initial court decision is rendered and all appeals of that decision have been exhausted (or the time for appeal has expired, with no appeal taken). The trial information set forth in the petition show that the District Court proceeding is still in the pretrial phase.<sup>7</sup> There has been no decision that the patent claims are valid, let alone a final decision following exhaustion of all appeals.

Good cause for suspension has not been shown. For *inter partes* reexamination, 35 U.S.C. 314 states: "Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." Good cause has not been shown as to why this proceeding should not be continued with special dispatch in accordance with § 314. The related District Court proceeding is still in the pretrial phase. As the court proceeding has not resulted in a final decision, no estoppel can attach that bars the third party from making an *inter partes* reexamination request or mandates termination of the proceeding. And, as pointed out above, a final decision that would bear on the validity of claims 1-12 under reexamination of the '386 patent is far off in the future. Thus, the proceeding must go forward, and there is no good cause to suspend it.

Stated another way, the fact that estoppel could attach as to some of the patent claims at some

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<sup>6</sup> Patent owner petition at 1.

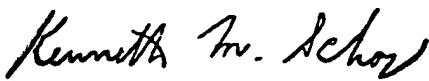
<sup>7</sup> "Order for Pretrial Preparation," Patent owner petition at Exhibit E.

uncertain point in the future, as argued by patent owner, is not a sufficient showing of good cause for suspension. Patent owner compares the facts of this situation to those in *Sony Computer Entertainment America, Inc. v. Dudas*, 2006 WL 1472462 (E.D. Va. 2006) in support of showing good cause for suspending these proceedings. However, the facts in *Sony* are distinguishable from this proceeding. Unlike this proceeding, the proceeding in *Sony* had advanced to the appellate stage following a decision of a District Court. As stated in *Sony*, "a party can choose to run horses in both races" until one is complete; in the instant case, the race is far from over in the litigation track.

In view of the above, the petition is dismissed, and the reexamination proceeding will continue with special dispatch within the Office.

### CONCLUSION

1. The patent owner petition for suspension filed on August 23, 2010 is dismissed.
2. The reexamination proceeding will not be stayed, and will proceed based on the Office action issued August 27, 2010.



---

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

October 27, 2010  
Kenpet8/





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,546 + 95/000,577	05/11/2010	7289386	19473-0052RX1	8688
20995	7590	03/03/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
FISH & RICHARDSON P.C.  
P.O. BOX 1022  
Minneapolis, MN 55440-1022

Date: 3-3-11

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000546 → 95/000577  
PATENT NO. : 7289386  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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IRVINE CA 92614

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

FISH & RICHARDSON P.C.  
PO BOX 1022  
MINNEAPOLIS, MN 55440-1022

(For first *Inter Partes* Requester)

ORRICK, HERRINGTON & SUTCLIFFE LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

(For second *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,546  
Filed: May 11, 2010  
For: U.S. Patent No. 7,289,386

:  
: **DECISION,**  
: ***SUA SPONTE*,**  
: **TO MERGE**  
: **REEXAMINATION**  
: **PROCEEDINGS**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,577  
Filed: October 20, 2010  
For: U.S. Patent No. 7,289,386

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

### REVIEW OF RELEVANT FACTS

1. On October 30, 2007, U.S. Patent No. 7,289,386 (the '386 patent) issued to Bhakta *et al.* with 13 claims.
2. On May 11, 2010, a first request for *inter partes* reexamination of claims 1-12 of the '386 patent, assigned control No. 95/000,546 ("the '546 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '546 requester").
3. On August 9, 2010, *inter partes* reexamination was ordered on claims 1-12 of the '386 patent in the '546 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

4. On August 27, 2010, a non-final Office action was mailed in the '546 proceeding, rejecting claims 1-12 of the '386 patent.
5. On October 20, 2010, a second request for *inter partes* reexamination of claims 1-13 of the '386 patent, assigned control No. 95/000,577 ("the '577 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '577 requester").
6. On October 27, 2010, patent owner timely filed, in the '546 proceeding, an amendment and response to the August 27, 2010 Office action, adding new claims 14-30. No claims were amended or canceled.
7. On November 26, 2010, third party request timely filed comments.
8. On January 18, 2011, *inter partes* reexamination was ordered on claims 1-13 of the '386 patent in the '577 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.
9. To date, no Office action has issued in the '577 *inter partes* proceedings, and no further Office action has issued in the '546 *inter partes* proceeding.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination is ordered in the two above-captioned proceedings for overlapping claims of the same patent. Both proceedings are *inter partes* reexamination proceedings. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/000,546 and 95/000,577 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. New claims 14-30 have been proposed by amendment in the '546 proceeding, while there is no corresponding amendment in the '577 proceeding. Thus, the claims are not currently the same in both files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947. It is to be noted that if the '546 requester chooses to file a comments paper after the patent owner response, the filing of such will be treated as comments in substitution for the comments filed on November 26, 2010. In that event, the November 26, 2010 comments paper would not be considered by the examiner. Accordingly, should '546

requester choose to file a substitute comments paper, then '546 requester should include any comments from the November 26, 2010 comments that it wishes considered in any such substitute comments paper.

### III. CONDUCT OF MERGED PROCEEDING

#### A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

#### B. *Inter partes* Third Party Requester Participation:

##### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, *e.g.* issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

##### 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (*i.e.*, the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

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<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '546 *inter partes* third party requester did not propose any rejections of claim 13 in the request for reexamination, the '546 requester does not have an appeal right to claim 13 as it appears in the '386 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to:           Attn: Mail Stop "*Inter Partes* Reexam"  
                          Central Reexamination Unit  
                          Commissioner for Patents  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

by FAX to:           (571) 273-9900  
                          Central Reexamination Unit

by Hand to:          Customer Service Window  
                          Attn: Central Reexamination Unit  
                          Randolph Building, Lobby Level  
                          401 Dulany Street  
                          Alexandria, VA 22314

by EFS:              Registered users may submit papers via the  
                          electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

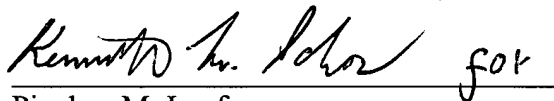
#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each

rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,546 and 95/000,577 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

 for

Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

March 1, 2011





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,546 <del>95/000,577</del>	05/11/2010	7289386	19473-0052RX1	8688
20995	7590	09/26/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 09/26/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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P.O. BOX 1022  
Minneapolis, MN 55440-1022

Date: 9-26-11

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000546 → 95/000577  
PATENT NO. : 7289386  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

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KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE CA 92614

(For Patent Owner)

FISH & RICHARDSON P.C.  
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MINNEAPOLIS, MN 55440-1022

(For first *Inter Partes* Requester)

ORRICK, HERRINGTON & SUTCLIFFE LLP  
IP PROSECUTION DEPARTMENT  
2050 MAIN STREET, SUITE 1100  
IRVINE, CA 92614

(For second *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,546  
Filed: May 11, 2010  
For: U.S. Patent No. 7,289,386

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:  
: **DECISION**  
: **GRANTING**  
: **PETITION**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,577  
Filed: October 20, 2010  
For: U.S. Patent No. 7,289,386

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This is a decision on patent owner's petition paper entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 CFR § 1.943(b)" filed on July 6, 2011.

The patent owner petition is before the Office of Patent Legal Administration.

The patent owner petition is granted, for the reasons set forth herein.

## BACKGROUND

1. On October 30, 2007, U.S. Patent No. 7,289,386 (the '386 patent) issued to Bhakta *et al.*
2. On May 11, 2010, a first request for *inter partes* reexamination of the '386 patent, assigned

control No. 95/000,546 (“the ‘546 proceeding”), was filed by a third party requester on behalf of real party in interest Google, Inc. (“the ‘546 requester”).

3. On August 9, 2010, *inter partes* reexamination was ordered in the ‘546 proceeding.
4. On August 27, 2010, a non-final Office action was mailed in the ‘546 proceeding.
5. On October 20, 2010, a second request for *inter partes* reexamination of the ‘386 patent, assigned control No. 95/000,577 (“the ‘577 proceeding”), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. (“the ‘577 requester”).
6. On October 27, 2010, patent owner timely filed, in the ‘546 proceeding, an amendment and response to the August 27, 2010 Office action.
7. On November 26, 2010, third party request timely filed comments in the ‘546 proceeding.
8. On January 18, 2011, *inter partes* reexamination was ordered in the ‘577 proceeding.
9. On March 3, 2011, the Office issued a Decision, *Sua Sponte*, merging the ‘546 and ‘577 *inter partes* proceedings (“the merged proceeding”).
10. On April 6, 2011, an Office action was issued in the merged proceeding, withdrawing the rejections previously set forth in the in the August 27, 2010 Office action in the ‘546 proceeding and setting forth new or revised grounds of rejection for the merged proceeding.
11. On July 6, 2011, patent owner filed the instant petition entitled “PATENTEE’S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 CFR § 1.943(b)” (patent owner petition under 37 CFR 1.183) concurrently with a patent owner response to the April 6, 2011 Office action.<sup>1</sup>

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

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<sup>1</sup> Patent Owner filed a “Request for Extension of time under 37 CFR 1.956” on April 15, 2011, seeking a one month extension of time to respond to the Office action mailed on April 6, 2011. The Office granted the petition for extension of time on April 22, 2011, thereby extending the time period for a response to the Office action by one month.

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## **II. Patent Owner Petition Under 37 CFR 1.183**

Patent owner's July 6, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the April 6, 2011 Office action, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner's July 6, 2011 response submission to permit patent owner to submit a 165-page response, including exhibits.<sup>2</sup> In particular, patent owner states that the "Response itself contains 44 pages of argument" and that "[t]aking the full lengths for the arguments of the Response and its three declarations, the 50-page count limit is exceeded by at most 115 pages, while excluding the exhibit pages, the 50-page count limit is exceeded by 33 pages."<sup>3</sup> Patent owner further states that it "attempted to comply with all relevant rules when preparing this Response" and that "despite Patentee's best efforts, the Response exceeded the page count limit...."<sup>4</sup>

In support of waiver of 37 CFR 1.943(b), patent owner states that "[b]ecause the large number of bases were compressed into a single Office Action, Patentee's ability to fully respond to each of the bases in the detailed manner required by 37 C.F.R. § 1.111, within the 50-page limit imposed by 37 C.F.R. § 1.943, is severely compromised."<sup>5</sup> Patent owner further asserts that "[t]he Office Action, on its face, is 31 pages long" but "expressly incorporates by reference substantial

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<sup>2</sup> Patent owner petition under 37 CFR 1.183 at page 4.

<sup>3</sup> *Id.* at page 2.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* at page 3.

portions of the third-party requesters' requests for reexamination" and that "[b]ecause of the incorporation by reference, the Office Action is effectively more than 350 pages long."<sup>6</sup>

### III. Findings and Analysis

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, patent owner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a response that is in excess of 50 pages. Based on the guidance set forth above, the July 6, 2011 response submission includes up to 80 pages of arguments. The remarks portion of the July 6, 2011 response includes 42 pages of arguments and 12 pages of support for the new and amended claims, and the 26-page declaration under 37 CFR 1.132 by Dr. Carl Sechen also includes legal argument and is being counted toward the regulatory page limit. The 8-page declaration by Christopher Lopes, submitted with attachments CL-A through CL-O, and the 5-page declaration by Hyun Lee, Ph.D., submitted with exhibits HL-B through HL-E, do not include legal argument and are not being counted toward the regulatory page limit.<sup>7</sup>

Based on patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and

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<sup>6</sup> Id. at page 4.

<sup>7</sup> Patent owner is reminded that to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission that: 1) is one-and-a-half or double-spaced; 2) is in a non-script type font (*e.g.*, Arial, Times New Roman, or Courier); 3) has a font size no smaller than 12-point; 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response submission. Because the declaration by Hyun Lee, Ph.D., is not being counted toward the regulatory page limit, the number of pages need not be accurately determined. Further, despite being single-spaced, the declaration by Hyun Lee, Ph.D., appears to have sufficient clarity and contrast.

submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case such as, for example, the size of the April 6, 2011 Office action, including the number of rejections and incorporation by reference of pages from the requests for *inter partes* reexamination in the '546 and '577 proceedings,<sup>8</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's July 6, 2011 response submission exceeds the regulatory page limit by up to 30 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the April 6, 2011 Office action to exceed the page limit by up to 30 pages. This waiver makes patent owner's July 6, 2011 response submission page-length compliant.

#### IV. Time Period for Submission of the Requesters' Comments

The '546 and '577 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 6, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission.

Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

- 1) is one-and-a-half or double-spaced;<sup>9</sup>
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

*See, generally*, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

#### CONCLUSION

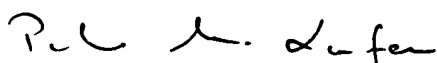
1. Patent owner's July 6, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 6, 2011 response submission to exceed the page limit by up to 30 pages. This waiver makes patent owner's July 6, 2011 response submission page-length compliant.

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<sup>8</sup> See Office action at pages 13-25.

<sup>9</sup> Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

2. The '546 and '577 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 6, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

9-22-2011





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,546	05/11/2010	7289386	19473-0052RX1	8688
25224	7590	01/18/2012	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2012

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Minneapolis, MN 55440-1022

Date:

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JAN 18 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000546

PATENT NO. : 7289386

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



and reexamination proceedings. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Knobbe Martens Olson & Bear LLP, 2040 Main Street, Fourteenth Floor, Irvine, CA 92614. Accordingly, all future correspondence will be directed to Knobbe Martens Olson & Bear LLP, 2040 Main Street, Fourteenth Floor, Irvine, CA 92614, unless, **within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123.**

## BACKGROUND

1. On October 30, 2007, U.S. Patent No. 7,289,386 (the '386 patent) issued to Bhakta *et al.*
2. On May 11, 2010, a first request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,546 ("the '546 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '546 requester").
3. On August 9, 2010, *inter partes* reexamination was ordered in the '546 proceeding.
4. On August 27, 2010, a non-final Office action was mailed in the '546 proceeding.
5. On October 20, 2010, a second request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,577 ("the '577 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '577 requester").
6. On October 27, 2010, patent owner timely filed, in the '546 proceeding, an amendment and response to the August 27, 2010 Office action.
7. On November 26, 2010, third party request timely filed comments in the '546 proceeding.
8. On January 18, 2011, *inter partes* reexamination was ordered in the '577 proceeding.
9. On March 3, 2011, the Office issued a Decision, *Sua Sponte*, merging the '546 and '577 *inter partes* proceedings ("the merged proceeding").
10. On April 6, 2011, a non-final Office action was issued in the merged proceeding.
11. On July 6, 2011, patent owner filed a petition entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 CFR § 1.943(b)", concurrently with a patent owner response to the April 6, 2011 Office action, including an amendment presenting new claims.<sup>1</sup>
12. On September 26, 2011 the Office issued a decision granting the July 6, 2011 patent owner

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<sup>1</sup> Patent Owner filed a "Request for Extension of time under 37 CFR 1.956" on April 15, 2011, seeking a one month extension of time to respond to the Office action mailed on April 6, 2011. The Office granted the petition<sup>9</sup> for extension of time on April 22, 2011, thereby extending the time period for patent owner's response to the Office action by one month.

petition for suspension of the page limit under 37 CFR 1.943(b). The decision included guidance on the time period for submission of third party requesters' comments.

13. On October 26, 2011, the '577 requester filed a petition entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)" (the '577 requester's petition under 37 CFR 1.183) seeking waiver of the page limit under 37 CFR 1.943(b) for its concurrently-filed comments submission.<sup>2</sup>
14. On October 27, 2011, the '546 requester filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183" (the '546 requester's petition under 37 CFR 1.183) seeking waiver of the page limit under 37 CFR 1.943(b) for its concurrently-filed comments submission.<sup>3</sup>

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. The Petition Under 37 CFR 1.183

The '546 requester's October 27, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

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<sup>2</sup> The '577 requester petition will be addressed in a separate decision by OPLA. It is also noted that the title of the petition is in error, and the body of the petition requests waiver of 37 CFR 1.943(b) (not 37 CFR 1.946(b)).

<sup>3</sup> The '546 requester's petition under 37 CFR 1.183 captioned reexamination proceeding Control Nos. 95/000,546, 95/000,577 and 95/000,579. It is noted that the instant merged *inter partes* reexamination proceeding comprises only the '546 and '577 proceeding. Reexamination proceeding Control No. 95/000,579 is not part of the instant merged proceeding.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response or third party requester comments submission in compliance with the 50-page limit, and submission of a resulting response or comments submission that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the proposed submission. Such a response or comments submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response or comments submission: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response or comments submission.

### III. Findings and Analysis

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In the instant petition under 37 CFR 1.183, the '546 requester requests that the page limit requirement of 37 CFR 1.943(b) be waived for its October 27, 2011 comments submission to permit a submission of 21 pages of comments, 29 pages comprising two claim charts, and a 25-page declaration by Dr. Kozyrakis.<sup>4</sup> In particular, requester asserts that "Petitioner has limited its remarks to 21 pages, separate from the claim charts, in the interest of brevity"<sup>5</sup> and that the pages of claim charts and responsive declaration are "due to the number of new claims submitted by the Patent Owner and the length of the supporting declaration, which are outside Petitioner's control."<sup>6</sup>

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<sup>4</sup> Petition under 37 CFR 1.183 at page 2.

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

In this instance, the '546 requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a comments submission that is in excess of 50 pages. Based on the guidance set forth above, the October 27, 2011 comments submission includes up to 75 pages of arguments. The remarks portion of the October 27, 2011 comments submission includes 21 pages of arguments that count toward the regulatory page limit. The 29 pages of claim charts for the new and amended claims (presented as Exhibits 1 and 2) also count toward the regulatory page limit. The 25-page declaration by Dr. Christoforos Kozyrakis includes legal argument and is being counted toward the regulatory page limit.

Based on requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission which is in excess of 50 pages, and the individual facts and circumstances of this case such as, for example, the addition of 47 new claims in the July 6, 2011 patent owner amendment and response,<sup>7</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '546 requester's October 27, 2011 comments submission exceeds the regulatory page limit by up to 25 pages. Accordingly, the '546 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '546 requester's October 27, 2011 comments submission to exceed the page limit by up to 25 pages. This waiver makes the '546 requester's October 27, 2011 comments submission page-length compliant.

### ADDITIONAL DISCUSSION

The parties to the instant merged proceeding are reminded that, pursuant to Section (III)(C) of the March 3, 2011 merger decision:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, filed in **duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

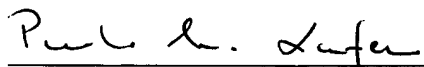
### CONCLUSION

1. The '546 requester's October 27, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '546 requester's October 27, 2011 comments submission to exceed the regulatory page limit by up to 25 pages. This waiver makes the '546 requester's October 27, 2011 comments submission page-length compliant.

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<sup>7</sup> See July 6, 2011 patent owner response "Amendments to the Claims" at pages 2-11, presenting new claims 14-60.

2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



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Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

01-17-2012





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,546	05/11/2010	7289386	19473-0052RX1	8688
25224	7590	01/27/2012	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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P.O. BOX 1022

Minneapolis, MN 55440-1022

Date:

**MAILED**

**JAN 27 2012**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000546

PATENT NO. : 7289386

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(Courtesy Copy)

MAILED

JAN 27 2012

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,546  
Filed: May 11, 2010  
For: U.S. Patent No. 7,289,386

:  
:  
:  
: **DECISION**  
: **ON**  
: **PETITION**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,577  
Filed: October 20, 2010  
For: U.S. Patent No. 7,289,386

This is a decision on the '577 *Inter Partes* requester's petition entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)," filed on October 26, 2011.

The petition is before the Office of Patent Legal Administration.

Third party requester's October 26, 2011 petition is dismissed to the extent requested, but is granted-in-part for the reasons set forth below.

Third party requester's October 26, 2011 comments submission is an improper paper and is being expunged for the reasons set forth below.

## BACKGROUND

1. On October 30, 2007, U.S. Patent No. 7,289,386 (the '386 patent) issued to Bhakta *et al.*
2. On May 11, 2010, a first request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,546 ("the '546 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '546 requester").
3. On August 9, 2010, *inter partes* reexamination was ordered in the '546 proceeding.
4. On August 27, 2010, a non-final Office action was mailed in the '546 proceeding.
5. On October 20, 2010, a second request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,577 ("the '577 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '577 requester" and also referred to herein as "SMART").
6. On October 27, 2010, patent owner timely filed, in the '546 proceeding, an amendment and response to the August 27, 2010 Office action.
7. On November 26, 2010, third party request timely filed comments in the '546 proceeding.
8. On January 18, 2011, *inter partes* reexamination was ordered in the '577 proceeding.
9. On March 3, 2011, the Office issued a Decision, *Sua Sponte*, merging the '546 and '577 *inter partes* proceedings ("the merged proceeding").
10. On April 6, 2011, a non-final Office action was issued in the merged proceeding.
11. On July 6, 2011, patent owner filed a petition entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 CFR § 1.943(b)", concurrently with a patent owner response to the April 6, 2011 Office action, including an amendment presenting new claims.<sup>1</sup>
12. On September 26, 2011 the Office issued a decision granting the July 6, 2011 patent owner petition for suspension of the page limit under 37 CFR 1.943(b). The decision included guidance on the time period for submission of third party requesters' comments.
13. On October 26, 2011, the '577 requester filed the instant petition entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION

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<sup>1</sup> Patent Owner filed a "Request for Extension of time under 37 CFR 1.956" on April 15, 2011, seeking a one month extension of time to respond to the Office action mailed on April 6, 2011. The Office granted the petition for extension of time on April 22, 2011, thereby extending the time period for patent owner's response to the Office action by one month.

PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)” (the ‘577 requester’s petition under 37 CFR 1.183) seeking waiver of the page limit under 37 CFR 1.943(b) for its concurrently-filed comments submission.<sup>2</sup>

14. On October 27, 2011, the ‘546 requester filed a petition entitled “PETITION UNDER 37 C.F.R. § 1.183” (the ‘546 requester’s petition under 37 CFR 1.183) seeking waiver of the page limit under 37 CFR 1.943(b) for its concurrently-filed comments submission, and the Office mailed a decision granting the ‘546 requester’s petition under 37 CFR 1.183 on January 17, 2012.

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. The Petition Under 37 CFR 1.183

The ‘577 requester’s October 26, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

In the instant petition under 37 CFR 1.183, the ‘577 requester asserts that it has attempted to comply with all of the relevant rules and formatting requirements for seeking waiver of the page limit requirement of 37 CFR 1.943(b) when preparing the comments submission but that “[d]espite SMART’s best efforts, the Comments exceeded the page count limit of 50 pages....”<sup>3</sup> The ‘577 requester asserts that the October 26, 2011 submission contains: “(1) a 369-page set of comments comprising a 1-page cover sheet, table of contents, table of exhibits, and 356 pages of

<sup>2</sup> It is noted that the title of the petition is in error, and the body of the petition requests waiver of 37 CFR 1.943(b) (not 37 CFR 1.946(b)).

<sup>3</sup> Petition under 37 CFR 1.183 at page 2.

remarks, (2) a 21-page declaration of Nader Bagherzadeh (the Bagherzadeh Declaration), (3) 238 pages comprising two claim charts demonstrating the invalidity of the 47 newly added claims, (4) 225 pages of additional prior art references, and (5) 938 pages of additional exhibits.”<sup>4</sup> In particular, the ‘577 requester asserts that “SMART’s comments submission exceeds the 50-page limit by up to 327 pages.”<sup>5</sup>

Among other arguments in support of waiver of 37 CFR 1.943(b), the ‘577 requester asserts on page 4 of the petition under 37 CFR 1.183 that:

- The 47 new claims Patent Owner has added are complicated and require substantial comment. In some instances the claims reached over four levels of dependency. Claim 25 for example depends on claim 24, which depends on claim 23, which depends on claim 20, which depends on claim 1.
- SMART has kept its comments to the original 13 claims that were rejected under the 50-page limit, using only 18 pages of remarks and 8 pages of declaration. The remainder of SMART’s comments addresses only the 47 claims Patent Owner added in its response.
- SMART has kept its comments to the original 13 claims of the reexamination to much less than [sic] the regulatory 50-page limit. The comments addressed to the original claims are limited to only 18 pages of remarks and 8 pages of declaration. The remaining pages were directed only to the 47 newly added claims. Further, the newly added claims were very complicated and required substantial comment. In some instances, the claims reached over four levels of dependency. Claim 25, for example, depends on claim 24, which depends on claim 23, which depends on claim 20, which depends on claim 1.

### III. Findings and Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner’s response or third party requester comments submission in compliance with the 50-page limit, and submission of a resulting response or comments submission that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the proposed submission. Such a response or comments submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response or comments submission: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response or comments submission.

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<sup>4</sup> Petition under 37 CFR 1.183 at page 2.

<sup>5</sup> Id. A review of the submission indicates that the submission exceeds the regulatory page limit by up to 560 pages, as set forth in Section III (Findings and Analysis).

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited** to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Based on the guidance set forth above, the '577 requester's October 26, 2011 comments submission includes up to 610 pages that count toward the regulatory page limit. The remarks portion of the October 26, 2011 comments submission includes 355 pages that count toward the regulatory page limit. Additionally, the 112-page claim chart "EXHIBIT CC-G" and 126-page claim chart "Exhibit CC-F" also count toward the regulatory page limit. Further, up to 17 pages of the Bagherzadeh declaration include legal argument that count toward the regulatory page limit. Thus, the October 26, 2011 comments submission exceeds the regulatory page limit by up to 560 pages.

In this instance, requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a proposed comments submission that is in excess of 50 pages; however, upon review of the submission, requester has not demonstrated that it economized or attempted to minimize duplicative or redundant material in the submission. For instance, Section VI of the comments submission spans over 300 pages of remarks and presents a claim-by-claim analysis of each of the 47 new claims, which remarks are, in some instances, duplicative of remarks presented elsewhere in the claim-by-claim analysis section and in the 238 pages of claim charts.<sup>6</sup> Further, contrary to requester's assertion, fewer pages should be needed to address claims having multiple levels of dependency because requester can make reference to, and need not repeat, discussion of the limitations of the parent claim(s).

Based on the evaluation of the '577 requester's October 26, 2011 comments submission for economizing, extraneous material, and arrangement, without repetition of information already of record, and the individual facts and circumstances of this case, it is not deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to permit the '577 requester's

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<sup>6</sup> As shown by the chart on page 40 of the remarks, the '577 requester has proposed five grounds of rejection under 35 U.S.C. 103, each being applied to various subsets of the 47 new claims. Requester has chosen to discuss each claim with the associated prior art individually. Additionally, there appears to be repetition of the pasted figures in the remarks and claim charts.

October 26, 2011 comments submission to exceed the regulatory page limit by up to 560 pages. The granting of a waiver for 560 additional pages based upon patent owner's inclusion of 47 new claims is not commensurate with the requirements of justice in this situation. Accordingly, the '577 requester's petition under 37 CFR 1.183 is **dismissed**.

The page limit requirement of 37 CFR 1.943(b) is instead waived to the extent that justice requires in this circumstance to permit the '577 requester's comments submission to exceed the page limit requirements by up to 250 pages, for a total of 300 pages.<sup>7</sup>

This waiver does not make the '577 requester's October 26, 2011 comments submission page-length compliant. Therefore, the '577 requester's October 26, 2011 comments submission is an improper paper and it will not be considered. The '577 requester's October 26, 2011 comments submission is being expunged by marking the papers "closed" and "not public" in the Image File Wrapper (IFW) of the merged proceeding. The '577 requester's October 26, 2011 comments submission will not constitute part of the record of the instant merged reexamination proceeding.

#### IV. Guidance for the '577 Third Party Requester

For the reasons given above, the 610 pages of the '577 requester's October 26, 2011 comments submission that count toward the regulatory page limit exceed the regulatory page limit established by 37 CFR 1.943(b) and this decision by 310 pages. However, from the record it is apparent that requester's October 26, 2011 comments submission was a *bona fide* attempt to respond and advance prosecution. Accordingly, requester may, **within 15 days from the date of this notice**, exercise one of the following two options:

1. Submit a re-drafted comments submission that does not exceed the 300-page limit established by this decision; or,
2. File a copy of the October 26, 2011 comments submission with pages redacted to satisfy the 300-page limit established by this decision.

This 15-day period for reply is not extendable.

If no comments submission from requester is received within the allotted time, the reexamination proceeding will be forwarded to the examiner for appropriate action, without written comments from the '577 requester.

The '577 requester is advised that submissions must be of sufficient size, 12 point font, 1.5 line spaced and conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See 37 CFR 1.52.

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<sup>7</sup> Note that waiver in this instance is not to be taken as an indication that the regulatory page limit would be waived to the same extent in similar circumstances in other cases; however, in the interest of special dispatch and in an effort to prevent substantial re-drafting by the '577 requester, permitting a comments submission of up to 300 pages is deemed equitable under the individual facts and circumstances in this case.



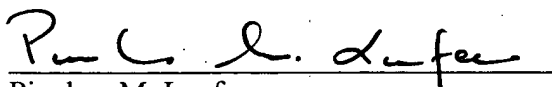
### ADDITIONAL DISCUSSION

The parties to the instant merged proceeding are reminded that, pursuant to Section (III)(C) of the March 3, 2011 merger decision:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, filed in **duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

### CONCLUSION

1. The '577 requester's October 26, 2011 petition under 37 CFR 1.183 is **dismissed to the extent requested**.
2. The '577 requester's request for waiver of the 37 CFR 1.943(b) is **granted-in-part to permit 250 additional pages** to respond to patent owner's July 6, 2011 response submission and the April 6, 2011 Office action. The '577 requester is given a time period of **15 days from the mailing date of this decision** to submit a comments submission in compliance with this decision. This time period is not extendable.
3. The '577 requester's October 26, 2011 comments submission is an **improper paper** and will not be considered. The comments submission is being **expunged** by marking the papers "closed" and "not public" in Image File Wrapper (IFW) of the merged proceeding. The October 26, 2011 comments submission will not constitute part of the record of the instant merged reexamination proceeding.
4. A copy of this decision will be made of public record.
5. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

01-26-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,548	06/30/2010	7563614	86708REX (47137)	4698
21874	7590	05/12/2011	EXAMINER	
EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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*Inter partes* Fluxion Biosciences, Inc.

v.

Cellectricon AB

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Reexamination Control No. 95/000,548

Patent 7,563,614

Technology Center 3900

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DECISION ON PETITION

This is a decision on “Patent Owner’s Petition under 37 C.F.R. § 1.182 to Strike Third Party Requester’s April 2, 2011, Appellant Brief in Inter Partes Reexam,” filed April 11, 2011 (Petition #1). Patent Owner requests that requester’s appellant brief be stricken because it is not compliant with 37 C.F.R. § 1.943(c). The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f), has been charged to patent owner’s deposit account on April 11, 2011.

*See* 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

This is also a decision on Requester's "Petition under Rule 1.182 to Oppose the Patent Owner's Petition to Strike Third Party Requester's Appellant Brief and/or Petition under 1.183 for Waiver of Rule 41. 67 to the Extent Necessary" filed on April 28, 2011 (Petition #2). Requester requests that requester's appellant brief not be stricken because it is compliant with 37 C.F.R. § 1.943(c). The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f), has been charged to requester's deposit account on April 28, 2011.

This is further a decision on "Patent Owner's Petition under 37 C.F.R. § 1.182 for Notification of Due Date for Respondent's Brief in Inter Partes Reexamination" filed on May 2, 2011 (Petition #3). Patent Owner requests notification of the due date for the respondent brief in view of the petitions that patent owner and requester have filed concerning the appellant brief. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f), has been charged to patent owner's deposit account on May 2, 2011.

## FINDINGS

1. On June 30, 2010, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,563,614, which was assigned control no. 95/000,548.
2. On August 18, 2010, reexamination was ordered and an Action Closing Prosecution (ACP) was mailed.
3. On January 6, 2011, a Right of Appeal Notice (RAN) was mailed.
4. Requester filed a Notice of Appeal on February 2, 2011.
5. Requester filed an appellant brief on April 2, 2011.

6. Patent Owner filed Petition #1 on April 11, 2011.
7. Requester filed Petition #2 in opposition to Petition #1 on April 28, 2011.
8. Patent owner filed Petition #3 on May 2, 2011.

## DISCUSSION

In Petition #1, patent owner requests that the requester's appellant brief of April 2, 2011, be stricken for not being in compliance with 37 C.F.R. § 1.943(c) because it purportedly exceeds the 30-page or 14,000 word limit. Petitioner alleges that the appellant's brief contains more than 30 pages, due to the exhibits included with the brief that contain claim charts, a § 1.132 declaration, a copy of a request for reexamination and copies of Office actions. Petitioner asserts that these exhibits constitute an additional 360 pages of arguments.

Requester argues in Petition #2 that these exhibits are already of record in the file and should not be counted toward the page limit of the appellant brief. Requester admits that they did not include the pages from the Kopf-Sill Declaration in the page count, but asserts that the pages in that declaration which may count toward the page limit would be at most 5 pages. Requester states that the appellant brief is 25 pages; therefore including the additional 5 pages of declaration would not cause the brief to exceed the page limit. Requester indicates that copies of the original reexamination request, claim charts that were filed with that request, and a copy of the ACP were included with the brief for the convenience of the BPAI.

Petitioner also asserts in petition #1 that the requester's brief should be stricken for non-compliance with 37 C.F.R. § 41.67 because it includes un-entered evidence, specifically, an image at page fourteen. Petitioner points out that the purported "illustration of an IonFlux plate" is neither part of the referenced Exhibit 6 to the Brief, nor any other part of the record in the instant reexamination. Petitioner further contends that requester's brief fails to address the issues presented for appeal concerning the dependent claims by improperly incorporating arguments by reference that it made in the reexamination request.

In Petition #2, requester petitions under 37 C.F.R. § 1.183 to waive § 41.67 and enter requester's appellant brief. Requester asserts that the appellant brief addressed the unconsidered dependent claims to the extent required. Since the examiner did not adopt the proposed rejections of the independent claims, the proposed rejections of the dependent claims could not have been adopted. Requester also asserts that the illustration included on page 14 of requester's brief simply shows the structure of the product accused of infringing the patent owner's patent to show the broad interpretation of the claims being asserted by patent owner in the pending litigation. Requester indicates that if the illustration is considered to be new evidence, then requester respectfully petitions under 37 C.F.R. § 1.183 to waive the relevant portion of § 41.67 and enter requester's brief into the record.

In petition #3, patent owner requests notification of the due date for the respondent brief.

## RELEVANT AUTHORITY

### **37 C.F.R. § 1.182 provides:**

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

### **37 C.F.R. § 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

### **37 C.F.R. § 41.67 provides:**

...

(c) (1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

(i) Real party in interest. A statement identifying by name the real party in interest.

(ii) Related appeals and interferences. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(xi) of this section.

(iii) Status of claims. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled). If the appellant is the owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

(iv) Status of amendments. A statement of the status of any amendment filed subsequent to the close of prosecution.

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the

specification by column and line number, and to the drawing(s), if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) Issues to be reviewed on appeal. A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

(vii) Argument. The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) Claims appendix. An appendix containing a copy of the claims to be reviewed on appeal.

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.



(xi) Certificate of service. A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

**37 C.F.R. § 1.943(c) provides:**

(c) Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

**MPEP 2667(I)(A)(2.) provides:**

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

## ANALYSIS

In Petition #1, patent owner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 1.943(c) because it exceeds the page limit. Requester admits on pages 3-4 of Petition #2 that the attachments to the brief were not counted in the page count of the appellant brief. It is agreed that they should be counted in the page and word limits for the reasons set forth in Petition #1. Including these pages and words causes the requester's appellant brief of April 2, 2011, to exceed the page and word limit pursuant to 37 C.F.R. § 1.943(c).

In Petition #1, patent owner also asserts that the requester's brief should be stricken for non-compliance with 37 C.F.R. § 41.67 because it includes un-entered evidence, specifically, an image at page fourteen, *i.e.*, the "illustration of an IonFlux plate" that is neither part of the referenced Exhibit 6 to the Brief, nor any other part of the record in the instant reexamination. It is agreed that this is new evidence that has not been considered nor entered by the examiner. Requester indicates in Petition #2 that, if the illustration is considered to be new evidence, then requester respectfully petitions under 37 C.F.R. § 1.183 to waive the relevant portion of § 41.67 and enter requester's brief into the record. However, requester has not provided a convincing explanation as to why this evidence is necessary and was not earlier presented. Requester has provided no showing of an extraordinary situation where justice requires waiver of this rule.

Petition #1 is **granted**. The patent owner appellant brief of April 2, 2011, is not entered.

Petition #2 is **denied**.


The relief requested in petition #3 is **granted**.

### DECISION

In view of the foregoing, petition #1 and petition #3 are GRANTED.  
Petition #2 is DENIED.

Requester is given one opportunity to file a corrected appellant brief in compliance with 37 CFR § 1.943(c), within a non-extendable time period of one month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the requester's appeal will be dismissed.

If a corrected appellant brief is timely filed, then patent owner is given one month from the date of service to file a respondent brief.



James D. Smith  
Chief Administrative Patent Judge

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,548	06/30/2010	7563614	86708REX (47137)	4698
21874	7590	05/12/2011	EXAMINER	
EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			ART UNIT	PAPER NUMBER

DATE MAILED: 05/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

---

*Inter partes* Fluxion Biosciences, Inc.

v.

Cellectricon AB

---

Reexamination Control No. 95/000,548

Patent 7,563,614

Technology Center 3900

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DECISION ON PETITION

This is a decision on “Patent Owner’s Petition under 37 C.F.R. § 1.182 to Strike Third Party Requester’s April 2, 2011, Appellant Brief in *Inter Partes* Reexam,” filed April 11, 2011 (Petition #1). Patent Owner requests that requester’s appellant brief be stricken because it is not compliant with 37 C.F.R. § 1.943(c). The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f), has been charged to patent owner’s deposit account on April 11, 2011.

*See* 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

This is also a decision on Requester's "Petition under Rule 1.182 to Oppose the Patent Owner's Petition to Strike Third Party Requester's Appellant Brief and/or Petition under 1.183 for Waiver of Rule 41. 67 to the Extent Necessary" filed on April 28, 2011 (Petition #2). Requester requests that requester's appellant brief not be stricken because it is compliant with 37 C.F.R. § 1.943(c). The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f), has been charged to requester's deposit account on April 28, 2011.

This is further a decision on "Patent Owner's Petition under 37 C.F.R. § 1.182 for Notification of Due Date for Respondent's Brief in Inter Partes Reexamination" filed on May 2, 2011 (Petition #3). Patent Owner requests notification of the due date for the respondent brief in view of the petitions that patent owner and requester have filed concerning the appellant brief. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f), has been charged to patent owner's deposit account on May 2, 2011.

## FINDINGS

1. On June 30, 2010, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,563,614, which was assigned control no. 95/000,548.
2. On August 18, 2010, reexamination was ordered and an Action Closing Prosecution (ACP) was mailed.
3. On January 6, 2011, a Right of Appeal Notice (RAN) was mailed.
4. Requester filed a Notice of Appeal on February 2, 2011.
5. Requester filed an appellant brief on April 2, 2011.

6. Patent Owner filed Petition #1 on April 11, 2011.
7. Requester filed Petition #2 in opposition to Petition #1 on April 28, 2011.
8. Patent owner filed Petition #3 on May 2, 2011.

## DISCUSSION

In Petition #1, patent owner requests that the requester's appellant brief of April 2, 2011, be stricken for not being in compliance with 37 C.F.R. § 1.943(c) because it purportedly exceeds the 30-page or 14,000 word limit. Petitioner alleges that the appellant's brief contains more than 30 pages, due to the exhibits included with the brief that contain claim charts, a § 1.132 declaration, a copy of a request for reexamination and copies of Office actions. Petitioner asserts that these exhibits constitute an additional 360 pages of arguments.

Requester argues in Petition #2 that these exhibits are already of record in the file and should not be counted toward the page limit of the appellant brief. Requester admits that they did not include the pages from the Kopf-Sill Declaration in the page count, but asserts that the pages in that declaration which may count toward the page limit would be at most 5 pages. Requester states that the appellant brief is 25 pages; therefore including the additional 5 pages of declaration would not cause the brief to exceed the page limit. Requester indicates that copies of the original reexamination request, claim charts that were filed with that request, and a copy of the ACP were included with the brief for the convenience of the BPAI.

Petitioner also asserts in petition #1 that the requester's brief should be stricken for non-compliance with 37 C.F.R. § 41.67 because it includes un-entered evidence, specifically, an image at page fourteen. Petitioner points out that the purported "illustration of an IonFlux plate" is neither part of the referenced Exhibit 6 to the Brief, nor any other part of the record in the instant reexamination. Petitioner further contends that requester's brief fails to address the issues presented for appeal concerning the dependent claims by improperly incorporating arguments by reference that it made in the reexamination request.

In Petition #2, requester petitions under 37 C.F.R. § 1.183 to waive § 41.67 and enter requester's appellant brief. Requester asserts that the appellant brief addressed the unconsidered dependent claims to the extent required. Since the examiner did not adopt the proposed rejections of the independent claims, the proposed rejections of the dependent claims could not have been adopted. Requester also asserts that the illustration included on page 14 of requester's brief simply shows the structure of the product accused of infringing the patent owner's patent to show the broad interpretation of the claims being asserted by patent owner in the pending litigation. Requester indicates that if the illustration is considered to be new evidence, then requester respectfully petitions under 37 C.F.R. § 1.183 to waive the relevant portion of § 41.67 and enter requester's brief into the record.

In petition #3, patent owner requests notification of the due date for the respondent brief.



## RELEVANT AUTHORITY

### **37 C.F.R. § 1.182 provides:**

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

### **37 C.F.R. § 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

### **37 C.F.R. § 41.67 provides:**

...

(c) (1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

(i) Real party in interest. A statement identifying by name the real party in interest.

(ii) Related appeals and interferences. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(xi) of this section.

(iii) Status of claims. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled). If the appellant is the owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

(iv) Status of amendments. A statement of the status of any amendment filed subsequent to the close of prosecution.

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the

specification by column and line number, and to the drawing(s), if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) Issues to be reviewed on appeal. A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

(vii) Argument. The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) Claims appendix. An appendix containing a copy of the claims to be reviewed on appeal.

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(xi) Certificate of service. A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

**37 C.F.R. § 1.943(c) provides:**

(c) Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

**MPEP 2667(I)(A)(2.) provides:**

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

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## ANALYSIS

In Petition #1, patent owner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 1.943(c) because it exceeds the page limit. Requester admits on pages 3-4 of Petition #2 that the attachments to the brief were not counted in the page count of the appellant brief. It is agreed that they should be counted in the page and word limits for the reasons set forth in Petition #1. Including these pages and words causes the requester's appellant brief of April 2, 2011, to exceed the page and word limit pursuant to 37 C.F.R. § 1.943(c).

In Petition #1, patent owner also asserts that the requester's brief should be stricken for non-compliance with 37 C.F.R. § 41.67 because it includes un-entered evidence, specifically, an image at page fourteen, *i.e.*, the "illustration of an IonFlux plate" that is neither part of the referenced Exhibit 6 to the Brief, nor any other part of the record in the instant reexamination. It is agreed that this is new evidence that has not been considered nor entered by the examiner. Requester indicates in Petition #2 that, if the illustration is considered to be new evidence, then requester respectfully petitions under 37 C.F.R. § 1.183 to waive the relevant portion of § 41.67 and enter requester's brief into the record. However, requester has not provided a convincing explanation as to why this evidence is necessary and was not earlier presented. Requester has provided no showing of an extraordinary situation where justice requires waiver of this rule.

Petition #1 is **granted**. The patent owner appellant brief of April 2, 2011, is not entered.

Petition #2 is **denied**.

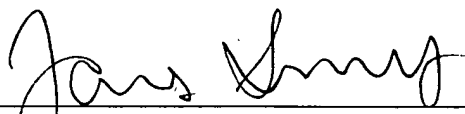
The relief requested in petition #3 is **granted**.

### DECISION

In view of the foregoing, petition #1 and petition #3 are GRANTED.  
Petition #2 is DENIED.

Requester is given one opportunity to file a corrected appellant brief in compliance with 37 CFR § 1.943(c), within a non-extendable time period of one month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the requester's appeal will be dismissed.

If a corrected appellant brief is timely filed, then patent owner is given one month from the date of service to file a respondent brief.

  
\_\_\_\_\_  
James D. Smith  
Chief Administrative Patent Judge

Counsel for Patent Owner:  
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P.O. Box 55874  
Boston, MA 02205

Counsel for Third Party Requester:  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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21874	7590	05/12/2011	EXAMINER	
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DATE MAILED: 05/12/2011

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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*Inter partes* Fluxion Biosciences, Inc.

v.

Cellectricon AB

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Reexamination Control No. 95/000,548

Patent 7,563,614

Technology Center 3900

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*See* 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

This is also a decision on Requester's "Petition under Rule 1.182 to Oppose the Patent Owner's Petition to Strike Third Party Requester's Appellant Brief and/or Petition under 1.183 for Waiver of Rule 41. 67 to the Extent Necessary" filed on April 28, 2011 (Petition #2). Requester requests that requester's appellant brief not be stricken because it is compliant with 37 C.F.R. § 1.943(c). The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f), has been charged to requester's deposit account on April 28, 2011.

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## FINDINGS

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## RELEVANT AUTHORITY

### **37 C.F.R. § 1.182 provides:**

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

### **37 C.F.R. § 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

### **37 C.F.R. § 41.67 provides:**

...

(c) (1) The appellant's brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(xi) of this section.

(i) Real party in interest. A statement identifying by name the real party in interest.

(ii) Related appeals and interferences. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(xi) of this section.

(iii) Status of claims. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled). If the appellant is the owner, the appellant must also identify the rejected claims whose rejection is being appealed. If the appellant is a requester, the appellant must identify the claims that the examiner has made a determination favorable to patentability, which determination is being appealed.

(iv) Status of amendments. A statement of the status of any amendment filed subsequent to the close of prosecution.

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the

specification by column and line number, and to the drawing(s), if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) Issues to be reviewed on appeal. A concise statement of each issue presented for review. No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

(vii) Argument. The contentions of appellant with respect to each issue presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief permitted under this section or §§ 41.68 and 41.71 will be refused consideration by the Board, unless good cause is shown. Each issue must be treated under a separate heading. If the appellant is the patent owner, for each ground of rejection in the Right of Appeal Notice which appellant contests and which applies to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) Claims appendix. An appendix containing a copy of the claims to be reviewed on appeal.

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(xi) Certificate of service. A certification that a copy of the brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, that appellant's appeal will stand dismissed.

**37 C.F.R. § 1.943(c) provides:**

(c) Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

**MPEP 2667(I.) (A.) (2.) provides:**

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

## ANALYSIS

In Petition #1, patent owner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 1.943(c) because it exceeds the page limit. Requester admits on pages 3-4 of Petition #2 that the attachments to the brief were not counted in the page count of the appellant brief. It is agreed that they should be counted in the page and word limits for the reasons set forth in Petition #1. Including these pages and words causes the requester's appellant brief of April 2, 2011, to exceed the page and word limit pursuant to 37 C.F.R. § 1.943(c).

In Petition #1, patent owner also asserts that the requester's brief should be stricken for non-compliance with 37 C.F.R. § 41.67 because it includes un-entered evidence, specifically, an image at page fourteen, *i.e.*, the "illustration of an IonFlux plate" that is neither part of the referenced Exhibit 6 to the Brief, nor any other part of the record in the instant reexamination. It is agreed that this is new evidence that has not been considered nor entered by the examiner. Requester indicates in Petition #2 that, if the illustration is considered to be new evidence, then requester respectfully petitions under 37 C.F.R. § 1.183 to waive the relevant portion of § 41.67 and enter requester's brief into the record. However, requester has not provided a convincing explanation as to why this evidence is necessary and was not earlier presented. Requester has provided no showing of an extraordinary situation where justice requires waiver of this rule.

Petition #1 is **granted**. The patent owner appellant brief of April 2, 2011, is not entered.

Inter Partes Reexamination Control No. 95/000,548  
Patent No. 7,563,614

Petition #2 is **denied**.

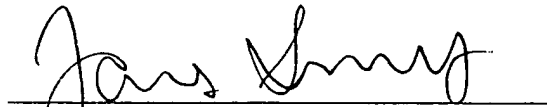
The relief requested in petition #3 is **granted**.

### DECISION

In view of the foregoing, petition #1 and petition #3 are GRANTED.  
Petition #2 is DENIED.

Requester is given one opportunity to file a corrected appellant brief in compliance with 37 CFR § 1.943(c), within a non-extendable time period of one month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the requester's appeal will be dismissed.

If a corrected appellant brief is timely filed, then patent owner is given one month from the date of service to file a respondent brief.

  
James D. Smith  
Chief Administrative Patent Judge

Counsel for Patent Owner:  
EDWARDS ANGELL PALMER & DODGE, LLP  
P.O. Box 55874  
Boston, MA 02205

Counsel for Third Party Requester:  
KLARQUIST SPARKMAN, LLP  
121 S.W. Salmon St., Suite 1600  
One World Trade Center  
Portland, OR 97204



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,549	06/09/2010	7,390,650	86707REX (47137)	4855
21874	7590	01/31/2011	EXAMINER	
EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2011

Please find below and/or attached an Office communication concerning this application or proceeding.





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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

Date: **MAILED**  
**JAN 31 2011**  
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000549  
PATENT NO. : 7390650  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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EDWARDS ANGELL PALMER & DODGE LLP  
P.O. BOX 55874  
BOSTON, MA 02205

(For Patent Owner)

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IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

(For Third Party Requester)

In re Karlsson et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,549  
Filed: June 9, 2010  
For: U.S. Patent No. 7,390,650

**: DECISION**  
**: GRANTING-IN-PART**  
**: PETITION AND**  
**: EXPUNGING**  
**: IMPROPER PAPER**

This is a decision on the November 12, 2010 third party requester petition entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 1.183." The petition requests waiver of the 37 CFR 1.943(b) requirement that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 101 pages. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in written comments by third party requester is granted to the extent that the page limit for written comments by third party requester is extended to not exceed 76 pages in length.

For the reasons set forth below, third party requester's comments submission is an improper paper and is being expunged without consideration. Since the third party requester paper has been scanned into the record, Image File Wrapper (IFW) of the 95/000,549 *inter partes* reexamination proceeding, the November 12, 2010 third party requester comments submission is being expunged from the record by closing it and marking it "not public" in the IFW of the 95/000,549 *inter partes* reexamination proceeding.

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JAN 5 2011

CENTRAL REEXAMINATION UNIT

## **FEES**

Third party requester has paid the petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.183 from Deposit Account No. 15-0665.

## **REVIEW OF THE RELEVANT FACTS**

1. On June 24, 2008, U.S. Patent No. 7,390,650 ("the '650 patent") was granted to Karlsson et al.
2. On June 9, 2010, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/000,549 ("the '549 proceeding").
3. On August 9, 2010, the Office issued an order granting *inter partes* reexamination in the '549 proceeding, with an accompanying Office action on the merits.
4. On October 12, 2010, the patent owner timely filed a response to the Office action.
5. On November 12, 2010, third party requester filed the instant petition entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 1.183." Third party requester timely filed a 37 CFR 1.947 comments submission concurrently with the petition.

## **DECISION**

### **I. Relevant Regulations and Procedure**

#### **37 CFR 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

#### **37 CFR 1.943(b) provides:**

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

**MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:**

\*\*\*\*\*

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

## II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on November 12, 2010, and requests that the page limit be extended to permit requester to submit 31 pages of comments and 70 pages of claim charts in support of the comments.<sup>1</sup> In support of its request for waiver of the rule, third party requester argues that patent owner's response "contains complex arguments that necessitate Requestor's in-depth analysis and rebuttal" and introduces "13 new claims" such that "Requestor is forced to present claim charts and arguments detailing where each of the dozens of limitations are taught in the prior art."<sup>2</sup> Third party requester further asserts that its comments "include both anticipation and obviousness arguments" and that "[o]bviousness arguments under 35 U.S.C. § 103(a) require additional analysis to satisfy the requirements of the KSR decision."<sup>3</sup> Third party requester also states that it has "minimized the length of the Comments by avoiding repetition of arguments for similar dependent claims and by citing previously filed documents, but it is impossible to limit the Comments and claim charts to 50 pages given the many new claims proposed by Patent Owner."<sup>4</sup>

## III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party.

A review of the November 12, 2010 third party requester comments paper shows that the paper contains 30 pages of remarks and is accompanied by three claim charts (Exhibits CC-C, CC-D, and CC-E), a court document (Exhibit OTH-C) and a second declaration of Anne Kofp-Sill under 37 CFR 1.132 (Exhibit OTH-E).

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<sup>1</sup> Petition at page 2.

<sup>2</sup> *Id.* at pages 2-3.

<sup>3</sup> *Id.* at page 3.

<sup>4</sup> *Id.*

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 30 pages of remarks count toward the page limit.

The three claim charts, totaling 70 pages, are proposed rejections for the newly added claims, which count toward the page limit.

Exhibit OTH-C is patent owner's infringement contentions from the current litigation. Since page 13 of the written comments rely on page 11 of the infringement contention for the meaning of a claim term, this page of the infringement contention is counted toward the page limit.

The second declaration of Kofp-Sill contains legal arguments on page 3, which is counted toward the page limit. Specifically, declarant Kofp-Sill argues on page 3 that "[a] person of ordinary skill...would be motivated to combine Dodgson's teaching...with Wang's teaching..."

Therefore, the requester's written comments submission is, *in toto*, 102 pages in length.

In response to requester's argument that the patent owner's response contains complex arguments that necessitate requester's in-depth analysis and rebuttal, this argument is unpersuasive as the requester's comments in response to patent owner's arguments occupy only 14 pages of its 102 page submission. It is noted that patent owner's response contains 21 pages of remarks and one page of claim support that are one and a half-spaced<sup>5</sup> to address the non-final office action mailed on August 9, 2010.

---

<sup>5</sup> Contrary to requester's statement of facts at page 2 of the instant petition, the patent owner's 30 page response is not single-spaced.

In response to requester's argument that additional pages are needed for the claim charts to show where each of the dozens of limitations of the 13 newly added claims are taught in the prior art, this argument is unpersuasive for the following reasons. The table on pages 18-19 of the third party requester's comments shows that the 13 newly added claims recite four additional limitations when compared to the limitations of the previous set of claims. The four additional limitations in the newly added claims are as follows: (1) wherein the surface defining an opening comprises a silicon-based polymer, (2) wherein the conducting fluid is in electrical communication with a conducting element, (3) wherein the cell chamber comprises a plurality of the nonplanar elements; and (4) wherein the surface of each nonplanar element is protruding or rounded. Third party requester's proposed rejections for the newly added claims are based on the same prior art references (Wang and Dodgson) that were applied to the claims in the previous office action. Therefore, the three claim charts (Exhibits CC-C, CC-D, and CC-E), which include the same information presented in the claim charts accompanying the request and in the requester's comments, are extraneous and repeat information already of record and in the requester's comments.

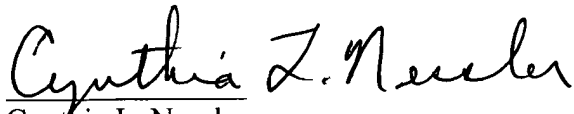
In a balancing of the equities, the third party requester petition under 37 CFR 1.183 is granted to the extent that the page limit of 37 CFR 1.943(b) is waived as to 26 pages of the portions of requester's written comments, which are included in the regulatory page count, that exceed the 50-page limit.

Accordingly, third party requester's written comments submission, that is 102 pages in length, does not comply with the page limit of seventy-six (76) pages in length granted in this decision. The third party requester's written comments submission lacks an entry right in the present '549 proceeding. The written comments paper was entered (scanned) into the IFW before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the written comments paper is being expunged from the record by closing it and marking it "not public" in the IFW of the present reexamination proceeding.

## CONCLUSION

1. Third party requester's November 12, 2010 petition under 37 CFR 1.183 is granted in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's 37 CFR 1.947 comments submission after the October 12, 2010 patent owner response is not to exceed 76 pages in length. **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.** Third party requester's written comments paper filed on November 12, 2010 is an improper paper, and therefore will NOT be made a part of the record of the '549 proceeding.
2. Since third party requester's comments submission and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the '549 proceeding, these papers are expunged by closing them in the '549 reexamination proceeding's IFW file and marking them as "non-public."

3. Third party requester has fifteen (15) days from the mailing date of this decision to file a redacted comments submission that meets the page limit granted in the present decision. The third party requester's responsive submission should be clearly labeled as, e.g., redacted or re-drafted written comments.
4. No copy of the third party requester's November 12, 2010 written comments will be maintained in the record, or elsewhere in the Office.
5. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration

1-28-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,550	06/29/2010	7470518	86705REX (47137)	4082
21874	7590	01/31/2011	EXAMINER	
EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Sanjeet K. Dutta

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4 Park Plaza, Ste. 1600, IP Prosecution Dept.

Irvine, CA 92614-2558

Date:

**MAILED**

**JAN 31 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000550

PATENT NO. : 7470518

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, ~~FAX~~, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

(For Third Party Requester)

In re Chiu et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,550  
Filed: June 29, 2010  
For: U.S. Patent No. 7,470,518

: **DECISION**  
: **GRANTING-IN-PART**  
: **PETITION AND**  
: **EXPUNGING**  
: **IMPROPER PAPER**

This is a decision on the November 12, 2010 third party requester petition entitled "PETITION TO WAIVE PAGE LIMIT PURSUANT TO 37 C.F.R. § 1.183." The petition requests waiver of the 37 CFR 1.943(b) requirement that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 133 pages. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in written comments by third party requester is granted to the extent that the page limit for written comments by third party requester is extended to not exceed 74 pages in length.

For the reasons set forth below, third party requester's comments submission is an improper paper and is being expunged without consideration. Since the third party requester paper has been scanned into the record, Image File Wrapper (IFW) of the 95/000,550 *inter partes* reexamination proceeding, the November 12, 2010 third party requester comments submission is being expunged from the record by closing it and marking it "not public" in the IFW of the 95/000,550 *inter partes* reexamination proceeding.

## DECISION

### I. Relevant Regulations and Procedure

#### **37 CFR 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

#### **37 CFR 1.943(b) provides:**

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

**MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:**

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Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

### II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on November 12, 2010, and requests that the page limit be extended to permit requester to submit 46 pages of comments and 87 pages of claim charts directed at the newly added claims.<sup>1</sup> In support of its request for waiver of the rule, third party requester argues that patent owner's

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<sup>1</sup> Petition at page 2.

response adds twelve new claims and that in order for its comments to be adequate, the comments must address each of these newly added claims comprehensively, which includes proposed rejections under 35 U.S.C. §§ 102, 103, and 112.<sup>2</sup> Requester also asserts that the claim charts are provided to “facilitate the Examiner’s analysis of the prior art and the Patent at issue.”<sup>3</sup>

### III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party.

A review of the November 12, 2010 third party requester comments paper shows that the paper contains 43 pages of remarks and is accompanied by three claim charts (Exhibits CC-C, CC-D, and CC-E), a court document (Exhibit OTH-C) and a second declaration of Anne Kofp-Sill under 37 CFR 1.132 (Exhibit OTH-E).

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 43 pages of remarks count toward the page limit.

The three claim charts, totaling 88 pages, are proposed rejections for the newly added claims, which count toward the page limit.

Exhibit OTH-C is patent owner’s infringement contentions from the current litigation. Since pages 6, 11, and 38 of the written comments rely on page 2 of the infringement contention for its

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<sup>2</sup> Petition at page 2.

<sup>3</sup> *Id.*

arguments regarding the patent owner's interpretation of claim terms, page 2 of the infringement contention is counted toward the page limit.

The second declaration of Kofp-Sill contains legal arguments on page 3, which is counted toward the page limit. Specifically, declarant Kofp-Sill argues in paragraph 17, on page 3, that "[a] person of ordinary skill...would be motivated to combine the teachings of Wang...with the teachings of Klemic..."

Therefore, the requester's written comments submission, *in toto*, is 133 pages in length.

In response to requester's argument that additional pages are needed for the claim charts to address 12 newly added claims, this argument is unpersuasive for the following reasons. The table on pages 12-14 of the third party requester's comments shows that the 12 newly added claims recite two additional limitations when compared to the limitations of the previous set of claims. The two additional limitations in the newly added claims are as follows: (1) wherein the substrate comprises an elastomeric material, and (2) wherein each channel of the substrate comprises at least one inlet for receiving solution from a reservoir. Third party requester's proposed rejections for the newly added claims are based on the same prior art references (Wang and Klemic) that were applied to the claims in the previous office action. Therefore, the three claim charts (Exhibits CC-C, CC-D, and CC-E), which include the same information presented in the claim charts accompanying the request and in the requester's comments, are extraneous and repeat information already of record and in the requester's comments. Requester's assertion that the claim charts are provided for the examiner's convenience is also unpersuasive, since these claim charts include a substantial amount of information already of record and would be burdensome on the examiner to review the same information.

The patent owner's October 12, 2010 response includes 16 pages of remarks and one page of claim support, which *in toto* is 17 pages in length, to address the non-final Office action mailed on August 9, 2010. The patent owner response is also accompanied by twelve new claims.

In a balancing of the equities, the third party requester petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to **24 pages** of the portions of requester's written comments, which are included in the regulatory page count, that exceed the 50-page limit.

Accordingly, third party requester's written comments submission, that is 133 pages in length, does not comply with the page limit of seventy-four (74) pages in length granted in this decision. The third party requester's written comments submission lacks an entry right in the present '550 proceeding. The written comments paper was entered (scanned) into the IFW before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the written comments paper is being expunged from the record by closing it and marking it "not public" in the IFW of the present reexamination proceeding.

### CONCLUSION

1. Third party requester's November 12, 2010 petition under 37 CFR 1.183 is granted in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's 37 CFR 1.947 comments submission after the October 12, 2010 patent owner response is not to exceed 74 pages in length. **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.** Third party requester's written comments paper filed on November 12, 2010 is an improper paper, and therefore will NOT be made a part of the record of the '550 proceeding.
2. Since third party requester's comments submission and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the '550 proceeding, these papers are expunged by closing them in the '550 reexamination proceeding's IFW file and marking them as "non-public."
3. Third party requester has fifteen (15) days from the mailing date of this decision to file a redacted comments submission that meets the page limit granted in the present decision. The third party requester's responsive submission should be clearly labelled as, e.g., redacted or re-drafted written comments.
4. No copy of the third party requester's November 12, 2010 written comments will be maintained in the record, or elsewhere in the Office.
5. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration

1-28-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,552 ; 95/000,542 45511	06/14/2010 7590 11/26/2010	7591844	01035.0068-00000	9463
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
EXAMINER				
ART UNIT			PAPER NUMBER	

DATE MAILED: 11/26/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MARK D. SWEET

FINNEGAN, HENDERSON, FARABOW, GARRET & DUNNER

901 NEW YORK AVENUE N.W.

WASHINGTON, DC 2001-4413

Date:

**MAILED**

**NOV 26 2010**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000552 ; 95/000,542

PATENT NO. : 7591844

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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(For Patent Owner)

**MAILED**

**NOV 26 2010**

**CENTRAL REEXAMINATION UNIT**

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(For 95/000,552 Requester)

In re Llanos et al  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No. 7,591,844

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: **DECISION,**  
: ***SUA SPONTE,***  
: **MERGING**  
: ***INTER PARTES***  
: **PROCEEDINGS**  
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In re Llanos et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 CFR 1.989 at this time.

### REVIEW OF RELEVANT FACTS

1. U. S. Patent Number 7,591,844 (the '844 patent) issued to Llanos et al. on September 22, 2009, with 24 claims.
2. A first request for *inter partes* reexamination, assigned Reexamination Control No. 95/00,542 ('542 proceeding), was filed by a third party requester on April 15, 2010. Boston Scientific SCIMED, Inc is identified as the real party in interest.
3. A second request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,552 ('552 proceeding), was filed by another third party requester on June 14, 2010. Abbott Laboratories is identified as the real party in interest.
4. On June 30, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '542 reexamination proceeding. An Office action containing at least one rejection of each of claims 1-24 of the '844 patent in the '542 reexamination proceeding was mailed on the same date.
5. On August 25, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '552 reexamination proceeding.
6. On August 30, 2010, patent owner timely filed a response to the Office action in the '542 proceeding, retaining original patent claims 1-24 as unamended.
7. On September 29, 2010, third party requester timely filed comments in the '542 proceeding, pursuant to 37 CFR 1.947.
8. To date, no Office action has been mailed, and no amendments to the claims have been made in the '552 *inter partes* reexamination proceeding.

### PERTINENT AUTHORITY

**35 U.S.C. § 314(c) states:**

SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office. (emphasis added)

**37 CFR 1.989 states, in pertinent part:**

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the

merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

**MPEP 2682.01(IV) states, in pertinent part:**

Pursuant to 35 U.S.C. 314(c), “[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section...shall be conducted with special dispatch within the Office.” This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory “special dispatch” requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster “special dispatch.” The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis. (emphasis added)

## DECISION

### I. MERGER OF PROCEEDINGS

As evidenced by the above review of facts, both the ‘542 and the ‘552 reexamination proceedings are currently pending. The order to reexamine has been mailed for both reexamination proceedings, and a decision under 37 CFR 1.989(a) is timely.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the ‘542 and ‘552 reexamination proceedings would address these considerations. Thus, pursuant to 37 CFR 1.989(a), the ‘542 and ‘552 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

## II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

### B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "Inter Partes Reexam"  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this Decision must be served on the other parties, including papers filed *via* facsimile transmission, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP 2666.01, which in turn references the guidelines of MPEP 2250.

37 CFR 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

#### E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

#### F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control No. 95/000,542 and *inter partes* Reexamination Control No. 95/000,552 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Susy Tsang-Foster, at (571) 272-7711, or in her absence, to the undersigned at (571) 272-7726.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

November 24 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

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(For 95/000,552 Third Party Requester)

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No. 7,591,844

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

MAILED

JUN 14 2011

CENTRAL REEXAMINATION UNIT

DECISION  
DISMISSING  
PETITIONS

This is a decision on the patent owner paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURUANT TO 37 CFR §§ 1.183 AND 1.943(b)," filed on March 21, 2011. This is also a decision on the 95/000,552 third party requester's paper entitled "PETITION SEEKING WAIVER OF 37 CFR § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947," filed on April 20, 2011.

The patent owner petition under 37 CFR 1.183 and the 95/000,552 third party requester's petition, which is also a petition under 37 CFR 1.183, are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are dismissed for the reasons set forth herein.

### BACKGROUND

1. U.S. Patent Number 7,591,844 (the '844 patent) issued to Llanos *et al.* on September 22, 2009, with claims 1-24.
2. A first request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,542 (the '542 proceeding), was filed by a first third party requester (the '542 requester) on April 15, 2010. Boston Scientific SCIMED, Inc (Boston Scientific) is identified as the real party in interest.
3. A second request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,552 (the '552 proceeding), was filed by a second third party requester (the '552 requester) on June 14, 2010. Abbott Laboratories (Abbott) is identified as the real party in interest.
4. On June 30, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '542 reexamination proceeding, and was accompanied by a non-final Office action.
5. On August 25, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '552 reexamination proceeding.
6. On November 26, 2010, the Office mailed a decision, *sua sponte*, merging the '542 and the '552 *inter partes* reexamination proceedings (the merged proceeding).
7. On January 21, 2011, the Office mailed a non-final Office action in the merged proceeding.
8. On March 21, 2011, patent owner filed the instant "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§ 1.183 AND 1.943(b)" (patent owner's petition under 37 CFR 1.183), concurrently with a "PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 1.945" (patent owner's response submission).
9. On April 20, 2011, the '542 requester Boston Scientific filed "THIRD-PARTY REQUESTER BOSTON SCIENTIFIC'S SECOND COMMENTS UNDER 37 C.F.R. § 1.947" (Boston Scientific's comments submission).
10. Also on April 20, 2011, the '552 requester Abbott filed the instant "PETITION SEEKING WAIVER OF 37 CFR § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947" (Abbott's petition under 37 CFR 1.183), concurrently with "COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947" (Abbott's comments submission).



## DECISION

### I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Patent Owner's March 21, 2011 Petition under 37 CFR 1.183

On March 21, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed response submission. Patent owner asserts that the March 21, 2011 response submission is 42 pages long, excluding the listing of claims.<sup>1</sup> Patent owner further asserts that "[a]ccompanying the response is a Declaration of Antonios G. Mikos, Ph.D., which presents testimony relevant to the issues raised in the Office Action" (the Mikos declaration) and "[t]o the extent that the Office is of the view that more than 8 pages of Dr. Mikos' declaration testimony should count against the 50-page limit for Patent Owner's response, Patent Owner respectfully requests a corresponding increase in that page limit."<sup>2</sup>

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

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<sup>1</sup> Patent owner petition under 37 CFR 1.183 at page 1.

<sup>2</sup> *Id.*

In the instant patent owner petition under 37 CFR 1.183, patent owner asserts that waiver of the 50-page limit is "necessitated by the fact that the Office Action is nearly 100 pages long and sets forth 50 separate outstanding grounds of rejection under 35 U.S.C. § 103 (based on twenty different references)" and that "the two underlying Requests from which the rejections have been adopted total over 400 pages in length...."<sup>3</sup> Patent owner further asserts that the Mikos declaration "is needed not only to address technical issues that are raised by the rejections and the prior publications upon which they are based, but also to provide a full and complete story of the claimed inventions in the context of the relevant technical field."<sup>4</sup> Thus, patent owner requests, "given the numerous and complex issues embodied in the outstanding Office action and the cited prior publications, that the page limit for Patent Owner's response be increased to an amount sufficient to include both the 42-page response and any pages from the Mikos Declaration that the Office determines should be counted against the 50-page limit."<sup>5</sup> Additionally, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages.<sup>6</sup>

### Analysis and Findings

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

*See, generally,* 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission.

In this instance, the remarks portion of patent owner's March 21, 2011 response submission satisfies the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), but the entire Mikos declaration does not. Accordingly, patent owner's March 21, 2011 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is dismissed.

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<sup>3</sup> Id at page 2.

<sup>4</sup> Id.

<sup>5</sup> Id.

<sup>6</sup> The remarks portion of patent owner's March 21, 2011 response submission is 42 pages long and appears to be one-and-a-half or double-spaced. The Mikos declaration is 60 pages long and is single-spaced.

Patent owner is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth herein; otherwise, patent owner's March 21, 2011 response submission will be deemed defective as not being page-length compliant and will not be considered. In the event patent owner files a **renewed** petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), **no** additional fee need be submitted.

### **Additional Discussion**

It is noted that, in the event patent owner files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a response submission, the content of which is identical to that of the March 21, 2011 response submission, with the exception that the entire Mikos declaration complies with the formatting guidelines set forth herein, such renewed petition would be grantable. In this instance, the specific facts set forth in patent owner's March 21, 2011 petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages, and the individual facts and circumstances of this case, such as, *e.g.*, the incorporation by reference, in the January 21, 2011 Office action, of a substantial number of pages from the April 15, 2010 and June 14, 2010 requests for *inter partes* reexamination, demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b).

It is also noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.<sup>7</sup>

<sup>7</sup> It is noted that, in this instance, 41 pages of the remarks portion of patent owner's March 21, 2011 response submission would be counted toward the page limit (*i.e.*, pages 2-42), and at least Section VIII of the Mikos declaration, spanning pages 13-59, appears to include arguments directed to how an outstanding or proposed rejection is overcome.

### III. The '552 Requester's (Abbott) April 20, 2011 Petition under 37 CFR 1.183

On April 20, 2011, the '552 requester Abbott filed the instant petition under 37 CFR 1.183 for waiver of the page limit of 37 CFR 1.943(b), concurrently filed with its comments submission. Abbott's April 20, 2011 comments submission will not be considered, because, given that the March 21, 2011 patent owner response submission has not been entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requester statutorily has no comment right under 35 USC § 314(b)(2). Further, because Abbott's April 20, 2011 comments submission is not being considered for the reasons set forth herein, Abbott's April 20, 2011 petition under 37 CFR 1.183 is dismissed as moot.

Given that requester statutorily has no comment right to file a comments submission, Abbott's April 20, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding. If patent owner timely files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37 CFR 1.947, Abbott may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant. Any renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) should accompany Abbott's comments submission that complies with the formatting guidelines set forth herein.<sup>8</sup> In the event Abbott files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

It is noted that, in the event Abbott files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a comments submission, the content of which is identical to that of the April 20, 2011 comments submission, such renewed petition would be grantable.<sup>9</sup> Abbott asserts on page 2 of the April 20, 2011 petition under 37 CFR 1.183:

In its 49-page Comments, Abbott appropriately limited its argumentation to issues raised in the Office Action and in Cordis' response. All of the legal arguments in the Comments are fully presented and developed in its Comments document. The Helmus Declaration was submitted to provide factual support for the legal arguments set forth in the Comments. To the extent that the Helmus Declaration discusses the prior art, the same discussion is contained in Abbott's Comments. Because the Helmus Declaration is relied upon for factual support for the arguments presented in Abbott's Comments, the Helmus Declaration should be considered a "reference material" that does not count toward the page limit

<sup>8</sup> Abbott's April 20, 2011 comments submission comprises 49 pages of remarks and appears to be one-and-a-half or double-spaced. The accompanying declaration by Michael N. Helmus, Ph. D., contains 86 pages and also appears to be one-and-a-half or double-spaced.

<sup>9</sup> This guidance is predicated on patent owner filing a grantable renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a response submission, the content of which is identical to that of the March 21, 2011 response submission, with the exception that the entire Mikos declaration complies with the formatting guidelines set forth in section II above.

requirement under 37 C.F.R. 1.943. Abbott's submission, therefore, complies with the page limit requirements of 37 C.F.R. § 1.943(b).

Nonetheless, Abbott requests that its April 20, 2011 petition be granted "[t]o the extent the Office were to deem that any portions of the Helmus Declaration should be counted toward the Rule 1.943 page limit and that, as a result, the limit would be exceeded."<sup>10</sup> Abbott further asserts "that the Rule 1.943 page limit be waived because it is not required by statute and justice requires that Abbott be permitted to fully and fairly address all of the issues raised in the 99-page Office Action and in Cordis' 42-page Response and 60-page, single-spaced Mikos Declaration" and that "[n]o inequities are raised by the Helmus Declaration given that its language regarding the prior art is already contained in Abbott's Comments."<sup>11</sup> Additionally, Abbott has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, which are in excess of 50 pages.<sup>12</sup>

In this instance, the specific facts set forth in Abbott's April 20, 2011 petition under 37 CFR 1.183, Abbott's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, which are in excess of 50 pages, and the individual facts and circumstances of this case, demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b).

#### **IV. The '542 Requester's (Boston Scientific) April 20, 2011 Comments Submission**

On April 20, 2011, the '542 requester Boston Scientific filed comments to the January 21, 2011 Office action and patent owner's March 21, 2011 response submission. For the same reasons set forth in section III above, Boston Scientific's April 20, 2011 comments submission will not be considered, because, given that the March 21, 2011 patent owner response submission has not been entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requester statutorily has no comment right under 35 USC § 314(b)(2).

Given that requester statutorily has no comment right to file a comments submission, Boston Scientific's April 20, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding. If patent owner timely files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37

<sup>10</sup> Abbott's April 20, 2011 petition under 37 CFR 1.182 at page 2.

<sup>11</sup> Id.

<sup>12</sup> It is noted that, in this instance, 49 pages of the remarks portion of Abbott's April 20, 2011 comments submission would be counted toward the page limit (i.e., pages 1-49). The pages of the Helmus declaration drawn to Dr. Helmus' curriculum vitae, work experience and publications are not counted towards the regulatory page limit; however, at least Section V, spanning pages 33-69, appears to contain arguments as to how an outstanding or proposed rejection is supported. Abbott is advised to set forth, in any renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the comments submission. See section II above, providing guidance on how to make such determination.

CFR 1.947, Boston Scientific may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant.

### CONCLUSION

1. Patent owner's March 21, 2011 petition under 37 CFR 1.183 is dismissed.
2. Patent owner is given a time period of fifteen (15) days from the mailing date of this decision to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth herein; otherwise, patent owner's March 21, 2011 response submission will be deemed defective as not being page-length compliant and will not be considered.
3. If patent owner files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37 CFR 1.947, both the '542 and '552 requesters may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant.
4. The '552 requester's (Abbott) April 20, 2011 petition under 37 CFR 1.183 is dismissed as moot.
5. The '542 requester's (Boston Scientific) and the '552 requester's (Abbott) April 20, 2011 comments submissions will not be considered, because, given that the March 21, 2011 patent owner response submission has not been entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requesters statutorily have no comment right under 35 USC § 314(b)(2). Requesters' April 20, 2011 comments submissions are being expunged from the record. Because these papers have been scanned into the Office's IFW system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.
6. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
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*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No. 7,591,844

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: **DECISION**  
: **GRANTING**  
: **PETITION**

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

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This is a decision on the patent owner paper entitled "RENEWED PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" (the renewed petition under 37 CFR 1.183), filed on June 28, 2011.

The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

## DECISION

### I. Patent Owner's June 28, 2011 Renewed Petition under 37 CFR 1.183

On January 21, 2011, the Office mailed a non-final office action in the instant merged proceeding. On March 21, 2011, patent owner filed a petition under 37 CFR 1.183, requesting waiver of the page limit for its concurrently-filed response submission. On June 14, 2011, the Office mailed a decision dismissing patent owner's March 21, 2011 petition under 37 CFR 1.183 (the June 14, 2011 decision). On June 28, 2011, patent owner filed the instant renewed petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response to the January 21, 2011 Office action.<sup>1</sup>

Patent owner states that the renewed petition under 37 CFR 1.183 is responsive to the June 14, 2011 decision, dismissing patent owner's March 21, 2011 petition for waiver of the page limit requirements of 37 CFR 1.943(b) for patent owner's March 21, 2011 response submission.<sup>2</sup> The June 14, 2011 decision states that to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that adheres to the formatting guidelines set forth therein to enable the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission.<sup>3</sup> The decision further states that "the remarks portion of patent owner's March 21, 2011 response submission satisfies the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), but the entire Mikos declaration does not."<sup>4</sup> The decision set a time period of 15 days from the mailing date of the decision for patent owner to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth in the decision.<sup>5</sup>

The June 14, 2011 decision also states:

[I]n the event patent owner files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a response submission, the content of which is identical to that of the March 21, 2011 response submission, with the exception that the entire Mikos declaration complies with the formatting guidelines set forth herein, such renewed petition would be grantable. In this instance, the specific facts set forth in patent owner's March 21, 2011 petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case, such as, e.g., the incorporation by reference, by the January 21, 2011 Office action, of a substantial number of pages from the April

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<sup>1</sup> See the renewed petition under 37 CFR 1.183 at page 1.

<sup>2</sup> Id.

<sup>3</sup> June 14, 2011 decision at page 4.

<sup>4</sup> Id.

<sup>5</sup> Id. at page 5.



15, 2010 and June 14, 2010 requests for *inter partes* reexamination, demonstrate an extraordinary situation in which justice requires suspension the 50-page limit of 37 CFR 1.943(b).<sup>6</sup> [Emphasis added.]

Concurrently with the instant renewed petition under 37 CFR 1.183, patent owner submitted “a Second Mikos Declaration, which Patent Owner certifies is substantively identical to the previous Declaration, except that the formatting has been revised to comply with the [the June 14, 2011 decision’s formatting] guidelines.”<sup>7</sup> Patent owner states that “Patent Owner’s response, not including the appendix (a listing of claims), is 42 pages long” and that “[a]ccompanying the response is a corrected Declaration of Antonios G. Mikos, Ph.D, which presents testimony relevant to the issues raised in the Office Action.”<sup>8</sup> Patent owner further states that “[t]o the extent that the Office if [sic] of the view that more than eight pages of Dr. Mikos’ declaration testimony should count against the 50-page limit for Patent Owner’s response, Patent Owner respectfully requests a corresponding increase in that page limit.”<sup>9</sup> Additionally, patent owner reiterates reasons, previously set forth in patent owner’s March 21, 2011 petition for waiver of 37 CFR 1.943(b), why patent owner deems the additional pages are necessary.<sup>10</sup>

The corrected Mikos declaration, submitted concurrently with the instant petition under 37 CFR 1.183 and the content of which patent owner has certified is identical to that of the March 21, 2011 Mikos declaration, is being entered as a substitute declaration for the March 21, 2011 Mikos declaration, which did not comply with the formatting guidelines set forth in the June 14, 2011 decision. Thus, patent owner’s corrected response submission to the January 21, 2011 Office action is deemed to comprise: (1) the 42 pages of remarks, the 3-page “Appendix A” listing of the claims, and Exhibits 4 and 7 (reference materials) of patent owner’s March 21, 2011 response submission, and (2) the June 28, 2011 80-page corrected Mikos declaration.

The portions of patent owner’s corrected response submission that count toward the regulatory page limit satisfy the formatting guidelines set forth in the June 14, 2011 decision and exceed the regulatory page limit by up to 71 pages.<sup>11</sup> For the reasons previously set forth in the June 14, 2011 decision, the individual facts and circumstances of this case demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b) for patent owner’s corrected response submission. Accordingly, patent owner’s June 28, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s corrected response submission to exceed the regulatory page limit by up to 71 pages for the reasons set forth in the decision of June 14, 2011. **This waiver makes patent owner’s corrected response submission page-length compliant.**

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<sup>6</sup> Id.

<sup>7</sup> The renewed petition under 37 CFR 1.183 at page 2 (also stating in FN 1 that “[s]ince Patent Owner’s Response filed March 21, 2011 was found to comply with the formatting guidelines, it has not been resubmitted.”)

<sup>8</sup> Id. [Footnote omitted.]

<sup>9</sup> Id.

<sup>10</sup> See id.

<sup>11</sup> Included in the regulatory page count are 41 pages of patent owner’s March 21, 2011 remarks (the cover page is excluded), as well as portions of the June 14, 2011 corrected Mikos declaration (e.g., at least Section VIII of the corrected Mikos declaration, spanning pages 17-79, presenting arguments directed to how outstanding rejections are overcome).

## II. The '552 Requester's (Abbott) Comments Submission

In the June 14, 2011 decision, the Office dismissed as moot the '552 requester's (Abbott) April 20, 2011 petition under 37 CFR 1.183 for waiver of the 37 CFR 1.943(b) page limit requirement with respect to requester's April 20, 2011 comments submission and expunging requester's April 20, 2011 comments submission from the record of the instant proceeding.<sup>12</sup> However, the June 14, 2011 decision states:

If patent owner timely files a grantable petition under 37 CFR 1.183 in response to the decision, then under 37 CFR 1.947, Abbott may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant. Any renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) should accompany Abbott's comments submission that complies with the formatting guidelines set forth herein. In the event Abbott files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

It is noted that, in the event Abbott files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a comments submission, the content of which is identical to that of the April 20, 2011 comments submission, such renewed petition would be grantable.<sup>13</sup> [Footnotes omitted.]

In view of the instant decision granting patent owner's June 28, 2011 renewed petition under 37 CFR 1.183 and entering patent owner's corrected response submission as page-length compliant, the '552 requester may once file written comments under 37 CFR 1.183 within 30 days of the mailing date of this decision.

## III. The '542 Requester's (Boston Scientific) Comments Submission

The June 14, 2011 decision stated that the '542 requester's (Boston Scientific) April 20, 2011 comments submission will not be considered.<sup>14</sup> However, the June 14, 2011 decision further states:

If patent owner timely files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37 CFR 1.947, Boston Scientific may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant.<sup>15</sup>

<sup>12</sup> See June 14, 2011 decision at page 6.

<sup>13</sup> Id.

<sup>14</sup> Id. at page 7.

<sup>15</sup> Id. at pages 7-8.

In view of the instant decision granting patent owner's June 28, 2011 renewed petition under 37 CFR 1.183 and entering patent owner's corrected response submission as page-length compliant, the '542 requester may once file written comments under 37 CFR 1.183 within 30 days of the mailing date of this decision.<sup>16</sup>

### CONCLUSION

1. Patent owner's June 28, 2011 renewed petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's corrected response submission to exceed the regulatory page limit by up to 71 pages. This waiver makes patent owner's corrected response submission page-length compliant.
2. Both the '552 and '542 requesters may once file written comments, limited to issues raised by the January 21, 2011 Office action or the patent owner's corrected response submission, within 30 days from the mailing date of this decision.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

8-2-2011

<sup>16</sup> Any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany Boston Scientific's comments submission that complies with the formatting guidelines set forth in the June 14, 2011 decision.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,552 + 95/000,542	06/14/2010	7591844	01035.0068-00000	9463
45511	7590	12/07/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 12/07/2011

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**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000552 95/000542

PATENT NO. : 7591844

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**MAILED** (For Patent Owner)

DEC 07 2011

CENTRAL REEXAMINATION UNIT

Frommer Lawrence & Haug, LLP  
745 Fifth Avenue – 10<sup>th</sup> Floor  
New York, NY 10151

(For *Inter Partes* '542 Requester)

Finnegan, Henderson, Farabow, Garrett,  
& Dunner, LLP  
901 New York Avenue, N.W.  
Washington, D.C. 20001-4413

(For *Inter Partes* '552 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No.: 7,591,844

**DECISION  
DENYING  
PETITION**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

This decision addresses the following:

1. The October 7, 2011 patent owner petition entitled "Petition Under 37 C.F.R. § 1.182", filed on October 7, 2011" (the October 7, 2011 patent owner petition under 1.182);
2. The November 2, 2011 opposition petition by the *inter partes* '552 requester entitled "Requester Abbott's Petition to Respond to Patent Owner's October 7, 2011 Petition Under 37 C.F.R. § 1.182 Seeking Unprecedented Discovery in *Inter Partes* Reexamination Proceedings" (the November 2, 2011 opposition by the *inter partes* '552 requester); and
3. The November 3, 2011 opposition petition by the *inter partes* '542 requester entitled "Third Part [*sic*] Requester Boston Scientific's Opposition Under 37 C.F.R. § 1.182 To Patent Owner's Petition for Discovery" (the November 3, 2011 opposition by the *inter partes* '542 requester).

The October 7, 2011 patent owner petition under 37 CFR 1.182, the November 2, 2011 opposition by the *inter partes* '552 requester, the November 3, 2011 opposition by the *inter partes* '542 requester, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

## SUMMARY

Patent owner's October 7, 2011 petition under 37 CFR 1.182 is **denied**. Discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings.

Patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is **denied**.

This decision is designated as a final agency action under 5 U.S.C. § 704.

## DECISION

The patent owner requests that the Office "clarify" its rules as they relate to the service of a subpoena under 35 U.S.C. 24 in *inter partes* reexamination proceedings. Specifically, the patent owner requests that the Office "confirm that its current rules impose no requirement that parties seeking to enforce subpoenas under § 24 must obtain the Office's authorization". Alternatively, the patent owner requests:

if the Office takes the position that such authorization is required for the enforcement of § 24 subpoenas, . . . that the Office grant such authorization so that Patent Owner may (i) obtain important information relevant to nonobviousness that is in the possession of the Third Party Requesters (TPRs) in these merged reexaminations, and (ii) cross-examine expert witnesses whose declarative testimony has been entered into the record of these consolidated *inter partes* reexaminations by TPRs.

35 U.S.C. 24 provides, in pertinent part (emphasis added):

The clerk of any United States court for the district wherein testimony is to be taken for use in *any contested case in the Patent and Trademark Office*, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office....

The *inter partes* reexamination statute, however, does not authorize discovery in *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Optional *inter partes* reexamination was enacted in the American Inventors Protection Act of 1999 (the AIPA). See Public Law 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999), codified at 35 U.S.C. 311-318. 35 U.S.C. 311-318 provide for the filing of a request for *inter partes* reexamination, the Office's decision on such a request, an examination stage including Office actions on the merits, patent owner responses to the Office actions, and third-party requester comments (where patent owner responds) addressing issues raised by the Office action and/or the patent owner's response, an appeal stage, and the issuance of a certificate at the

conclusion of the proceedings. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the Board of Patent Appeals and Interferences (BPAI) adverse to patent owner to the United States Court of Appeals for the Federal Circuit (Federal Circuit). However, as originally enacted, the AIPA did not permit a third party requester of the *inter partes* reexamination to appeal an adverse decision of the BPAI to the Federal Circuit, and did not provide for third-party-requester participation in an appeal taken by the patent owner to the Federal Circuit. Subsequently, the *21st Century Department of Justice Appropriations Authorization Act* (see Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002)) via section 13106, granted the third party requester the rights to (a) appeal an adverse decision of the BPAI to the Federal Circuit (in which appeal the patent owner may participate), and (b) be a party to a patent owner appeal to the Federal Circuit. **Such is the extent of third party participation in an *inter partes* reexamination proceeding, as provided by the 1999 and 2002 enactments.**

35 U.S.C. 314 prescribes the procedure for the conduct of *inter partes* reexamination proceedings. 35 U.S.C. 314(a) provides, in pertinent part:

Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

35 U.S.C. 132 and 133, which govern initial examination, do not provide for a discovery practice. In addition, the initial examination of a patent application is not a "contested case in the Patent and Trademark Office" within the meaning of 35 U.S.C. 24. 35 U.S.C. 132 and 133 address initial examination, and not adjudication, and accordingly do not provide any basis for the authorization of discovery under 35 U.S.C. 24. Moreover, 35 U.S.C. 305, which includes corresponding provisions governing *ex parte* reexamination, similarly specifies that *ex parte* reexamination "will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133." The fact that the same language is used to describe the conduct of *ex parte* reexamination proceedings, which do not provide for discovery, suggests that discovery practice is not within the scope of any reexamination proceeding, whether *inter partes* or *ex parte*. Cf. *Rules to Implement Optional Inter Partes Reexamination Proceeding*, 65 Fed. Reg. 76,756, 76,763 (December 7, 2000) (final rule) ("In a very real sense, the intent of reexamination is to start over and reexamine the patent and examine new and amended claims *as they would have been examined in the original application of the patent.*") (emphasis added).

35 U.S.C. 314(b) provides for service of parties and for the submission of written comments by the third party requester after a patent owner response during the examination stage. Third party requester's written comments must be filed within thirty days of the date of service of patent owner's response. There is no authorization for discovery. Furthermore, as argued by the third party requester in the '542 proceeding,<sup>1</sup> it would be impracticable, if not impossible, for the parties to conduct discovery, for the court to resolve any discovery disputes, and for the third party requester to prepare and submit its written comments within the thirty-day period set by statute. The fact that Congress required the third party requester to file written comments within

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<sup>1</sup> See the November 3, 2011 opposition by the third party requester, Boston Scientific, of *inter partes* reexamination proceeding 95/000,542.



a thirty-day period provides evidence that Congress did not intend to authorize discovery practice in *inter partes* reexamination proceedings.

Both 35 U.S.C. § 314(c), which governs *inter partes* reexamination, and 35 U.S.C. § 305, which governs *ex parte* reexamination, provide that reexamination in *inter partes* reexamination and in *ex parte* reexamination proceedings, respectively, will be conducted with “special dispatch” within the Office. Neither the statute nor the regulations define special dispatch; however, in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit explained:

“Special dispatch” is not defined by statute. . . . According to Webster’s New World Dictionary, special means distinctive, unique, exceptional or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary and common meaning of special dispatch envisions some type of unique, extraordinary or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that ‘reexamination proceedings will be “special” through their pendency’ in the office and provides for an accelerated schedule. MPEP § 2261.

*Ethicon*, 849 F.2d at 1426.

Any provision for discovery would necessarily prolong proceedings before the Office. If Congress had intended for discovery to be permitted in *inter partes* reexamination proceedings, rather than in *ex parte* reexamination proceedings, Congress would have expressly provided for such a practice, and it would have circumscribed the discovery in a manner consistent with the statutory requirement for “special dispatch.” Thus, the statutory requirement for special dispatch clearly provides evidence that Congress did not contemplate discovery for *inter partes* reexamination proceedings. Regarding the sole exception to the “special dispatch” requirement, i.e., a finding of “good cause” by the Director, the Office has not authorized an exception to the “special dispatch” provision for the purposes of permitting discovery, and is not authorized to do so, given the above-discussed provisions of 35 U.S.C. 314(a).

The above interpretation of the *inter partes* reexamination provisions is consistent with their legislative history. The legislative history makes no mention of discovery, and consistently expresses a concern for providing a low-cost, efficient alternative to litigation, in which a third party requester has the ability to participate by submitting comments, in writing, to the examiner, in response to arguments made by the patentee. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did “not subject the patent to any greater challenge in scope than currently exists today” but “merely allows a reexam requestor the option to further explain why a particular patent should not have been granted”); H.R. Rep. No. 106-287, 106th Cong., 1st Sess. 31, (1999) (Submitted by Rep. Coble) (“The existing patent reexamination system is an ineffective means for bringing relevant prior art unavailable to examiners during their search to the attention of the PTO due to the *ex parte* nature of the proceeding.”); 145 Cong. Rec. S14720, (Nov. 17, 1999) (Statement of Senator Lott) (“Subtitle F is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing *ex parte* reexamination in Chapter 30 of title 35, the option of *inter partes* reexamination proceedings in the USPTO. Congress enacted legislation to authorize *ex parte* reexamination of

patents in the USPTO in 1980, but such reexamination has been used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the USPTO. Subtitle F provides that opportunity as an option to the existing *ex parte* reexamination proceedings.”).

The Office has implicitly understood that the *inter partes* reexamination provisions do not authorize discovery. In response to a reporting requirement of the AIPA (*see* AIPA, Pub. L. 106-113, 1501A-571, § 4606 (1999)), the Office conducted a “round table meeting” to receive views on the effectiveness and possible improvement of *inter partes* reexamination and then drafted a report to Congress. The report points out that “the lack of such procedural mechanisms as discovery and cross-examination that would be available in litigation has apparently resulted in challengers being unwilling to invoke *inter partes* reexamination and risk its estoppel effect.” United States Patent And Trademark Office Report To Congress On Inter Partes Reexamination (2004) (available at [http://www.uspto.gov/web/offices/dcom/olia/reports/reexam\\_report.htm](http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm)), at 4; *see also* Transcript of February 17, 2004 Roundtable Meeting (available at [http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round\\_tbl\\_transcript.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round_tbl_transcript.pdf)) at 20-21 (discussing the lack of discovery in *inter partes* reexamination). The report contrasts *inter partes* reexamination to a proposed “post-grant review process,” in which “[c]losely controlled discovery and cross-examination would be available in the review, upon the challenger’s presenting sufficient grounds that one or more of the patent claims are unpatentable.” *Id.* at 8. Accordingly, the public and the Office understood that discovery was not available in *inter partes* reexamination, and that additional legislation would be required to provide for such discovery.

On September 16, 2011, Congress enacted The America Invents Act (the AIA), which, replaces *inter partes* reexamination with a new proceeding titled *inter partes* review, effective September 16, 2012. The statute expressly provides for discovery in newly enacted 35 U.S.C. § 316 (Conduct of *inter partes* review), which instructs the Director to “prescribe regulations . . . setting forth standards and procedures for discovery of relevant evidence, including that such discovery will be limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is necessary in the interests of justice.” *See* Pub. L. No. 112-29, Section 6. The legislative history of the new proceeding confirms that Congress intended to provide discovery where none had previously been available:

The Act converts *inter partes* reexamination from an examinational to an adjudicative proceeding, and renames the proceeding “*inter partes* review.” The Act also makes the following improvements to this proceeding:

- Discovery. Parties may depose witnesses submitting affidavits or declarations and seek such discovery as the Patent Office determines is otherwise necessary in the interest of justice.

H. Rep. No. 112-98 (Part 1) 112th Cong., 1st Sess., at 46-47 (2011) (available at <http://www.gpo.gov/fdsys/pkg/CRPT-112hrpt98/pdf/CRPT-112hrpt98-pt1.pdf>).

Congress's characterization of the provision for limited discovery in *inter partes* review as an "improvement" over *inter partes* reexamination settles any dispute concerning the proper interpretation of the *inter partes* reexamination statute. The AIPA does not authorize discovery in *inter partes* reexamination proceedings.

The patent owner argues that case law relating to discovery in patent interferences supports the ability to obtain discovery under 35 U.S.C. 24 without prior Office approval. However, the enactment of the *inter partes* review discovery provision of the AIA, which sets limits on permissible discovery in *inter partes* review, confirms that the patent owner cannot rely on 35 U.S.C. 24 in isolation to provide authorization for discovery in Office proceedings. The anomalous result of patent owner's argument would be that because the *inter partes* reexamination statute failed to provide for discovery, more discovery would be available under *inter partes* reexamination than under *inter partes* review. That result is plainly contrary to Congress's intent.

Furthermore, 35 U.S.C. 24 applies to contested cases within the Patent and Trademark Office. However, an *inter partes* reexamination proceeding is not a contested case, also as argued by the third party requester of the '552 proceeding.<sup>2</sup> The Office's interpretation of 35 U.S.C. 314 to exclude authorization for discovery in *inter partes* reexamination proceedings, including the interpretation that *inter partes* reexamination proceedings are not "contested cases" within the meaning of 35 U.S.C. 24, is confirmed by the Office's promulgation of rules specifically governing discovery for interferences, while none were drafted for *inter partes* reexamination proceedings. See, e.g., 37 CFR 41.150(a), which states: "[a] party is not entitled to discovery except as authorized in this subpart". Finally, if Congress intended to permit discovery in *inter partes* reexamination proceedings, it would have modeled those proceedings on "contested cases" such as interferences, and not on proceedings such as initial examination or *ex parte* reexamination, which are not contested cases, and which do not include discovery. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did "not subject the patent to any greater challenge in scope than currently exists today" but "merely allows a reexam requestor the option to further explain why a particular patent should not have been granted").

In summary, discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Accordingly, patent owner's October 7, 2011 petition under 37 CFR 1.182 is **denied**. For the same reasons, patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is also **denied**.

This decision constitutes the Office's final decision concerning whether discovery is permissible in *inter partes* reexamination proceedings.

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<sup>2</sup> See the November 2, 2011 opposition by the third party requester, Abbott Laboratories, of *inter partes* reexamination proceeding 95/000,552.

### CONCLUSION

- Patent owner's October 7, 2011 petition under 37 CFR 1.182 is denied.
- Patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is denied.
- This decision is designated as a final agency action under 5 U.S.C. § 704.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



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Brian E. Hanlon  
Director  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,552 • 95/000542	06/14/2010	7591844	01035.0068-00000	9463
45511	7590	12/30/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-30-11

MARK D. SWEET

FINNEGAN, HENDERSON, FARABOW, GARRET & DUNNER

901 NEW YORK AVENUE N.W.

WASHINGTON, DC 2001-4413

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000552 95/000542

PATENT NO. : 7591844

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**CENTRAL REEXAMINATION UNIT** (For Patent Owner)

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(For 95/000,542 Third Party Requester)

Mark D. Sweet  
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Washington, DC 20001-4413

(For 95/000,552 Third Party Requester)

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,542  
Filed: April 15, 2010  
For: U.S. Patent No. 7,591,844

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: **DECISION**  
: **GRANTING**  
: **PETITION**

*In re Llanos et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,552  
Filed: June 14, 2010  
For: U.S. Patent No. 7,591,844

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This is a decision on the 95/000,552 third party requester, Abbott Laboratories (Abbott), paper entitled "RENEWED PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 CFR §1.947" (the renewed petition under 37 CFR 1.183), filed on August 30, 2011.

The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

## DECISION

### I. Background

On January 21, 2011, the Office mailed a non-final office action in the instant merged 95/000,542 and 95/000,552 proceeding (the merged proceeding). On March 21, 2011, patent owner filed a petition under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit for its concurrently-filed response submission. On April 20, 2011, Abbott filed a petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its concurrently-filed comments submission. On June 14, 2011, the Office mailed a decision dismissing patent owner's March 21, 2011 petition and not entering patent owner's response submission, and dismissing as moot Abbott's April 20, 2011 petition and not entering Abbott's comments submission (the June 14, 2011 decision).

On June 28, 2011, in accordance with the June 14, 2011 decision, patent owner filed a renewed petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its concurrently-filed corrected response submission. On August 3, 2011, the Office mailed a decision granting patent owner's June 28, 2011 petition and entering patent owner's June 28, 2011 corrected response submission, giving Abbott and the 95/000,542 requester 30 days from the mailing date of that decision to file written comments limited to issues raised by the January 21, 2011 Office action or the patent owner's corrected response submission. On August 30, 2011, Abbott filed the instant renewed petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its concurrently-filed comments submission.<sup>1</sup>

### II. Abbott's August 30, 2011 Renewed Petition under 37 CFR 1.183

Requester Abbott states that the instant renewed petition under 37 CFR 1.183 is responsive to the June 14, 2011 and August 3, 2011 decisions.<sup>2</sup> The June 14, 2011 decision states that to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that adheres to the formatting guidelines set forth therein to enable the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission.<sup>3</sup> The August 3, 2011 decision reiterates the June 14, 2011 decision in stating that "[i]n the event Abbott files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a comments submission, the content of which is identical to that of the April 20, 2011 comments submission, such renewed petition would be grantable."<sup>4</sup>

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<sup>1</sup> See the renewed petition under 37 CFR 1.183 at page 1.

<sup>2</sup> Id. It is noted that Abbott refers to the August 3, 2011 decision as "the August 2, 2011 decision"; the decision was signed on August 2, 2011 and mailed on August 3, 2011.

<sup>3</sup> June 14, 2011 decision at page 6.

<sup>4</sup> August 3, 2011 decision at page 4. It is noted that Abbott's August 30, 2011 comments submission was not required to be identical in content to its June 14, 2011 comments submission because the entry of patent owner's corrected response on August 3, 2011 started a new statutory time period for requester comments submissions.



In the instant renewed petition under 37 CFR 1.183, Abbott states that the August 30, 2011 comments “are very similar to its previous submission”, but notes the following changes:

... a change in the font size from 11 to 12; the addition of the text “both used in repairing arteries” at the end of the first full paragraph on page 4; the addition of a short section bridging pages 7 and 8 to address the new information submitted by Cordis in its August 8, 2011, Information Disclosure Statement; the addition of two lines of text to the last paragraph on page 15; the addition of less than six lines of text at the end of the second paragraph on page 16; and formatting, typographical, and grammatical changes to the text. Abbott also submits that the Helmus Declaration is nearly identical to the previously submitted Helmus Declaration except for formatting, typographical, and grammatical changes.<sup>5</sup>

In this instance, Abbott requests waiver of the regulatory page limit so that “Abbott be permitted to fully and fairly address all of the issues raised in the 99-page Office Action and in Cordis’s 42-page Response and 80-page Mikos Declaration” and “specifically requests an increase in the regulatory page limit by 55 pages.”<sup>6</sup>

Abbott’s August 30, 2011 comments comprise 59 pages of remarks that count toward the regulatory page limit (the cover page, table of contents and list of attachments are excluded from the page count). Additionally, at least portions of the 72-page declaration of Michael N. Helmus, Ph.D., are deemed to be an extension of the arguments of counsel and count toward the regulatory page limit.<sup>7</sup>

Although the content of Abbott’s August 30, 2011 comments submission differs slightly from that of Abbott’s April 20, 2011 comments submission, the reasons previously set forth in the June 14, 2011 decision supporting waiver of the regulatory page limit for Abbott’s April 20, 2011 comments submission are equally applicable to Abbott’s August 30, 2011 comments submission. Thus, the individual facts and circumstances of this case demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b) for Abbott’s August 30, 2011 comments submission. Accordingly, Abbott’s August 30, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of Abbott’s August 30, 2011 comments submission for the reasons set forth in the decision of June 14, 2011. **This waiver makes Abbott’s August 30, 2011 comments submission page-length compliant.**

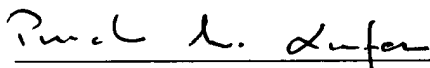
<sup>5</sup> The renewed petition under 37 CFR 1.183 at page 3.

<sup>6</sup> Id. at pages 3-4 and FN 3 (stating, “Abbott’s Comment comprises 59 pages. The accompanying Helmus Declaration contains 69 pages. However, the pages including Dr. Helmus’ curriculum vitae, work experience and publications were not counted towards the page limit. In accordance with the Office, Abbott believes that only Section V, spanning pages 33-69 contain argument as to how an outstanding or proposed rejection is supported. Although Abbott believes pages 24-33 merely provide background factual information, in an abundance of caution, Abbott has also included those pages in counting the regulatory page limit. Therefore, Abbott believes that 46 pages of the Helmus Declaration should count toward the regulatory page limit for a total of 105 pages and the corresponding request for a 55 page increase in the page limit.”).

<sup>7</sup> See, e.g., Section IV of the Helmus declaration, spanning pages 24-69.

### CONCLUSION

1. Requester Abbott Laboratories' August 30, 2011 renewed petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived **to the extent necessary to permit entry of Abbott's August 30, 2011 comments submission. This waiver makes Abbott's August 30, 2011 comments submission page-length compliant.**
2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

12-27-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,552 + 95/000,542	06/14/2010	7591844	01035.0068-00000	9463
45511	7590	02/23/2012	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-23-12

MARK D. SWEET

FINNEGAN, HENDERSON, FARABOW, GARRET & DUNNER

901 NEW YORK AVENUE N.W.

WASHINGTON, DC 2001-4413

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000552 → 95/000542

PATENT NO. : 7591844

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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WOODCOCK WASHBURN LLP      FEB 23 2012      (For Patent Owner)  
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Mark D. Sweet      (For 95/000,552 Requester)  
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GARRETT & DUNNER, LLP  
901 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20001-4413

<i>In re Llanos et al.</i>	:	
<i>Inter Partes</i> Reexamination Proceeding	:	
Control No. 95/000,542	:	DECISION ON PETITION
Filed: April 15, 2010	:	UNDER 37 CFR 1.181
For: U.S. Patent No. 7,591,844	:	AND OPPOSITION
	:	THEREFOR
<i>Inter Partes</i> Reexamination Proceeding	:	FOR WITHDRAWAL OF
Control No. 95/000,552	:	THE ACTION CLOSING
Filed: June 14, 2010	:	PROSECUTION
For: U.S. Patent No. 7,591,844	:	

This is a decision addressing Patent Owner's petition, filed February 6, 2012 under 37 CFR 1.181, and a third party Requester's petition, filed February 14, 2012, in opposition to Patent Owner's petition. The petitions concern whether the Action Closing Prosecution was proper.

The petitions are before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit for decision.

Patent Owner's petition is DENIED.

Requester's opposition petition is GRANTED to the extent that Patent Owner's petition is denied.

### BACKGROUND

1. U.S. Patent Number 7,591,844 (the '844 patent) issued to Llanos et al. on September 22, 2009, with 24 claims.
2. A first request for *inter partes* reexamination, assigned Reexamination Control No. 95/00,542 ("the '542 proceeding"), was filed by a third party requester on April 15, 2010. Boston Scientific SCIMED, Inc. is identified as the real party in interest.
3. A second request for *inter partes* reexamination, assigned Reexamination Control No. 95/000,552 ("the '552 proceeding"), was filed by another third party requester on June 14, 2010. Abbott Laboratories is identified as the real party in interest.
4. On June 30, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '542 reexamination proceeding. An Office action containing at least one rejection of each of claims 1-24 of the '844 patent in the '542 reexamination proceeding was mailed on the same date.
5. On August 25, 2010, an order granting reexamination of claims 1-24 of the '844 patent was mailed for the '552 reexamination proceeding.
6. On August 30, 2010, patent owner timely filed a response to the Office action in the '542 proceeding, retaining original patent claims 1-24 as unamended. The response included a first declaration under 37 CFR 1.132 by Antonios G. Mikos, to support patent owner's arguments pertaining the rejections, such as contentions that there are no reasons to combine the prior art teachings.
7. On September 29, 2010, third party requester timely filed comments in the '542 proceeding, pursuant to 37 CFR 1.947, including a declaration under 37 CFR 1.132 by Chris Scott.
8. On November 26, 2010, a decision merging the '542 and '552 proceedings ("merged proceedings") were mailed.
9. On January 21, 2011, an Office action on the merits was mailed in the merged proceedings. The Office action contained obviousness rejections for claims 1-24. The Office action also addressed the August 30, 2010 response, including the Mikos declaration and the September 29, 2010 comments, including the Scott declaration. See, e.g., pages 78-93 of the Office action.
10. On March 21, 2011, Patent Owner filed a response to the Office action. The response included a second declaration under 37 CFR 1.132 by Antonios G. Mikos, to support patent owner's arguments pertaining the obviousness rejections, such as contentions that there are no reasons to combine the prior art teachings.
11. On April 20, 2011, Requester, Boston Scientific, in the '542 proceeding filed comments in response to Patent Owner's response and submitted a declaration by Gary L. Loomis in support of the rejections of the claims. On the same day, Requester, Abbott Laboratories, in the '552

proceeding filed comments in response to Patent Owner's response and submitted a declaration by Michael N. Helmus in support of the rejections of the claims.

12. Due to the eventual grant of petitions under 37 CFR 1.183 requesting that the Office waive the page limit of 37 CFR 1.943(b), Patent Owner and both Requesters were able to file replacement response and comments, respectively. See the August 8, 2011 decision.

13. On February 1, 2012, the Office mailed an Action Closing Prosecution.

11. On February 6, 2012, Patent Owner filed the petition under 37 CFR 1.181.

12. On February 14, 2012, Requester filed the opposition petition under 37 CFR 1.181 requesting that the Office deny Patent Owner's petition filed on February 6, 2012.

### DECISION

In the February 6, 2012 petition, Patent Owner argues that the examiner substantially modified her positions in the Action Closing Prosecution (ACP) by the alleged improper reliance on declarations submitted by the Requesters in the merged proceedings. For these reasons, Patent Owner requests that the ACP be withdrawn. Patent Owner also requests that a new examiner be assigned to the proceedings.

In response to Patent Owner's arguments for reopening prosecution in this reexamination proceeding, the Director finds there are not good and sufficient reasons to do so for the reasons set forth below. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an action closing prosecution.

Turning to the facts in this proceeding, Patent Owner asserts that the examiner's response to arguments and evidence essentially resulted in new grounds of rejection, which requires that prosecution be reopened. Specifically, Patent Owner argues that the examiner has modified her position in several obviousness rejections by relying on the declarations and evidence filed by the Requesters in their comments. This argument is not persuasive for the following reasons. Specifically, upon review of the record, it is noted that the ACP maintained the rejections (Grounds 4-15, 29-41, 48-53, and 69-83) that were applied in the January 21, 2011 non-final Office action. See pages 93-96 in the January 21, 2011 Office action and pages 4-7 in the ACP. Therefore, no new grounds of rejections were set forth in the ACP. As explained above, reexamination procedures are required to proceed with special dispatch under 35 U.S.C. 305. The record clearly shows that the examiner set forth the *exact* same rejections as in the non-final Office action of January 21, 2011. The basis for which petitioner requests reopening of prosecution is the examiner's response to arguments and evidence pertaining to obviousness issues presented in the Patent Owner's response to the January 21, 2011 Office action. To reiterate, in the ACP, the examiner was addressing arguments and evidence of the Patent Owner

by referring to the arguments and evidence filed in the Requester's comments, and did not modify or alter the grounds of rejection.

As discussed in more detail below, the Requesters are permitted to file comments, including the filing of declarations to support their comments, on the obviousness issues raised by the Patent Owner and the Office action. In accordance with Office procedures, the examiner considered both the Patent Owner's and third party Requesters' arguments and evidence and addressed such in the ACP. It is noted that the examiner followed the same procedure in the January 21, 2011 Office action. Specifically, the examiner addressed both the first Mikos declaration and Scott declaration as part of her response. See, e.g., pages 79-85. For example, in addressing the arguments/evidence for Ground 5, the examiner supported her position with a citation to the Scott declaration on pages 79 and 82 of the January 21, 2011 Office action. Petitioner points to pages 65-66 of the ACP as an example of showing that the examiner *de facto* introduced a new ground of rejection. However, it is noted that pages 65-66 of the ACP also addresses arguments pertaining to Ground 5 and applies the declaration evidence of record in substantially similar manner as that applied in the January 21, 2011 Office action. In fact, all the pages alleged to have new grounds of rejection are part of the examiner's response to issues raised by the Patent Owner and the Requesters. Upon review of the record, the examiner followed Office policy and procedures by stating agreement or disagreement with the positions of the Patent Owner and third party Requesters and providing reasons for the examiner's position. It would be impossible to ever close prosecution if the examiner could not to do so because he or she addressed evidence filed by the parties after a non-final Office action. The statutory requirement of special dispatch is clear that prosecution is not meant to continue without end. Upon review of the record, the examiner's rebuttal is consistent with the prior position taken by the examiner, and therefore does not constitute a *de facto* new ground of rejection by addressing the arguments and evidence submitted in response to the January 21, 2011 Office action. There is no new ground of rejection where the basic thrust of the examiner's rejection remains the same. See MPEP 1207.03 (III). Therefore, no new grounds of rejection were made, and Office policies and procedures do not require reopening of prosecution. See MPEP 2673.01. For these reasons, the issuance of the ACP is in accordance with Office rules and procedures.

In regard to Patent Owner's arguments that they have been prejudiced, as stated above, the rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an ACP. As discussed above, the record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP, and did not categorically deprive the patent owner of its statutory rights to present amendments and arguments in reexamination proceedings.

Patent Owner also generally asserts that the evidence filed by the Requesters was improperly entered into the reexamination records and considered by the examiner because there is no procedural basis for a Requester to file a declaration in support of their comments on the Patent Owner's response.



Patent Owner's position is not supported by statute, regulation, or the guidance of the MPEP. MPEP 2617(II) states:

Affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in any reexamination.

Furthermore, MPEP 2658, which describes the scope of reexamination proceedings, states in subsection IV.G.:

Affidavits under 37 CFR 1.131 and 1.132 may be utilized in a reexamination proceeding.

The guidance provided above in the MPEP is grounded in the statutes that established *inter partes* reexamination, including 35 U.S.C. 314, which states, in part:

(a) IN GENERAL.- Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for **initial examination under the provisions of sections 132 and 133**. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(b) RESPONSE.-

(1) With the exception of the *inter partes* reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the *inter partes* reexamination proceeding.

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the **third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto**, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response. (emphasis added in bold).

As pointed out in the decision of *In re Chambers*, 20 USPQ2d 1470 (Comr. Pats. 1991), the reexamination statute provides for evidentiary affidavits and declarations to help define the scope and content of the prior art. See also *In re Baxter Travenol Labs*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1992) that applied the *Chambers* principle and found that affidavits and declarations are proper to help define the scope and content of the prior art. While the legal precedent was addressing *ex parte* reexamination, it also applies to *inter partes* reexamination, established after the decisions were rendered. Moreover, there is no provision in the statutes and regulations that prohibits a requester from filing a declaration as part of its comments on a patent owner's response to an Office action. In fact, the statutes, regulations, and guidance make it clear that declaration practice is permitted in *inter partes* reexamination proceedings.

The declarations filed by the Requesters clearly fall within the scope of what is permissible as set forth in the laws, regulations, and guidance cited above. Specifically, the declarations address the patentability issues raised by the Patent Owner in their response. For example, the declarations speak to the issues of whether there is a reason to combine the prior art teachings and the level of skill and knowledge in the art. For these reasons, the Patent Owner's petition failed to show that

the third party Requesters' comments, including the declarations and evidence, were not compliant with 37 CFR 1.947, which proscribes the requirements for a third party requester's comments.

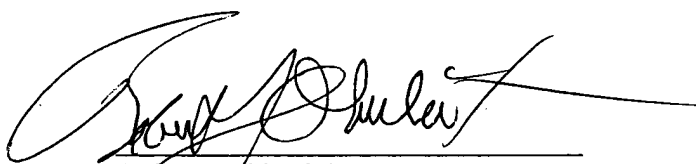
In summary, the examiner appropriately followed Office rules and procedures in deciding to issue the ACP, and closed prosecution in the interest of "special dispatch" in accordance with Office rules and procedures. For the reasons set forth above, the examiner followed Office rules and procedures and did not abuse her discretion in deciding to issue an ACP.

In regard to Patent Owner's request for a new examiner to be assigned to the proceeding, the request is respectfully declined. Patent Owner has not shown that the assignment of the merged proceedings to this examiner has violated the policies and procedures set forth in MPEP 2636. In the interest of special dispatch and the best use of resources, Patent Owner's request is not granted.

Accordingly, good and sufficient reasons to reopen prosecution and to assign a new examiner to the reexamination proceedings have not been provided and the Patent Owner's petition is denied.

#### CONCLUSION

1. Patent Owner's petition filed February 6, 2012 is **DENIED** for the reasons discussed above.
2. Requester's petition filed February 14, 2012 is **GRANTED** to the extent that patent owner's petition is denied.
3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.



Robert J. Oberleitner,  
Assistant Deputy Commissioner for Patent Operations and  
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,554	06/23/2010	6,772,142	2525.314REXO	3118
23676	7590	12/14/2010	EXAMINER	
SHELDON MAK & ANDERSON PC 100 Corson Street Third Floor PASADENA, CA 91103-3842			ART UNIT	PAPER NUMBER

DATE MAILED: 12/14/2010

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WASHINGTON, DC 20005

Date:

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**DEC 14 2010**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000554  
PATENT NO. : 6772142  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

**MAILED**

**DEC 14 2010**

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein & Fox P.L.L.C.  
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Washington, DC 20005

(For Requester)

In re Steven T. Kelling et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,554  
Filed: June 23, 2010  
For: U.S. Patent No. 6,772,142

:  
: **DECISION**  
: **GRANTING**  
: **PETITION UNDER**  
: **37 CFR 1.137(b)**

This is a decision on the December 3, 2010 patent owner petition under 37 CFR 1.137(b) to accept a delayed response to Office action and revive the present terminated<sup>1</sup> reexamination proceeding ("the December 3, 2010 patent owner petition to revive").

The December 3, 2010 patent owner petition to revive has been treated as a petition under the unintentional standard of 37 CFR 1.137(b) and is before the Office of Patent Legal Administration (OPLA) for consideration.

The December 3, 2010 patent owner petition to revive under the unintentional standard is **granted**.

**STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES**

**35 U.S.C. 41(a)(7) provides, in pertinent part:**

REVIVAL FEES. — On filing each petition ... for an unintentionally delayed response by the patent owner in any reexamination proceeding ...

<sup>1</sup> Although a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" within the meaning of 37 CFR 1.957(b) for failure of the patent owner to timely file a response under 37 CFR 1.945(a) to the August 27, 2010 Office action.

**35 U.S.C. 133 provides:**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

**35 U.S.C. 314(a) provides, in pertinent part:**

IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.

**37 CFR 1.137 provides, in pertinent part:**

(b) *Unintentional*. If the delay in reply by ... patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive ... a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c) .... A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional ....

\*  
\*

(d) *Terminal disclaimer*.

\*  
\*

- (3) The provisions of paragraph (d)(1) of this section do not apply to ... reexamination proceedings.

**37 CFR 1.945(a) provides, in pertinent part:**

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination.

**37 CFR 1.957(b) provides, in pertinent part:**

If no claims are found patentable, and the patent owner fails to file a timely and appropriate response in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed

to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

**37 CFR 1.958(b) provides, in pertinent part:**

Any response by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed response must be filed in compliance with § 1.137(b).

**MPEP 2668 provides, in pertinent part:**

**II. PETITION BASED ON UNINTENTIONAL DELAY**

The unintentional delay fee provisions of 35 U.S.C. 41(a)(7) are imported into, and are applicable to, any reexamination proceeding by Sec. 4605(a) of the American Inventors Protection Act of 1999. Accordingly, the Office will consider, in appropriate circumstances, a petition showing unintentional delay under 37 CFR 1.137(b) where untimely papers are filed by the patent owner subsequent to the order for reexamination. Any such petition must provide a verified statement that the delay was unintentional, a proposed response to continue prosecution (unless it has been previously filed), and the petition fee required by 37 CFR 1.17(m).

\*

\*

**IV. FURTHER DISCUSSION OF THE PETITION REQUIREMENTS**

See also MPEP § 711.03(c), subsection III, for a detailed discussion of the requirements of petitions filed under 37 CFR 1.137(a) and (b).

**DECISION**

***The Petition Under 37 CFR 1.137(b) is Granted***

A grantable petition under 37 CFR 1.137(b) for a reexamination proceeding must be accompanied by: (1) a response to the outstanding Office action; (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional.

Regarding item (1), this reexamination proceeding prosecution was terminated under 37 CFR 1.957(b) due to patent owner's failure to timely submit a response to the August 27, 2010 Office action pursuant to 37 CFR 1.945(a). 37 CFR 1.945(a) provides that the patent owner will be given at least thirty days to file a response to any Office action on the merits of the *inter partes* reexamination. The August 27, 2010 Office action set a two-month period for response. A proper response to the August 27, 2010

Office action was not filed until November 30, 2010, which was untimely. However, for the purpose of evaluating whether the December 3, 2010 patent owner petition to revive under the unintentional standard is a grantable petition, the submission of the November 30, 2010 Response To Office Action Mailed August 27, 2010 In *Inter Partes* Reexamination satisfies item (1).<sup>2</sup>

The small entity unintentional standard petition fee of \$810.00 has been charged to patent owner, consistent with patent owner's December 3, 2010 fee transmittal, which satisfies item (2).

Regarding item (3), none of the statements provided in the December 3, 2010 petition to revive (e.g., "[t]he one hour delay in responding to the outstanding Office Action was either unavoidable or unintentional") specify that the **entire** delay in filing the required response, **from the due date of the response to the filing of a grantable petition**, was unintentional, as is required by 37 CFR 1.137(b)(3). However, the statements contained in the December 3, 2010 petition to revive, collectively, are being so construed, thereby satisfying item (3). Patent owner **must** notify the Office **if** the Office has misconstrued the statements provided in the December 3, 2010 petition to revive.

Accordingly, the December 3, 2010 patent owner petition to revive under the unintentional standard is **granted**.

### ADDITIONAL DISCUSSION

The December 3, 2010 patent owner petition seeks to revive the instant reexamination proceeding either under the unavoidable or unintentional standard.

MPEP 711.03(c) makes abundantly clear that the "unavoidable delay" standard invoked by a petition under 37 CFR 1.137(a) is a stringent standard. For example, MPEP 711.03(c) makes clear that, whereas 37 CFR 1.137(b) merely requires **a statement** that the entire delay in filing the required response, from the due date of the response to the filing of a grantable petition, was unintentional, 37 CFR 1.137(a) requires **a showing accompanied by documentary evidence** that not only the delay which resulted in the abandonment of the application was unavoidable, but also that the delay until the filing of a grantable petition to revive was unavoidable.

The December 3, 2010 patent owner petition to revive makes no showing at all with respect to the time period between patent owner's November 30, 2010 transmissions and patent owner's December 3, 2010 filing of the petition to revive.

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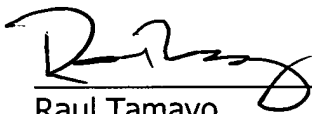
<sup>2</sup> This decision is not directed to the persuasiveness and propriety of the arguments presented in the November 30, 2010 Response To Office Action Mailed August 27, 2010 In *Inter Partes* Reexamination as to each of the rejections set forth in the August 27, 2010 Office action; such is the examiner's province.



Accordingly, the December 3, 2010 patent owner petition to revive has been treated as a petition under the unintentional standard of 37 CFR 1.137(b).

### CONCLUSION

1. The December 3, 2010 patent owner petition has been **granted** under 37 CFR 1.137(b).
2. Patent owner's response to the August 27, 2010 Office action is hereby entered in the record, thus triggering a comment right for third party requester under 37 CFR 1.947. Accordingly, third party requester may file comments to patent owner's response as per 37 CFR 1.947 within 30 days of the mailing date of this decision.
3. Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7728.



Raul Tamayo  
Legal Advisor  
Office of Patent Legal Administration

December 10, 2010



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,557	07/16/2010	6947903	09449.0023-00000	4089
21005	7590	03/09/2011	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			ART UNIT	PAPER NUMBER

DATE MAILED: 03/09/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Joseph Palys

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**MAILED**

**MAR 09 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000557

PATENT NO. : 6947903

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW,  
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901 NEW YORK AVENUE, NW  
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(For Third Party Requester)

MAILED

MAR 09 2011

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,557  
Filed: July 16, 2010  
For: U.S. Patent No. 6,947,903

: **DECISION GRANTING**  
: **PETITIONS AND**  
: **WAIVING PAGE LIMIT**  
:

This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT REQUIREMENTS WITH RESPECT TO PATENT OWNER'S RESPONSE TO OFFICE ACTION OF SEPTEMBER 27, 2010," filed on December 27, 2010, and third party requester's petition entitled "PETITION SEEKING WAIVER OF 37 CFR § 1.943 FOR COMMENTS BY THIRD PARTY REQUESTOR UNDER 37 CFR § 1.947," filed on January 26, 2011.

The patent owner and third party requester petitions are before the Office of Patent Legal Administration.

Both the patent owner petition and the third party requester petitions are granted, for the reasons set forth herein.

**BACKGROUND**

1. On September 20, 2005, United States Patent No. 6,947,903 (the '903 patent) issued to Perry.
2. On July 16, 2010, a request for *inter partes* reexamination of the '903 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/000,557 (the '557 proceeding).

3. On September 27, 2010, *inter partes* reexamination was ordered in the '557 proceeding. Concurrently on September 27, 2010, a non-final Office action was mailed in the '557 proceeding.
4. On October 29, 2010, patent owner filed a request for extension of time to file its response to the September 27, 2010 Office action.
5. On November 3, 2010, the Office mailed a decision granting patent owner's October 29, 2010 request for extension of time and extending the time period for patent owner's response by one month to December 27, 2010.
6. On December 27, 2010, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT REQUIREMENTS WITH RESPECT TO PATENT OWNER'S RESPONSE TO OFFICE ACTION OF SEPTEMBER 27, 2010" (patent owner petition under 37 CFR 1.183), concurrently with a patent owner response to the September 27, 2010 Office action. The instant decision addresses patent owner's petition under 37 CFR 1.183.
7. On January 26, 2011, third party requester filed the instant petition entitled "PETITION SEEKING WAIVER OF 37 CFR § 1.943 FOR COMMENTS BY THIRD PARTY REQUESTOR UNDER 37 CFR § 1.947" (requester petition under 37 CFR 1.183) concurrently with third party requester comments to the December 27, 2010 patent owner response and the September 27, 2010 Office action. The instant decision also addresses third party requester's petition under 37 CFR 1.183.

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## II. Patent Owner Petition Under 37 CFR 1.183

Patent owner's December 27, 2010 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the September 27, 2010 Office action, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner's December 27, 2010 response. In particular, patent owner states that the December 27, 2010 response "has 158 total pages" and that "[t]he declaration attached to the Response has 5 total pages and 185 pages of Exhibits, which is not believed to part of the page limit."<sup>1</sup> Patent owner further states that it "undertook diligent effort to file as succinct of a response as possible, without sacrificing Patent Owner's substantive rights."<sup>2</sup>

In support of waiver of 37 CFR 1.943(b), patent owner states that "[t]he Office Action contains 62 pages of substantive rejections and incorporates by reference the Request for Reexamination to provide support for the rejections. The Request for Reexamination itself is 1,648 pages in length and it includes 5,775 pages of exhibits and 3,026 pages of claim charts."<sup>3</sup> Patent owner asserts that the present facts present an extraordinary situation in which justice requires waiver of the page limit in view of "the application of multiple separate art rejections for many of the claims, the page length of the instant Office Action, and the capacious material relied on and incorporated by the Office Action...."<sup>4</sup> Patent owner asserts that it cannot be expected to address the rejections within the 50 page limit when "[t]he Office Action setting forth those rejections is itself in excess of 60 pages and incorporates just under 10,500 pages of arguments, exhibits and claim charts."<sup>5</sup> Additionally, patent owner asserts that it "actively worked to submit the

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<sup>1</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>2</sup> Id.

<sup>3</sup> Id.

<sup>4</sup> Id.

<sup>5</sup> Id. at pages 2-3.

Response in as few pages and words as would adequately and completely address the numerous rejections” and that “[i]n an attempt to reduce the page count of the Response, for example, to avoid repeating arguments, Patent Owner referenced arguments that were common to multiple rejections when they were applicable in the separate rejections....”<sup>6</sup>

Based on the individual facts and circumstances of this case such as, for example, the size of the September 27, 2010 Office action, including the number of rejections and incorporation by reference of pages from the request for reexamination in the ‘557 proceeding,<sup>7</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner’s December 27, 2010 response that count toward the page limit is 163 pages.<sup>8</sup> The substantive portion of the September 27, 2010 Office action has been determined to span much more than 163 pages.<sup>9</sup> Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner’s response to the September 27, 2010 Office action not exceed 163 pages. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s response to the September 27, 2010 Office action to exceed the page limit by 113 pages. This waiver makes patent owner’s December 27, 2010 response submission page-length compliant.

### III. Third Party Requester Petition Under 37 CFR 1.183

Third party requester’s January 26, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

In the instant petition under 37 CFR 1.183, third party requester requests “[t]hat the Office accept its comments containing 76 pages,” excluding “amendments, appendices of claims, and reference materials.”<sup>10</sup> In support of waiver of 37 CFR 1.943(b), requester states that the “Office

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<sup>6</sup> Id. at page 3.

<sup>7</sup> See Office action at pages 11-29.

<sup>8</sup> Pursuant to MPEP 2667(I)(A)(2), only those pages of patent owner’s response upon which arguments appear are included against the page limit count. The remarks portion of the December 27, 2010 response includes 158 pages of arguments. The December 27, 2010 response also includes a declaration by inventor Perry, referencing exhibits A-F. As set forth in MPEP 2667(I)(A)(2), affidavits or declarations that are excluded from the page limit requirements include, for example, declarations that provide comparative test data and an analysis of same. Further, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. The five pages of the Perry declaration are deemed to count toward the page limit, but the pages of accompanying exhibits are excluded from the page limit count.

<sup>9</sup> It is noted that, on its face, the substantive portion of the September 27, 2010 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only about 56 pages but relies heavily on incorporation by reference of approximately 700 pages from the request for *inter partes* reexamination in the ‘557 proceeding to set forth the rejections.

<sup>10</sup> Requester petition under 37 CFR 1.183 at page 1. Also submitted with the comments on January 26, 2011 are declarations by Demesa, Metzger, Smith and Therborn.

Action is 62 pages long and the Response is 163 pages long (which includes a 5-page declaration from the named inventor discussing one of the prior art references).<sup>11</sup> Waiver of 37 CFR 1.943(b) is requested “[b]ecause of the numerous issues raised by [patent owner’s] 163-page Response ... and the issues raised in the 62-page Office Action.”<sup>12</sup> Requester asserts that it “has made every effort to pare down its comments, but submits that 50 pages are inadequate to address and respond to the issue raised by the Examiner and [patent owner].”<sup>13</sup> Requester further asserts that it “has made every effort to pare down its comments by referring back wherever possible.”<sup>14</sup>

Based on the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance, to the extent stated. The total number of pages of third party requester’s January 26, 2011 comments submission that count toward the page limit is 76 pages.<sup>15</sup> Requester’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting third party requester’s comments submission exceed the page limit by up to 26 pages. This waiver makes third party requester’s January 26, 2011 comments submission page-length compliant.

## CONCLUSION

1. Patent owner’s December 27, 2010 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s December 27, 2010 response submission to exceed the page limit by 113 pages. This waiver makes patent owner’s December 27, 2010 response submission page-length compliant.
2. Third party requester’s January 26, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester’s January 26, 2011 comments submission to exceed the page limit by 26 pages. This waiver makes requester’s January 26, 2011 comments submission page-length compliant.

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<sup>11</sup> Id. at page 1.

<sup>12</sup> Id. at page 2.

<sup>13</sup> Id. at pages 1-2.

<sup>14</sup> Id. at page 3.

<sup>15</sup> Pursuant to MPEP 2667(I)(A)(2), only those pages of requester’s comments upon which arguments appear are included against the page limit count. The remarks portion of requester’s January 26, 2011 comments submission includes 71 pages of arguments. The January 26, 2011 comment submission also include declarations by Demesa, Metzger, Smith and Therborn. As set forth in MPEP 2667(I)(A)(2), affidavits or declarations that are excluded from the page limit requirements include, for example, declarations that provide comparative test data and an analysis of same. Further, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Five pages of the Metzger declaration are deemed to count toward the page limit and no pages of the Demesa, Smith and Therborn declarations, and their accompanying exhibits, are deemed to count toward the page limit.



3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.

/Kenneth M. Schor/

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Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

03-9-2011  
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,557	07/16/2010	6947903	09449.0023-00000	4089
21005	7590	09/26/2011	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			ART UNIT	PAPER NUMBER

DATE MAILED: 09/26/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

Joseph Palys

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP  
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WASHINGTON, DC 20001

**MAILED**

**SEP 26 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000557

PATENT NO. : 6947903

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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SEP 26 2011

CENTRAL REEXAMINATION UNIT

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WASHINGTON, DC. 20001

(For Third Party Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,557  
Filed: July 16, 2010  
For: U.S. Patent No. 6,947,903

:  
: **DECISION**  
: **GRANTING**  
: **PETITIONS**  
:

This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT REQUIREMENTS WITH RESPECT TO PATENT OWNER'S RESPONSE TO OFFICE ACTION OF MARCH 14, 2011," filed on June 14, 2011, and third party requester's petition entitled "PETITION SEEKING WAIVER OF 37 CFR § 1.943 FOR COMMENTS BY THIRD PARTY REQUESTOR UNDER 37 CFR § 1.947," filed on July 14, 2011.

The patent owner and third party requester petitions are before the Office of Patent Legal Administration.

Both the patent owner and the third party requester petitions are granted, for the reasons set forth herein.

**BACKGROUND**

1. On September 20, 2005, United States Patent No. 6,947,903 (the '903 patent) issued to Perry.
2. On July 16, 2010, a request for *inter partes* reexamination of the '903 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/000,557 (the '557 proceeding).
3. On September 27, 2010, *inter partes* reexamination was ordered in the '557 proceeding. Concurrently on September 27, 2010, a non-final Office action was mailed in the '557 proceeding.

4. The '557 proceeding progressed to the point where, on March 14, 2011, the Office mailed a second non-final Office action on the merits.
5. On June 14, 2011, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT REQUIREMENTS WITH RESPECT TO PATENT OWNER'S RESPONSE TO OFFCE ACTION OF MARCH 14, 2011" (patent owner petition under 37 CFR 1.183), concurrently with a patent owner response to the March 14, 2011 Office action.<sup>1</sup> The instant decision addresses patent owner's petition under 37 CFR 1.183.
6. On July 14, 2011, third party requester filed the instant petition entitled "PETITION SEEKING WAIVER OF 37 CFR § 1.943 FOR COMMENTS BY THIRD PARTY REQUESTOR UNDER 37 CFR § 1.947" (requester petition under 37 CFR 1.183) concurrently with third party requester comments after the June 14, 2011 patent owner response. The instant decision also addresses third party requester's petition under 37 CFR 1.183

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR

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<sup>1</sup> See April 18, 2011 decision granting patent owner's April 15, 2011 request for a one-month extension of time to file patent owner's response.

1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Additionally, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response or third party requester comments submission that:

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (*e.g.*, Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response or a third party requester comments submission.

#### A. Patent Owner Petition Under 37 CFR 1.183

Patent owner's June 14, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the March 14, 2011 Office action, has been fully considered.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner's June 14, 2011 response. In particular, patent owner states that the June 14, 2011 response "has 96 total pages" and that "[t]he declarations attached to the Response include a total of 12 pages and 83 pages of Exhibits, which is not believed to be part of the page limit."<sup>2</sup> Patent owner further states that it "undertook diligent effort to file as succinct of a response as possible, without sacrificing Patent Owner's substantive rights."<sup>3</sup>

In support of waiver of 37 CFR 1.943(b), patent owner states that "[t]he Second Office Action contains 118 pages of substantive analysis and rejections for the 55 pending claims and includes 28 cited references (13 of which are newly cited)" and that "the Second Office Action incorporates by reference the Request for Reexamination to provide support for the rejections."<sup>4</sup> Patent owner also states that "the Office has further adopted additional portions of the Request that were previously not adopted; specifically, the Office Action incorporates 22 additional proposed rejections by the Third Party Requester" presented in requester's previously-filed comments submission.<sup>5</sup> Patent owner asserts that it cannot be expected to address the rejections within the 50 page limit when "[t]he Office Action setting forth those rejections is itself in excess of 120 pages and incorporates just over 10,600 pages of arguments, exhibits and claim charts."<sup>6</sup> Patent owner asserts that "the application of multiple separate art rejections for many of the claims, the page length of the instant Office Action, and the capacious material relied on and incorporated by the Office Action" present an extraordinary situation in which justice requires waiver of the page limit.<sup>7</sup> Additionally, patent owner asserts that it "actively worked to submit the Response in as few pages and words as would adequately and completely address the numerous rejections" and that "[i]n an attempt to reduce the page count of the Response, for example, to avoid repeating arguments, Patent Owner referenced arguments that were common to multiple rejections when they were applicable in the separate rejection sections, thereby reducing the page count...."<sup>8</sup>

In this instance, patent owner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a response that is in excess of 50 pages. In view of the guidance set forth above, the June 14, 2011 response submission includes up to 96 pages of arguments.<sup>9</sup> Based on patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case such as, for example, the size of the March 14, 2011 Office action, including the number of rejections and incorporation by reference of pages from the request for reexamination

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<sup>2</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>3</sup> Id.

<sup>4</sup> Id.

<sup>5</sup> Id.

<sup>6</sup> Id. at page 3.

<sup>7</sup> Id.

<sup>8</sup> Id. at page 3.

<sup>9</sup> The June 14, 2011 response also includes a Declaration of Giovanna Fessenden including Exhibits A-J; a Declaration of James M. Smith; and a Declaration of Brian Perry including Exhibits A and B. Based on the guidance set forth herein, the declarations provide factual evidence and none of the pages of the Fessenden, Smith and Perry declarations and accompanying exhibits are deemed to count toward the regulatory page limit.

in the '557 proceeding,<sup>10</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's June 14, 2011 response submission exceeds the regulatory page limit by up to 46 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's June 14, 2011 response submission to exceed the regulatory page limit by up to 46 pages. This waiver makes patent owner's June 14, 2011 response submission page-length compliant.

### **B. Third Party Requester Petition Under 37 CFR 1.183**

Third party requester's July 24, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

In the instant petition under 37 CFR 1.183, third party requester requests "[t]hat the Office accept its comments containing 67 pages."<sup>11</sup> In support of waiver of 37 CFR 1.943(b), requester states that the "Office Action is 121 pages long and the Response is 96 pages long" and that "[b]ecause of the numerous issues raised by [patent owner's] 96-page Response, and the issues raised in the 121-page Office Action" waiver of 37 CFR 1.943(b) is requested.<sup>12</sup> Requester asserts that it "has made every effort to pare down its comments, referring back wherever possible" but "submits that 50 pages are inadequate to address and respond to the issue raised by [patent owner] and the Examiner."<sup>13</sup>

In this instance, requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting comments in excess of 50 pages. Based on requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit and submitting the resulting comments which are in excess of 50 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance, to the extent requester's July 24, 2011 comments submission exceeds the regulatory page limit by up to 17 pages.<sup>14</sup> Accordingly, requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting third party requester's July 24, 2011 comments submission to exceed the regulatory page limit by up to 17 pages. This waiver makes third party requester's July 24, 2011 comments submission page-length compliant.

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<sup>10</sup> See Office action at pages 11-72. It is noted that, on its face, the substantive portion of the March 14, 2011 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only about 100 pages but relies heavily on incorporation by reference of approximately 800 pages from the request for *inter partes* reexamination in the '557 proceeding to set forth the rejections.

<sup>11</sup> Requester petition under 37 CFR 1.183 at page 1 (stating that the requester is submitting "comments which contain 67 pages including 64 pages of substantive comments and a 3 page declaration by Sue McFarland Metzger, which discusses one of the prior art references.").

<sup>12</sup> Id. at page 2.

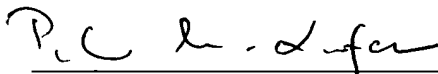
<sup>13</sup> Id. at pages 1-2.

<sup>14</sup> The remarks portion of requester's July 24, 2011 comments submission includes 64 pages of arguments. The declaration by Sue McFarland Metzger is 3 pages long. Thus, the July 24, 2011 comments submission includes up to 67 pages of arguments.



### CONCLUSION

1. Patent owner's June 14, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's June 14, 2011 response submission to exceed the page limit by up to 46 pages. This waiver makes patent owner's June 14, 2011 response submission page-length compliant.
2. Third party requester's July 24, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's July 24, 2011 comments submission to exceed the page limit by up to 17 pages. This waiver makes requester's July 24, 2011 comments submission page-length compliant.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



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Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

9-25-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,557	07/16/2010	6947903	09449.0023-00000	4089
21005	7590	02/24/2012	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph Palys

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001

Date:

MAILED

FEB 24 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000557

PATENT NO. : 6947903

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

HAMILTON, BROOK, SMITH  
& REYNOLDS, P.C.  
530 VIRGINIA ROAD  
P.O. BOX 9133  
CONCORD MA 01742-9133

(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER  
901 NEW YORK AVE., NW  
WASHINGTON, DC 20001

(For Third Party Requester)

*In re Perry*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,557  
Filed: July 16, 2010  
For: U.S. Patent No. 6,947,903

:  
: **DECISION DISMISSING**  
: **PETITION UNDER**  
: **37 C.F.R. § 1.183**  
:

This is a decision on the October 9, 2011 patent owner petition entitled "Petition Under 37 C.F.R. § 1.182 Petition to Dismiss-Inter Parte Reexamination" [sic], and the October 24, 2011 requester petition entitled "Requester's Petition to Respond to Patent Owner's October 9, 2011 Petition."

The petitions are before the Office of Patent Legal Administration.

The petition under 37 C.F.R. § 1.182 is dismissed.

### BACKGROUND

1. On April 7, 2000, an application for patent by inventor Brian M. Perry was filed at the Office; the application was assigned application number 09/546,347 ("the '347 patent application"). The application claimed priority to U.S. provisional application number 60/147,670, filed on August 6, 1999.
2. A first Office action was issued on the '347 patent application on October 9, 2002.
3. Prosecution of the application proceeded until, on May 13, 2005, the Office issued a Notice of Allowance of the '347 application.

4. On June 13, 2005, applicant paid the issue fee for the '347 application.
5. On September 20, 2005, the '347 application was issued as U.S. Patent Number 6,947,903 ("the '903 patent").
6. On July 16, 2010, a request meeting the filing date requirements for *inter partes* reexamination of all of the claims (claims 1-55) of the '903 patent was deposited by the third party requester, and the resulting reexamination proceeding was assigned control number 95/000,557 ("the '557 proceeding").
7. On September 27, 2010, the Office issued an order granting the request for *inter partes* reexamination, and an Office action rejecting claims 1-55.
8. On December 27, 2010, patent owner filed a response to the September 27, 2010 Office action.
9. On January 26, 2011, requester filed comments under 37 C.F.R. § 1.947.
10. On March 14, 2011, the Office issued a non-final action rejecting claims 1-55.
11. On June 14, 2011, patent owner filed a response to the March 14, 2011 Office action.
12. On July 14, 2011, requester filed comments under 37 C.F.R. § 1.947.
13. On October 2, 2011, the Office issued an Action Closing Prosecution ("ACP"), rejecting claims 1-55 and closing prosecution in the proceeding.
14. On October 9, 2011, patent owner filed the instant petition, entitled "Petition Under 37 C.F.R. § 1.182 Petition to Dismiss-Inter Parte Reexamination" [sic].
15. On October 24, 2011, the requester filed an opposition petition entitled "Requester's Petition to Respond to Patent Owner's October 9, 2011 Petition."

## **STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES**

The American Inventors Protection Act of 1999 states that:

Subject to subsection (b), this subtitle and the amendments made by this subtitle shall take effect on the date of the enactment of this Act and shall apply to *any patent that issues from an original application* filed in the United States on or after that date. (emphasis added).

35 U.S.C. 111 provides, in pertinent part:

(b) PROVISIONAL APPLICATION

(b)(8) APPLICABLE PROVISIONS. —The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title. (emphasis added).

35 U.S.C. 131 provides:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. 151 provides, in pertinent part:

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant.

35 U.S.C. 314 provides, in pertinent part:

[R]eexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

37 C.F.R. § 1.181(f) states:

Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.913 states:

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for inter partes reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

## DECISION

The present patent owner petition requests that the Director refine the interpretation of the phrase “original application” as set forth in section 4608 of the April 11, 2000 Official Gazette for the

purposes of rulemaking; and in doing so, terminate the ‘557 *inter partes* reexamination. Patent owner petitioner contends that the ‘903 patent under reexamination issued from a provisional application filed on August 6, 1999, and that the provisional application should be considered to be an “original application.” Petitioner presents two lines of reasoning that would both need to be persuasive in order to accept the conclusion that *inter partes* reexamination is not available for the ‘903 patent.

Petitioner’s primary reasoning is that U.S. nonprovisional application number 09/214,306, which matured into the ‘903 patent, is not an “original application” from which the patent issued. Petitioner reasons that if the patent issued from the provisional application, it “is actually axiomatic” that the patent could not also issue from the nonprovisional application because there cannot be two “original applications” from which a patent issues.<sup>1</sup>

As detailed below, this reasoning is in direct conflict with the Federal Circuit’s holding in *Cooper Technologies v. Dudas*. The Federal Circuit in *Cooper Techs.* held that both a parent application and a continuation application met the definition of the phrase “original application” as pertains to *inter partes* reexamination.

Petitioner’s secondary reasoning is based upon the statement from the Federal Circuit’s decision in *In re Giacomini*, “[a]n application that a patent was ‘granted on’ is the first U.S. application to disclose the invention claimed in the patent.”<sup>2</sup> Petitioner alleges that this statement necessitates that a nonprovisional application is not an “original application” which the patent “issues from” under the meaning of the American Inventors Protection Act of 1999 (“AIPA”), whenever that nonprovisional application claims priority to a provisional application which first disclosed the invention claimed in the patent.

As detailed below, the statements by the court in *Giacomini* fail to redefine the interpretation of § 4608 of the AIPA. First, *Giacomini* did not overrule *Cooper Techs.*, because it did not address the same issue and a later panel decision of the Federal Circuit cannot overrule an earlier panel decision of the Federal Circuit.<sup>3</sup> Second, *Giacomini*’s discussion of a patent being “granted on” a provisional application is limited to the effect of a provisional application on a patent-defeating date for purposes of 35 U.S.C. 102(e), and not to any interpretation of § 4608.

#### 1. The ‘903 Patent Issued From an Original Nonprovisional Application, No. 09/214,306.

Section 4608 of the American Inventors Protection Act of 1999 stated that *inter partes* reexamination is authorized for “any patent that issues from an original application filed in the United States on or after” November 29, 1999.<sup>4</sup> In a contemporaneous Office publication, the Office interpreted “original application . . . to encompass utility, plant and design applications, including first filed applications, continuations . . .” and stated that the MPEP defines an original

<sup>1</sup> See petition at 5. No support is presented for this axiom.

<sup>2</sup> *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010) (citing *In re Klesper*, 397 F.2d 882, 885-86 (CCPA 1968)).

<sup>3</sup> See, e.g., *Mother’s Restaurant v. Mama’s Pizza*, 723 F.2d 1566, 1573 (Fed. Cir. 1983).

<sup>4</sup> AIPA § 4608, 113 Stat. at 1501A-572, enacted on November 29, 1999. *Id.*, 113 Stat. at 1501.

application as “an application which is not a reissue application.”<sup>5</sup>

In the 2008 case of *Cooper Techs.*, the Federal Circuit stated that “the Patent Office’s interpretation of section 4608 is permissible and therefore entitled to deference.”<sup>6</sup> In *Cooper Techs.*, the Federal Circuit found that an application filed after November 29, 1999 was subject to *inter partes* reexamination, despite the fact that the application claimed priority under 35 U.S.C. 120 to an earlier filed, copending U.S. application which was filed before November 29, 1999. As the Federal Circuit explained in *Cooper Techs.*, the phrase “original application” does not necessarily mean the first application in a chain - the phrase does not have a single definitive meaning but depends on the context. *Cooper Techs.*, 536 F.3d at 1338. The phrase “original application” as used in *inter partes* reexamination therefore does not necessarily mean the first filed nonprovisional application in the chain.

Therefore, patent owner’s contention that “[t]here simply cannot be two ‘original applications’ in the very same patent prosecution in the present context,”<sup>7</sup> is in direct conflict with the Federal Circuit’s decision in *Cooper Techs.* In that decision, the Federal Circuit gave deference to the Patent Office’s interpretation of “original application” as including both first filed applications and continuations. Petitioner would ask that the later-filed be disqualified as an “original application” simply because it claimed benefit under 35 U.S.C. 120 to the filing date of an earlier filed application – thus causing the opposite result to that reached by the court in *Cooper Techs.*

In the instant case, an application for patent was filed under 35 U.S.C. 111(a) by inventor Brian M. Perry on April 7, 2000. This nonprovisional patent application was assigned application number 09/546,347, and examined pursuant to 35 U.S.C. 131. On September 20, 2005, the ‘347 application was issued as U.S. Patent Number 6,947,903 (“the ‘903 patent”). Following the rule set forth by *Cooper Techs.*, since the ‘347 application was filed after November 29, 1999, the patent that issued from that application would be subject to *inter partes* reexamination, regardless of whether or not that application claimed priority to any earlier application. Since patent owner petitioner’s requested interpretation of § 4608 of the AIPA would be in conflict with that set forth in *Cooper Techs.*, it cannot be adopted to find here that the patent issued from an application with a filing date before November 29, 1999, such that the patent is not subject to *inter partes* reexamination.

## 2. The *Giacomini* Decision Does Not Alter the *Cooper* Interpretation of Section 4608

The question of whether a patent is “granted on” an “application for patent” is an issue that arises under 35 U.S.C. 102(e).<sup>8</sup> The Federal Circuit in *Giacomini* addressed the question of whether a provisional application is an “application for patent” for which “a patent is granted on” under

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<sup>5</sup> U.S. Patent and Trademark Office, Guidelines Concerning the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term “Original Application” in the American Inventors Protection Act of 1999, 1233 Official Gazette 54, 56 (Apr. 11, 2000)

<sup>6</sup> *Cooper Technologies Company v. Dudas*, 537 F.3d 1330 (Fed. Cir. 2008).

<sup>7</sup> Patent owner petition at 18 (bolded in original).

<sup>8</sup> 35 U.S.C. 102 states that “[a] person may be entitled to a patent unless . . . (e) the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . . .”



§ 102(e)(2).<sup>9</sup> The *Giacomini* court quoted from an earlier decision in *In re Klesper*, also addressing § 102(e), for the proposition that “[a]n application that a patent was ‘granted on’ is the first U.S. application to disclose the invention claimed in the patent.”<sup>10</sup>

*Giacomini* stands for the proposition that a provisional application is an “application for patent . . . filed in the United States,” under the meaning of § 102(e). The holding of the court in *Giacomini* is that a “patent has a patent-defeating effect as of the filing date of the [patent’s] provisional.”<sup>11</sup> Therefore a patent claiming the benefit of the filing date of that provisional application satisfies certain requirements under § 102(e), permitting that patent to be available as prior art as of the filing date of the provisional application. Such a proposition is evident in the plain language of the text of 35 U.S.C. 111(b), which states that a provisional application is a “provisional application for patent.”

However, pursuant to 35 U.S.C. 111(b)(8), a provisional application, while an application for the prior art-defeating purposes of § 102(e), is not an application that is examined under § 131 such that a patent may be issued upon the provisional application.<sup>12</sup> Only where applicant requests that the provisional application be converted into a nonprovisional application, through 35 U.S.C. 111(b)(5), may such an application be treated as a nonprovisional application and be subject to examination and issuance of a patent.<sup>13</sup> In the absence of such a request, § 111(b)(5) causes a provisional application to be regarded as abandoned 12 months after the filing date of the provisional application.

Furthermore, the *Giacomini* court did not address the question at issue in this petition, that of the applicability of *inter partes* reexamination to a patent which contains a reference to an earlier filed provisional application, and did not state that a patent may “issue from” a provisional application in accordance with AIPA § 4608. The question in *Giacomini* was solely whether an applicant is entitled to a patent if another’s patent discloses the same invention, which was carried forward from an earlier U.S. provisional application or U.S. non-provisional application.

Thus, a provisional application satisfies the requirement of § 102(e) of “an application for patent” for which a patent may be “granted on”, for the purposes of applying as prior art a patent claiming the benefit of the provisional application. The *Giacomini* decision does not state that a provisional application is an “original application” from which a patent may issue as used in AIPA § 4608. Nothing in the *Giacomini* decision is read as altering prior interpretation of AIPA

<sup>9</sup> *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010) (quoting 35 U.S.C. 102(e), as stating “[A] person shall be entitled to a patent unless . . . the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . .”).

<sup>10</sup> *Id.* (quoting from *In re Klesper*, 397 F.2d 882, 885 (CCPA 1968)).

<sup>11</sup> *Id.* at 1385.

<sup>12</sup> As set forth in §§ 111(b)(8) and 131, the patent laws do not permit issuance of a patent on the mere filing of a provisional application under 35 U.S.C. § 111(b). 35 U.S.C. § 151, entitled “Issue of patent”, also requires that for a patent to issue, the applicant “must be entitled to a patent under the law.” This language is the same as in § 131, and is not interpreted to provide a separate route to an issued patent for provisional applications. As petitioner is not arguing that a provisional application, by itself, is entitled to issue as a patent, this decision refrains from engaging in a more extensive analysis.

<sup>13</sup> This provision of 35 U.S.C. § 111 contradicts petitioner’s allegations that the provisional and the nonprovisional are “actually one and the same.” Petition at 17. On the contrary, these are separate applications in the absence of a request from applicant that the provisional be treated as a nonprovisional application.

§ 4608. Therefore, a provisional application is not an “original application” from which a patent may issue, and therefore a provisional application, by itself, may not satisfy the requirements of AIPA § 4608.

### 3. Conclusion

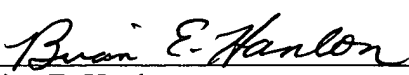
For the reasons given above, the ‘903 patent which issued from the ‘306 application, filed after November 29, 1999, is properly subject to *inter partes* reexamination. Petitioner’s plea that the *inter partes* reexamination be inapplicable to the ‘903 patent is found to lack sufficient basis, and therefore the petition is **dismissed**.

With respect to the timeliness of the petition as to terminate the reexamination, the petition was filed on October 9, 2011, six months after reexamination was ordered for the ‘903 patent. A petition under § 1.182 must, however, be filed “within two months of mailing date of the action or notice from which relief is requested,” or such a petition may be dismissed as untimely pursuant to § 1.181(f). As the instant petition was filed outside the permitted time period, the instant petition was not filed in accordance with § 1.181(f).

With respect to the petition’s request that the term “original application” be redefined to exclude from *inter partes* reexamination those patents having a benefit claim to a provisional application filed prior to November 29, 1999, the Office shall consider such as a comment submitted in furtherance of ongoing efforts to improve reexamination procedures.

### CONCLUSION

1. The October 9, 2011 patent owner petition is **dismissed**.
2. Further correspondence with respect to this matter should be addressed as follows:  
  
By mail: Mail Stop Inter Partes Reexam  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450
3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

  
\_\_\_\_\_  
Brian E. Hanlon  
Director  
Office of Patent Legal Administration

February 21, 2012



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JAN 21 2011

Skaar Ulbrich Macari, P.A. CENTRAL REEXAMINATION UNIT (For Patent Owner)  
601 Carlson Parkway :  
Suite 1050 :  
Minneapolis, MN 55305 :

OBLON, SPIVAK, MCCLELLAND : (For Third Party  
MAIER & NEUSTADT, L.L.P. : Requester)  
1940 DUKE STREET :  
ALEXANDRIA, VA 22314 :

*In re: Shuster et al.* :  
*Inter Partes* Reexamination Proceeding : DECISION ON PETITION  
Control No.: 95/000,559 : UNDER 37 CFR § 1.181  
Deposited: August 24, 2010 :  
For: U.S. Patent No.: 7,595,764 B2 :

This is a decision on a petition filed by the patent owner on December 20, 2010 entitled "PATENT OWNER'S PETITION UNDER 37 C.F.R. 1.181 TO VACATE *ULTRA VIRES* ORDER GRANTING INTER PARTES REEXAMINATION" and is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to vacate the October 18, 2010 Order Granting Request for *Inter Partes* Reexamination.

The petition is before the Director of the Central Reexamination Unit.

The petition under 37 CFR § 1.181 is dismissed.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,595,764 issued on September 29, 2009.
- A request for *inter partes* reexamination was filed and assigned control number 95/000,559, ultimately receiving a filing date of August 24, 2010.
- Reexamination was ordered and mailed together with a first action on the merits on October 18, 2010.
- On December 20, 2010, the Patent owner timely filed the instant petition with a response to the first action.
- On January 3, 2011, the third party requester timely filed an opposition to the instant petition as permitted by MPEP § 2646(II).

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### MPEP § 2646 Decision Ordering Reexamination

### II. PETITION TO VACATE THE ORDER GRANTING REEXAMINATION (in part):

A substantive determination by the Director of the Office to institute reexamination pursuant to a finding that the prior art patents or printed publications raise a substantial new question of patentability is not subject to review by petition or otherwise. *See Joy Mfg. Co. v. Nat'l Mine Serv. Co., Inc.*, 810 F.2d 1127, 1 USPQ2d 1627 (Fed. Cir. 1987); *Heinl v. Godici*, 143 F.Supp. 2d 593 (E.D. Va. 2001). Note further the decision of *Patlex Corp. v. Quigg*, 680 F.Supp. 33, 6 USPQ2d 1296, 1298 (D.D.C. 1988) (the legislative scheme leaves the Director's 35 U.S.C. 303 determination entirely to his discretion and not subject to judicial review). These decisions were rendered for *ex parte* reexamination; however, the holdings of these decisions apply equally in *inter partes* reexamination proceedings, since the language of 35 U.S.C. 302(c) (i.e., the *ex parte* reexamination statute) is also found in 35 U.S.C. 312(c) (i.e., the *inter partes* reexamination statute). Because the substantive determination is not subject to review by petition or otherwise, neither the patent owner nor the third party requester has a right to petition, or request reconsideration of, a finding that the prior art patents or printed publications raise a substantial new question. There is no right to petition such a finding even if the finding of a substantial new question is based on reasons other than those urged by the third party requester (or based on less than all the

grounds urged by the third party requester). Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be argued by the patent owner and appealed during the examination phase of the reexamination proceeding.

A petition under 37 CFR 1.181 may, however, be filed to vacate an *ultra vires* reexamination order, such as where the order for reexamination is not based on prior art patents and printed publications. In cases where no discretion to grant a request for reexamination exists, a petition to vacate the decision to grant, or a request for reconsideration, will be entertained. "Appropriate circumstances" under 37 CFR 1.181(a)(3) exist to vacate the order granting reexamination where, for example:

- (A) the reexamination order is not based on prior art patents or printed publications;
- (B) reexamination is prohibited under 37 CFR 1.907;
- (C) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;
- (D) reexamination was ordered for the wrong patent;
- (E) reexamination was ordered based on a duplicate copy of the request; or
- (F) the reexamination order was based wholly on the same question of patentability raised by the prior art previously considered in an earlier concluded examination of the patent by the Office (e.g., the application which matured into the patent, a prior reexamination, an interference proceeding).

## DECISION

The Patent owner ["petitioner"] states that the Order Granting the Request for *Inter Partes* Reexamination is *ultra vires* and must be vacated. Each substantial new question of patentability granted in the Order relies in part on the reference described as TCS, and petitioner argues that there is no evidence that this document is a patent or printed publication.

The MPEP clearly states that "[w]here the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable." MPEP § 2646(II). It goes on to state that this is a matter that cannot be questioned with respect to vacating the order until a final agency decision on the proceeding has issued, and

that the proper avenue for questioning this issue is by argument and appeal during the examination stage.

Petitioner argues that a petition to vacate is permissible because reexamination is not based on patents and printed publications, citing MPEP § 2646(II)(A). Petition p. 4. This portion of section 2646 is also quoted above, and states that a petition may be filed to vacate an *ultra vires* reexamination order in appropriate circumstances where no discretion to grant the request exists, such as where the order is not based on patents or printed publications.

Petitioner's reading of the MPEP is not correct, as it would clearly contradict the immediately preceding paragraph explicitly stating that such an issue is not petitionable. Rather, it is apparent that section 2646(II)(A) permits a petition only where no discretion exists to grant the request. A determination of whether a reference is a printed publication falls under the examiner's discretion, and as stated above this may be argued by patent owner during examination. MPEP § 2646(II)(A) does not refer to a case where the examiner determines that a reference is a printed publication, but instead refers to a case when an order is based upon issues that cannot be alleged to be patents or printed publications at all. For example, if a reexamination request were granted based upon an indefinite issue under 35 U.S.C. § 112, such an action would be petitionable as *ultra vires* as the examiner has no discretion to grant such a request.

The examiner, in granting the request, has at least implicitly determined that the TCS reference pages relied upon are a printed publication. As stated in the MPEP, such a determination is not petitionable, therefore the petition is dismissed.

### CONCLUSION

1. The petition under 37 CFR § 1.181 for vacating the Order as *ultra vires* is dismissed.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,562	09/17/2010	7,002,533	D450 0011/GNM	4958
22434	7590	09/13/2011	EXAMINER	
Weaver Austin Villeneuve & Sampson LLP			ART UNIT	
P.O. BOX 70250			PAPER NUMBER	
OAKLAND, CA 94612-0250				

DATE MAILED: 09/13/2011

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Oakland, CA 94612-0250

(For Patent Owner) **MAILED**

**SEP 13 2011**

John Carpenter  
Dolby Laboratories Inc.  
100 Potrero Ave.  
San Francisco, CA 94103

(For Requester) **CENTRAL REEXAMINATION UNIT**

*In re Sayag*  
Reexamination Proceeding  
Control No. 95/000,562  
For: U.S. Patent No. 7,002,533

: DECISION GRANTING  
: PETITION UNDER  
: 37 CFR 1.181 AND  
: 37 CFR 1.515(c)

This is a decision on the November 13, 2010 paper entitled "PETITION UNDER 37 C.F.R. 1.181 and 1.927 FOR RECONSIDERATION OF ORDER DENYING REQUEST FOR *INTER PARTES* REEXAMINATION." No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

The petition is **Granted** for the reasons set forth below.

**REVIEW OF FACTS**

1. U.S. Patent No. 7,002,533 (hereinafter, the '533 patent) issued on February 21, 2006 to Michel Sayag.
2. On August 2, 2010, a Request for *Inter Partes* Reexamination of the '533 patent was deposited by a third party requester, and this reexamination proceeding was assigned Control No. 95/000,562 (hereinafter, the '562 proceeding). The Request sought reexamination of claims 1-30.
3. On August 18, 2010, the office mailed a NOTICE OF FAILURE TO COMPLY WITH *INTER PARTES* REEXAMINATION REQUEST FILING REQUIREMENTS.



4. On September 17, 2010, a corrected Request for *Inter Partes* Reexamination of the '533 patent was deposited by a third party requester, and this proceeding was assigned a filing date.
5. On October 14, 2010, an Order Denying Request for *Inter Partes* Reexamination was mailed. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.
6. On November 13, 2010, the present petition was filed. A supplemental petition was filed on November 15, 2010.

## DISCUSSION

Third party requester ("Petitioner") in the '533 proceeding has petitioned seeking relief from the Examiner's November 14, 2010 Order denying *ex parte* reexamination for all requested claims.

### I. Standard of Review

37 CFR 1.927 and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for patent claims 1-30 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 312(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 CFR § 1.927 provides:

The third party requester may seek review by a petition to the Director under 37 CFR § 1.181 within one month of the mailing date of the examiner's determination refusing to order *inter partes* reexamination. Any such petition must comply with 37 CFR § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

MPEP § 2648 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The Director's review will be *de novo*.

If a petition is timely filed, the petition (together with the reexamination file) is forwarded to the office of the CRU Director for decision. The CRU Director will then review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be *de novo*. Each decision by the CRU Director will conclude with the following paragraph:

This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

If the petition is granted, the decision of the CRU Director should include a sentence stating that an Office action will be mailed in due course.

MPEP § 2642 provides, in pertinent part:

For "a substantial new question of patentability" to be present, it is only necessary that:

(A) The prior art patents and /or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the prior art patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and

(B) The same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

It is not necessary that a "prima facie" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either anticipated by, or obvious in view of, the prior art patents or printed publications.

MPEP § 2658.I by way of MPEP § 2258.I (G) provides, in pertinent part:

During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (*In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)).

## II. Summary of the Most Pertinent Patent Prosecution History, the Reexam Prosecution History, the Current Petition and the Most Pertinent cited References.

### Pertinent Patent Prosecution History

Claims 1-30 are the current claims in the '533 patent which issued to Michel Sayag on February 21, 2006 from application 10/218,199 filed on August 13, 2002. Claim 1 is representative:

A display apparatus, comprising: a first display disposed in a first plane, having a first area and configured to generate a first image based upon first image data; a second display disposed in a second plane, having a second area and configured to generate a second image based upon second image data, the first image data comprising lower spatial frequency content than the second image data; and a projection device for projecting the first image substantially into the second plane, thereby superimposing a projected image and the second image.

In a first Non-Final rejection (10/5/2004) the examiner rejected the claims as being anticipated or obvious US 5,978,142 to Blackham *et al* alone or in combination with one or more additional references.

In an amendment (1/04/2005) responsive to the first office action, the applicant amended two of the independent claims to include the limitation from dependent claim 8 wherein "the first image data comprising lower spatial frequency content than the second image data" and also argued, among other things, that the prior art did not teach "the first image data comprising lower spatial frequency content than the second image data" and did not teach "an optical low pass filter," "a filter for removing high spatial frequency components from the first image data," or "a filter for filtering high spatial frequency data and low spatial frequency data from the image data."

Following the response and amendment, the examiner issued a Final rejection wherein most of the claims were rejected, with some claims being objected to.

In arguments and remarks (7/1/2005) submitted after the Final rejection, the applicant specifically referring to the recitations in claim 1 of the *first image data comprising lower spatial frequency content than the second image data* and projecting the first image into the second image plane *thereby superimposing a projected image and the second image* argued that those limitations, or similar limitations were common to all of the independent claims, and that such limitations were not disclosed or suggested by the prior art. Applicant also explained how certain embodiments of the invention exemplified the common claim language.

Following the response, the examiner issued a Notice of Allowability (11/03/2005) with no additional explanation.

### Pertinent Reexamination History

Following the receipt of the corrected *Inter Partes* Request (9/17/2010), the reexaminer issued an order (10/14/2010) denying the Request.

In the order denying the Request, the examiner indicated, among other things, that in the Request, five separate groups of primary reference combinations (relying on Arakawa, Gibbon, Crossland, Mir and Blackham, respectively) were asserted to raise substantial new questions of patentability.

The examiner further indicated that based on the patent prosecution history, a reasonable examiner would consider a teaching of display apparatus including 1<sup>st</sup> and 2<sup>nd</sup> displays associated with 1<sup>st</sup> and 2<sup>nd</sup> image data with the “1<sup>st</sup> image data comprising lower spatial frequency content than the 2<sup>nd</sup> image data” as a proper basis for a substantial new question of patentability as to claims 1-30.

The examiner indicated that a reasonable examiner knowledgeable in the imaging arts would interpret the phrase “spatial frequency” in terms of the “local spatial frequencies of a wavefront” such that the spatial frequency would relate to the periodicity of a wave across space, i.e., the spatial frequency in Fourier Optics.

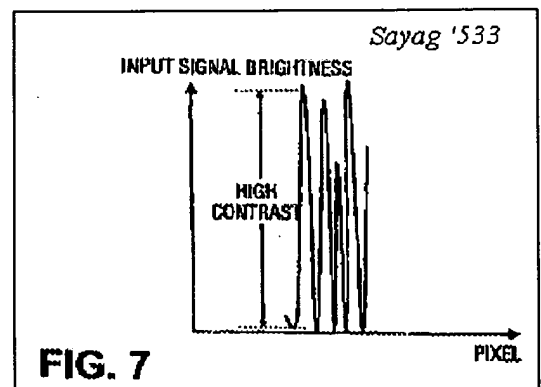
The examiner also noted that Third Party Requester proposed an interpretation of “spatial frequency” that was inconsistent with [broader in scope] than the interpretation as would be understood by a person of ordinary skill in the art.

### Pertinent Petition Information

The Requester/Petitioner asserts that the claims do not refer to “local spatial frequencies”, but merely refer to the “spatial frequency content” and that the term “spatial frequency” with regard to image data is more commonly understood by those of ordinary skill in the art as being a measure of how rapidly brightness or other characteristics change over distance (Petition at pages 6 and 11; Goodman declaration at par. 8) and that such meaning is consistent with the way it is used in the ‘533 patent and effectively illustrated in Fig. 7.

The Requester/Petitioner further asserts that the common understanding of “lower spatial frequency content” as described and claimed in the ‘533 patent refers to brightness or intensity values of image data (or pixels) changing more slowly as compared to higher spatial frequency content data (Petition at page 11).

The Requester/Petitioner notes that while Fourier Optics or analysis could be used to assist in designing a particular filter for altering the spatial frequency content of image data (Petition at page 11), the actual use of Fourier transforms, or the



use of Fourier Optics or analysis is not required by the claims (Petition at page 11). Requester/Petitioner also notes that while a Fourier transform could be utilized to manipulate the spatial frequency of the image data, other ways of manipulating spatial frequency data can be used (Petition at page 6).

The Requester/Petitioner further notes (page 7) that the '533 patent provides specific examples of lowering spatial frequency of images and image data content such as by using any known low-pass and high pass filters, wherein the filters may be optical filters, digital or analog electronic filters, or combinations thereof ('533 patent at col. 6, line 58 to col. 7, line 16) with one specific example being a simple convolution kernel which replaces a pixel value with the weighted average of the pixel and its neighboring pixels ('533 patent at col. 7, lines 21-27).

The Requester/Petitioner asserts (page 8) that the '533 patent associates the low and high spatial frequency images with respective low resolution and high resolution displays ('533 patent at col. 6, lines 49-57).

#### The Principal References Cited in the Request

1. **Arakawa** (US 6,268,843) discloses a flat panel display apparatus (Fig. 1) including a 1<sup>st</sup> display (20) and a 2<sup>nd</sup> displays (30) with the 1<sup>st</sup> display generating a lower resolution image than the 2<sup>nd</sup> display (col. 3, lines 1-4). Arakawa further teaches that the 1st image data (S1) has lower spatial frequency content (col. 3, lines 30-42).
2. **Gibbon** (US 7,050,122) discloses an image projection system (Fig. 1) including a 1<sup>st</sup> display (2) and a 2<sup>nd</sup> display (3) wherein the 1<sup>st</sup> display may have a lower resolution than the 2<sup>nd</sup> display (col. 5, lines 53-57; col. 10, lines 30-37). Gibbon further teaches that the 1st image data has lower spatial frequency content (col. 7, lines 3-45).
3. **Crossland** (WO00/40018) discloses an image display system (Fig. 1) including a 1<sup>st</sup> display (1) and a 2<sup>nd</sup> display (5) wherein the 1<sup>st</sup> display may have a lower pixilation than the 2<sup>nd</sup> display (page 9, lines 4-11). Contrary to the assertions in the Request, however, Crossland does not teach that the 1st image data has lower spatial frequency content that the 2<sup>nd</sup> image data. Instead, Crossland teaches that the first image data contains data representing a plurality (e.g., 4) of sequentially generated images that are projected to different portions (e. g., quadrants) of the second display in order to build up the final image (page 3, 23-25). In other words, even though the second display may have a higher pixilation or resolution, the second image is not based on different image data, but rather is based on the same sequentially transmitted first image data.
4. **Mir** (US 4,374,397) discloses an electronic imaging apparatus (Fig. 7) including a 1<sup>st</sup> display (85) and a 2<sup>nd</sup> display (81) wherein the 1<sup>st</sup> display may have a lower resolution than the 2<sup>nd</sup> display (col. 7, lines 24-28). Mir further discloses that the 1st image data (via S-1, S-2, S-3, etc.) has lower spatial frequency content than the second image data (via I, II, III, etc.) (col. 7, lines 31-44).

5. **Blackham** (US 5,978,142 is old prior art utilized in a rejection of the claims during the original prosecution. During the original prosecution of the '533 patent, the Blackman reference was considered to teach many of the features of the claims except that Blackman did not teach at least the *first image data comprising lower spatial frequency content than the second image data*. Requester has asserted that the Blackman reference should be considered in a new light because Blackman teaches that the 1<sup>st</sup> and 2<sup>nd</sup> modulators are driven with different functional signals (col. 3, lines 37-40). Requester indicates (Request at page 11) that as one example, the first modulator may produce a fully modulated image and the second modulator may be use to compress the dynamic range of the image signal (Blackham at col. 5, lines 24-26). Requester further argues (page 11) that a compressed dynamic range image would have lower spatial frequency content than a fully modulated image because the difference between pixel values would be reduced in the compressed dynamic range image. Regardless of any inherent spatial frequency characteristic of the final image, Blackham has not been shown to specifically disclose that the first image data is necessarily of lower spatial frequency than the second image data. It is noted that even if one set of data were to have a lower dynamic range than the other set of data, such difference would relate to changes in amplitude (contrast) of the image data, and not to changes if the spatial frequency content of the data.

As noted in Blackham (col. 5, lines 12-17), the spatially addressable elements of the two modulators are aligned along the light path; such that the light representing a given pixel in the image which emanates from the first modulator passes through a corresponding pixel modulator in a second spatially addressed modulator enabling further modulation to be applied to that pixel. In other words, Blackham suggests that there is a one-to-one correspondence in the pixels such that the resolution of the two modulators would be the same, and therefore the spatial frequency content could also be considered to be the same. Since this would be consistent with the original examiner's understanding of Blackham, and the new passages cited by the Requester do not require a different conclusion, it is considered that Requester has not shown the Blackman in a new light.

It is noted that the secondary references asserted in combination with Blackman do not show Blackham in a new light or make up for the deficiencies of Blackman.

## DECISION

It is determined that the broader interpretation of "spatial frequency content" of image data as asserted by the Requester/Petitioner is most closely aligned with the broadest reasonable interpretation consistent with the specification.

It is determined that a reasonable examiner would consider a reference or combination of references that teach or suggest at least a display apparatus including 1<sup>st</sup> and 2<sup>nd</sup> displays associated with 1<sup>st</sup> and 2<sup>nd</sup> image data with the "1<sup>st</sup> image data comprising lower spatial frequency content than the 2<sup>nd</sup> image data" as a proper basis for raising a substantial new question of patentability as to claims 1-30.


It is determined that each of the principle combinations of references based on either of Arakawa, Gibbon and Mir each raise a substantial new question of patentability with regard to claims 1-30 of the '533 patent.

It is determined that neither of the principle references or combination of reference based on Crossland or Blackham raise a substantial new question of patentability as to any of claims 1-30 of the '533 patent.

Accordingly, the petition is **granted**.

### SUMMARY AND CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is **GRANTED**.
2. Accordingly, the request for *inter partes* reexamination of claims 1-30 based on the Arakawa, Gibbon and Mir references is hereby ordered.
3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2648.
4. An Office action will be mailed in due course.
5. This decision is final and nonappealable. See 35 U.S.C. 303(c) and 37 CFR 1.515(c). No further communication on this matter will be acknowledged or considered.

  
\_\_\_\_\_  
Irem Yucel, Director  
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,563	08/03/2010	6334938	097007-0105	2786
22428	7590	01/25/2012	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			ART UNIT	PAPER NUMBER

DATE MAILED: 01/25/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

JOSEPH A. RHOA

NIXON & VANDERHYE, PC

901 NORTH GLEBE ROAD, 11th FLOOR

ARLINGTON, VA 22203

Date:

**MAILED**

**JAN 25 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000563

PATENT NO. : 6334938

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>Decision Granting 37 CFR 1.59 Petition in Reexamination</b>	Control No.:95/000,563
<p>1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed <u>April 29, 2011</u> is granted.</p> <p>2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.</p> <p>A. <input checked="" type="checkbox"/> Since the petition does not specify otherwise, the documents have been:</p> <p>i. <input checked="" type="checkbox"/> Destroyed.</p> <p>ii. <input type="checkbox"/> Expunged.</p> <p>B. <input type="checkbox"/> Other/Comment:</p> <p>_____</p> <p>3. CONCLUSION</p> <p>Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535 in the Central Reexamination Unit</p> <p>/Deborah Jones/ [Signature]</p> <p>SPE, Art Unit 3991, CRU (Title)</p>	



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,564	08/06/2010	7,249,378	159291-0010(378)	8115
28661	7590	01/18/2011	EXAMINER	
LEWIS AND ROCA LLP 1663 Hwy 395, Suite 201 Minden, NV 89423			ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2011

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IRELL & MANELLA LLP

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SUITE 900

LOS ANGELES, CA 90067

Date:

MAILED

JAN 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000564

PATENT NO. : 7249378

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension  
of Time in Reexamination**

Control No.: 95/000,564

**MAILED**

**JAN 18 2011**

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 13 January 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 21 December 2010 which sets a one (1) month period for filing a response thereto, be extended by and additional one (1) month.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
  - ii. ☒ Petition includes authorization to charge a credit card account.
  - iii. ☐ Other: electronic payment via EFS.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for an additional one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).  
☒ Other/comment: MPEP § 2265 notes "requests for more than one month will be granted only in extraordinary situations."
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
  - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
  - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
  - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
  - v. ☐ The petition is moot.
  - vi. ☐ Other/comment: \_\_\_\_\_

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

\_\_\_\_\_/Mark Reinhart/  
[Signature]

\_\_\_\_\_  
(Title) SPE AU 3992



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28661	7590	07/08/2011	EXAMINER	
LEWIS AND ROCA LLP 1663 Hwy 395, Suite 201 Minden, NV 89423			ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2011

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**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000564

PATENT NO. : 7249378

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAILED

JUL 08 2011

*In re Wesigner et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,564  
Filed: August 6, 2010  
For: U.S. Patent No. 7,249,378

:  
: **DECISION**  
: **ON**  
: **PETITIONS**  
:

CENTRAL REEXAMINATION UNIT

This is a decision on the third party requester's paper entitled "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 CFR § 1.183", filed on April 13, 2011. This is also a decision on the third party requester's paper entitled "PETITION FOR EXPEDITED CONSIDERATION UNDER 37 CFR § 1.182", also filed on April 13, 2011.

The third party requester petitions are before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 for waiver of page limit is granted in-part, to the extent set forth herein. The petition under 37 CFR 1.182 for expedited consideration is dismissed for the reasons set forth herein.

### BACKGROUND

1. U.S. Patent Number 7,249,378 (the '378 patent) issued to Wesigner *et al.* on July 24, 2007, with claims 1-15.
2. A request for *inter partes* reexamination of the '378 patent was deposited by a third party requester on August 6, 2010, which request was assigned Reexamination Control No. 95/000,564 (the '564 proceeding). Juniper Networks, Inc. is identified as the real party in interest.
3. On September 30, 2010, an order granting *inter partes* reexamination of claims 1-15 of the '378 patent was mailed for the '564 proceeding.



4. On December 21, 2010, the Office mailed a non final Office action in the '564 proceeding.
5. On March 21, 2011, patent owner timely filed a response to the December 21, 2011 Office action.<sup>1</sup>
6. On April 13, 2011, third party requester filed the instant paper entitled "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 CFR § 1.183" (the petition under 37 CFR 1.183), requesting waiver of the page limit for third party requester's comments submission.
7. On April 13, 2011, third party requester also filed a paper entitled "PETITION FOR EXPEDITED CONSIDERATION UNDER 37 CFR § 1.182" (the petition under 37 CFR 1.182), requesting expedited consideration of the concurrently-filed petition under 37 CFR 1.183.
8. On April 25, 2011, the Office timely received "THIRD PARTY REQUESTER COMMENTS AFTER PATENT OWNER RESPONSE UNDER 37 C.F.R. § 1.947" and accompanying attachments (the comments submission).<sup>2</sup>

## DECISION

### I. Relevant Statutes, Regulations and Procedures

#### 35 U.S.C. 314(c) provides:

SPECIAL DISPATCH.— Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

#### 37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

#### 37 CFR 1.183 provides:

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<sup>1</sup> See January 18, 2011 decision granting in-part patent owner's request for extension of time to file patent owner's response to the December 21, 2010 Office action.

<sup>2</sup> See certificate of mailing on page 55 of the remarks portion of requester's comments submission.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

**37 CFR 1.943(b) provides:**

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

**II. Third Party Requester April 13, 2011 Petition under 37 CFR 1.183**

On April 13, 2011, third party requester filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of a comments submission of up to 90 pages.<sup>3</sup> Subsequently, on April 25, 2011, third party requester filed a comments submission that exceeds the 50-page limit.<sup>4</sup> Accordingly, the April 13, 2011 petition under 37 CFR 1.183 is being considered with respect to the April 25, 2011 comments submission.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of resulting comments that are in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such comments can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments: (1) for justification that more pages are needed to complete the comments, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the comments.

In support of waiver of the rule, requester asserts that patent owner's response presents eight new independent claims that "include a number of new limitations not included in any of the original claims, for which Juniper must submit additional prior art and arguments."<sup>5</sup> Requester also asserts that it "has attempted to address the numerous new independent claims, new limitations, and new references and arguments to be explained within [the 50-page] limit but has been unable to do so" and that "[a]lthough a complete discussion of these issues would likely require hundreds of pages, Juniper is substantially editing its comments at this time for the sake of

<sup>3</sup> Third party requester petition under 37 CFR 1.183 at page 2.

<sup>4</sup> The April 25, 2011 comments submission comprises 55 pages of remarks and appendices R1-R9. Appendix R1 is an 8-page "37 C.F.R. § 1.132 Declaration of Marcus Ranum" (the Ranum declaration).

<sup>5</sup> Id. at page 1.

brevity.”<sup>6</sup> Additionally, requester has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, which are in excess of 50 pages.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, the April 25, 2011 comments submission includes 55 pages of remarks. Additionally, based on the guidance set forth above, portions of the 8-page Ranum declaration are deemed to include legal argument (*e.g.*, as to the obviousness of the claims) and are subject to the regulatory page limit count, such that the April 25, 2011 comments submission exceeds the 50-page limit by up to 13 pages.<sup>7</sup>

Based on the individual facts and circumstances of this case such as, for example, the 8 independent claims newly added by patent owner in the March 21, 2011 response, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that third party requester’s April 25, 2011 comments submission exceeds the regulatory page limit by up to 13 pages.

As pointed out above, in the instant petition under 37 CFR 1.183, petitioner requests that the Office waive the page length requirement for requester’s comments submission to provide an extra 40 pages beyond the regulatory page limit; however, based on the above discussion, only 13 pages are needed. Accordingly, requester’s petition under 37 CFR 1.183 is granted in-part and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting third party requester’s April 25, 2011 comments submission to exceed the regulatory page limit by up to 13

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<sup>6</sup> Id. at page 2.

<sup>7</sup> 37 CFR 1.943(b) expressly excludes from the regulatory page limit count attached reference materials, such as prior art references.

pages. This waiver makes third party requester's April 25, 2011 comments submission page-length compliant.

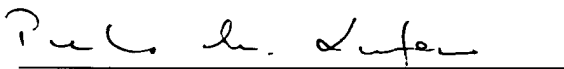
### **III. Third Party Requester April 13, 2011 Petition under 37 CFR 1.182**

In the instant petition under 37 CFR 1.182, petitioner requests expedited consideration of the concurrently-filed petition under 37 CFR 1.183. Petitioner's request to expedite the review of the concurrently-filed petition under 37 CFR 1.183, requesting waiver of the 50 page limit of 37 CFR 1.943(b), is without merit as all reexamination proceedings are to be conducted with special dispatch within the Office (35 U.S.C. 314(c)). Since all matters in a reexamination proceeding are conducted with special dispatch, petitions are taken up for consideration in the order that they are received by the Office.

Accordingly, requester's petition under 37 CFR 1.182 is **dismissed**.

### **CONCLUSION**

1. Third party requester's April 13, 2011 petition under 37 CFR 1.183 is **granted in-part**, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's April 25, 2011 comments submission to exceed the page limit by up to 13 pages. This waiver makes requester's April 25, 2011 comments submission page-length compliant.
2. Third party requester's April 13, 2011 petition under 37 CFR 1.182 is **dismissed**.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

07-08-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,565	08/12/2010	6699221	0006675.00277US1	2323

7590

07/28/2011

Francis C. Hand, Esq.  
c/o CARELLA, BYRNE, BAIN, GILFILLAN et al.  
6 Becker Farm Road  
Roseland, NJ 07068

EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 07/28/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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*Inter partes* BECTON, DICKINSON & COMPANY

v.

MICHAEL J. VAILLANCOURT

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Reexamination Control No. 95/000,565

Patent 6,699,221

Technology Center 3900

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DECISION ON PETITION

This is a decision on patent owner's "Petition under 37 C.F.R. § 1.181 and 37 C.F.R. § 1.183" filed June 28, 2011 ("present petition"). Under 37 C.F.R. § 1.181, petitioner requests waiver of the requirement of 37 C.F.R. § 1.943(c) limiting an appellant brief to 30 pages or 14,000 words, to permit entry of the patent owner's appellant brief, stated to be 81 pages and 23,005 words. Under 37 C.F.R. § 1.183, petitioner requests suspension or waiver of the requirement of 37 C.F.R. § 1.943(c), limiting an appellant brief to 30 pages or 14,000 words; withdrawal of the Notice of Defective Brief dated

Inter Partes Reexamination Control No. 95/000,565  
Patent No. 6,699,221

June 22, 2011; and/or suspension of the time for filing a response to the Notice of Defective Brief. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on July 20, 2011, per an authorization to charge the petition fee dated July 18, 2011.

*See* 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

### FINDINGS

1. On August 12, 2010, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,699,221, which was assigned control no. 95/000,565.
2. On September 15, 2010, reexamination was ordered and a non-final Office action was mailed, rejecting claims 1-20.
3. Patent owner filed a response to the Office action on December 7, 2010, adding claims 21-37, and third party requester filed comments in reply to the Office action and patent owner's response on January 6, 2011, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
4. On January 24, 2011, an Action Closing Prosecution (ACP) was mailed, rejecting claims 1-37.
5. Patent owner filed a response on February 22, 2011, and third party requester filed comments on March 22, 2011, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
6. On April 5, 2011, a Right of Appeal Notice (RAN) was mailed, rejecting claims 1-37.
7. Patent owner filed a Notice of Appeal on April 29, 2011.

Inter Partes Reexamination Control No. 95/000,565  
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8. On June 13, 2011, patent owner filed an appellant's brief appealing the rejections of claims 1-37.

9. A Notice of Defective Brief was mailed on June 22, 2011, indicating that the appellant brief of June 13, 2011, exceeds the 30 page limit of 37 C.F.R. §1.943(c), and does not include a certificate of the word count.

10. On June 28, 2011, patent owner filed a certificate of the word count for appellant's brief of June 13, 2011, accompanied by the present petition.

11. Petition filed an authorization to charge the petition fee for the present petition on July 18, 2011.

#### DISCUSSION

In the present petition, patent owner requests waiver of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to 30 pages or 14,000 words in length. The patent owner's appellant brief is stated to be 81 pages and 23,005 words. Petitioner also requests, in the alternative, that the Notice of Defective Brief of June 22, 2011, be withdrawn and/or the time for filing a response to the notice be suspended.

Waiver is requested because the ACP mailed on January 24, 2011, contains 44 pages and includes 33 grounds of rejections of 37 claims. Petitioner asserts that it would not be fair to limit appellant to a 30 page appellant brief. Petitioner states that to do so would be an injustice to appellant, which would require appellant to waive an appeal of one or more grounds of rejection, and/or to limit argument on one or more grounds of rejection.



### RELEVANT AUTHORITY

37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 C.F.R. § 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 C.F.R. § 1.943(c).

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 C.F.R. § 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example,

declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

37 C.F.R. § 41.61 provides in pertinent part:

...

(c) The notice of appeal or cross appeal in the proceeding must identify the appealed claim(s) and must be signed by the owner, the requester, or a duly authorized attorney or agent.

...

(f) If a notice of appeal or cross appeal is timely filed but does not comply with any requirement of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended notice of appeal or cross appeal. If the appellant does not then file an amended notice of appeal or cross appeal within the set time period, or files a notice which does not overcome all the reasons for non-compliance stated in the notification of the reasons for non-compliance, that appellant's appeal or cross appeal will stand dismissed.

### ANALYSIS

Patent owner's petition has been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Therefore, 37 C.F.R. § 1.181 is not applicable to the present request for waiver of 37 C.F.R. § 1.943(c).

Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been well within the page limit requirements. However, the appellant brief filed subsequent to appeal is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Patent owner's appellant brief filed on June 13, 2011, is stated to be 81 pages and 23,005 words, which far exceeds the limit of 30 pages and 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the length of the ACP, and the numerous rejections which are appealed. However, the prosecution history reveals that the patent owner chose to present an additional 17 claims in their amendment in response to the non-final Office action, without canceling any of the original 20 patent claims. It is not surprising that patent owner is now challenged by the page and word limit, given that the number of claims being examined has increased from 20 to 37, and is now almost twice the number of original patent claims. The patent owner caused this challenge itself. Presenting the Office with 17 new claims is not conducive to expediting *inter partes* reexamination of the instant patent.

The RAN incorporates all of the rejections contained in the ACP. The ACP contains issues 1-9 and 12-17, which are adopted rejections of the original patent claims 1-20, plus newly presented issues 20-28, 30-34, 36, 38 and 40-42, which are adopted rejections of new claims 21-37. Patent owner's amendment necessitated the new grounds of rejections by adding claims 21-37. Patent owner responded to the new rejections prior to the RAN, *i.e.*, in response to the ACP, on February 22, 2011, within the page limit requirements.

Patent owner asserts that the length of appellant's brief is due to the number of grounds of rejection on appeal. Patent owner contests each of the grounds of rejection on appeal. However, the brief includes a "Summary of Claimed Subject Matter" on pp. 3-6; "Grounds of Rejection to be Reviewed on Appeal" on pp. 6-11; and "Arguments" on pp. 11-81. It is not evident how appellant has attempted to consolidate their arguments so as to comply with the page and word limit. It is not surprising that patent owner is now challenged by the page and word limit, given that the number of issues has been expanded from 15 rejections to 34 rejections, and by virtue of all the claims added by patent owner.

A persuasive showing has not been made that this situation is extraordinary nor that justice requires that significantly more pages/words be allotted to appellant's brief compared to prior responses and comments submitted in reply to actions issued by the Office. Accordingly, the present petition is **denied**, and the request to waive the page limit is **denied**. The alternative request that the Notice of Defective Brief of June 22, 2011, be withdrawn is **denied**. The alternative request that the time for filing a response to the notice be suspended is **granted** to the extent that a time

Inter Partes Reexamination Control No. 95/000,565  
Patent No. 6,699,221

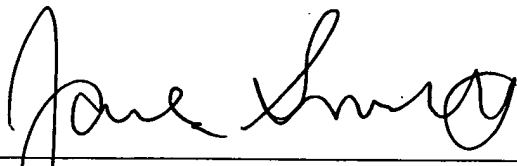
period is set for patent owner to file an appellant brief in compliance with 37 C.F.R. § 1.943(c), in response to this petition decision.

The review of the record also revealed that the Notice of Appeal filed by patent owner on April 29, 2011, does not identify the claims being appealed, as required by 37 C.F.R. § 41.61(c).

### DECISION

Appellant is given one opportunity to file a corrected Notice of Appeal in compliance with 37 C.F.R. § 41.61(c), and a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected Notice of Appeal and a corrected appellant brief are not timely submitted, the patent owner's appeal will be dismissed.

In view of the foregoing, the Petition is DENIED.



---

James Donald Smith  
Chief Administrative Patent Judge

Counsel for Patent Owner:

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Inter Partes Reexamination Control No. 95/000,565  
Patent No. 6,699,221

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,565	08/12/2010	6699221	0006675.00277US1	2323

7590 08/30/2011

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/30/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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*Inter partes* Beckton, Dickinson & Company  
v.  
Michael J. Vaillancourt

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Reexamination Control No. 95/000,565  
Patent 6,699,221  
Technology Center 3900

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DECISION ON PETITION

This is a decision on patent owner's "Request for Reconsideration of a Petition Decision" filed August 1, 2011 (request for reconsideration). Petitioner requests reconsideration of the decision of July 28, 2011, that denied waiver of the requirement of 37 C.F.R. § 1.943(c) limiting an appellant brief to 30 pages or 14,000 words, denied entry of the patent owner's appellant brief, stated to be 81 pages and 23,005 words, and required a corrected Notice of Appeal and a corrected appellant brief.

*See* 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.



### FINDINGS

1. On August 12, 2010, third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 6,699,221, which was assigned control no. 95/000,565.
2. On September 15, 2010, reexamination was ordered and a non-final Office action was mailed, rejecting claims 1-20.
3. Patent owner filed a response to the Office action on December 7, 2010, adding claims 21-37, and third party requester filed comments in reply to the Office action and patent owner's response on January 6, 2011, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
4. On January 24, 2011, an Action Closing Prosecution (ACP) was mailed, rejecting claims 1-37.
5. Patent owner filed a response on February 22, 2011, and third party requester filed comments on March 22, 2011, within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
6. On April 5, 2011, a Right of Appeal Notice (RAN) was mailed, rejecting claims 1-37.
7. Patent owner filed a Notice of Appeal on April 29, 2011.
8. On June 13, 2011, patent owner filed an appellant's brief appealing the rejections of claims 1-37.
9. A Notice of Defective Brief was mailed on June 22, 2011, indicating that the appellant brief of June 13, 2011, exceeds the 30 page limit of 37 C.F.R. § 1.943(c), and does not include a certificate of the word count.

Inter Partes Reexamination Control No. 95/000,565  
Patent No. 6,699,221

10. On June 28, 2011, patent owner filed a certificate of the word count for appellant's brief of June 13, 2011, accompanied by a petition to waive 37 C.F.R. § 1.943(c).

11. On July 28, 2011, a decision denying the petition of June 28, 2011, was mailed.

12. The patent owner filed the present request for reconsideration of the decision denying the petition on August 1, 2011.

## DISCUSSION

In the present request for reconsideration, petitioner asserts that a corrected Notice of Appeal is not required because the appellant used Form PTO/SB/31 to file the Notice of Appeal. (Request for reconsideration, 1.) Petitioner refers to MPEP 1204, II. Appeal by Patent Owner. *Id.* Petitioner states that 37 C.F.R. § 41.61(c) provides that a notice of appeal must identify the appealed claims, whereas, Form PTO/SB/31 does not. *Id.*

With regard to the requirement for a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), petitioner contends that the "FINDINGS" in the petition decision are incomplete and biased against granting of a waiver of the length of brief requirements because the findings do not include an indication of the number of rejections or the length of each Office action. Petitioner argues that patent owner's amendment adding dependent claims 21-37 to the reexamination proceeding did not necessitate adding 19 newly presented issues that were adopted by the examiner based upon the response of the requester.

RELEVANT AUTHORITY

**35 U.S.C. 315(a) states:**

PATENT OWNER.- The patent owner involved in an inter partes reexamination proceeding under this chapter-

(1) may appeal under the provisions of section 134 and may appeal under the provisions of sections 141 through 144, with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent; and

(2) may be a party to any appeal taken by a third-party requester under subsection (b).

**37 C.F.R. § 1.959 states:**

Appeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(c) are conducted according to part 41 of this title.

**37 C.F.R. § 41.61 provides in pertinent part:**

...

(c) The notice of appeal or cross appeal in the proceeding must identify the appealed claim(s) and must be signed by the owner, the requester, or a duly authorized attorney or agent.

...

(f) If a notice of appeal or cross appeal is timely filed but does not comply with any requirement of this section, appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended notice of appeal or cross appeal. If the appellant does not then file an amended notice of appeal or cross appeal within the set time period, or files a notice which does not overcome all the reasons for non-compliance stated in the notification of the reasons for

non-compliance, that appellant's appeal or cross appeal will stand dismissed.

**37 C.F.R. § 1.181 provides in pertinent part:**

...

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. . . .

**37 C.F.R. § 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

**37 C.F.R. § 1.943(c) provides:**

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

**MPEP § 2674 Appeal in Reexamination provides in pertinent part:**

...

The procedure for taking appeal is referenced in 37 CFR 1.959 and set forth in 37 CFR 41.61.

(A) The notice of appeal must identify the appealed claim(s).

(B) The appeal must be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) which the patent owner proposes to contest, or (2) the finding(s) of patentability of claims in the RAN which the third party requester proposes to contest. Therefore:

- A notice of appeal by the patent owner must identify each claim rejected by the examiner that the patent owner intends to contest;

...

(C) The notice of appeal must be signed by the patent owner or the third party requester, or their duly authorized attorney or agent.

...

Where a notice of appeal or notice of cross appeal is timely filed but is defective, e.g., missing fee or missing portion of the fee, no proof of service is included, it is signed by an inappropriate party or is unsigned, failure to identify the appealed claims; 37 CFR 41.61(f) provides the appropriate party one opportunity to file, within a nonextendable period of one month, an amended notice of appeal or cross appeal that corrects the defect(s).

## ANALYSIS

Patent owner's request for reconsideration has been considered fully. Although the appellant used Form PTO/SB/31, and it is agreed that this form does not identify the appealed claims, this is because the form was created for *ex parte* appeals. Since this is an *inter partes* reexamination, different statutes, regulations and MPEP sections apply, *i.e.*, 35 U.S.C. 315, 37 C.F.R. § 1.959, 37 C.F.R. § 41.61 and MPEP 2674. As previously communicated,

Inter Partes Reexamination Control No. 95/000,565  
Patent No. 6,699,221

the Notice of Appeal must identify the appealed claims as required by 37 C.F.R. § 41.61(c), therefore the requirement for a corrected Notice of Appeal that identifies the appealed claims stands.

With regard to the appellant brief, the USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Petitioner contends that the “FINDINGS” in the petition decision are incomplete and biased against granting of a waiver of the length of brief requirements, because the findings do not include an indication of the number of rejections or the length of each Office action. A review of the prosecution history of this proceeding reveals that the patent owner responses to Office actions prior to appeal have been well within the page limit requirements. However, the appellant brief filed subsequent to appeal is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Since the issues have not changed, it is unclear how patent owner has attempted to comply with the rules when submitting the appellant brief of June 13, 2011, stated to be 81 pages and 23,005 words, which far exceeds the limit of 30 pages and 14,000 words, and far exceeds prior responses to Office actions.

Petitioner argues that patent owner’s amendment adding dependent claims 21-37 to the reexamination proceeding did not necessitate adding 19 newly presented issues that were adopted by the examiner based upon the response of the requester. However, the prosecution history reveals that the patent owner chose to present an additional 17 claims in their amendment in response to the non-final Office action, without canceling any of the original 20 patent claims. Amendment by a patent owner in an *inter partes* reexamination provides a reply right to requester that may include additional

Inter Partes Reexamination Control No. 95/000,565  
Patent No. 6,699,221

proposed rejections deemed applicable to the newly presented claims. It is not surprising that Patent Owner is now challenged by the page and word limit, given that the number of claims being examined has increased from 20 to 37, and is now almost twice the number of original patent claims. The Patent Owner caused this challenge itself. Presenting the Office with 17 new claims without canceling any existing claims is not conducive to expediting *inter partes* reexamination of the instant patent.

Petitioner states that limiting patent owner to a 30 page brief, when the first 11 pages include, *inter alia*, “Summary of Claimed Subject Matter” and “Grounds of Rejection to be Reviewed on Appeal” means that only 19 pages are available to address the 16 separate grounds of rejection of the independent claims, and the various grounds of rejection of the dependent claims 2-18 of the patent. It is not surprising that patent owner is now challenged by the page and word limit, given that the number of issues has been expanded from 15 rejections to 34 rejections, and by virtue of all the claims added by Patent Owner. The ACP contains issues 1-9 and 12-17, which are adopted rejections of the original patent claims 1-20, plus newly presented issues 20-28, 30-34, 36, 38 and 40-42, which are adopted rejections of new claims 21-37. Patent owner’s amendment necessitated the new grounds of rejections by adding claims 21-37. Patent owner responded to the new rejections prior to the RAN, *i.e.*, in response to the ACP, on February 22, 2011, within the page limit requirements. Again, because the issues have not changed, it is unclear how patent owner has attempted to comply with the rules when submitting the appellant brief of June 13, 2011, stated to be 81 pages and 23,005 words, which far exceeds the limit set by regulation and far exceeds prior responses to Office actions.

Petitioner urges that justice and fairness should permit the appeal to proceed with appellant's brief of record and purports that it is extraordinary for an appeal to be taken from 12 grounds of rejection of a main claim, such as claim 1 herein, much less the number of rejections in the ACP. However, the nature and complexity of *inter partes* reexamination appeals is such that the number of issues on appeal in the instant *inter partes* reexamination is not extraordinary.

Petitioner has not made a persuasive showing that this situation is extraordinary nor that justice requires that significantly more pages/words be allotted to appellant's brief compared to prior responses and comments submitted in reply to actions issued by the Office. Compliance with the statutes, regulations and procedures governing *inter partes* reexamination is required in the absence of such a showing. Accordingly, the present request for reconsideration is **denied**.

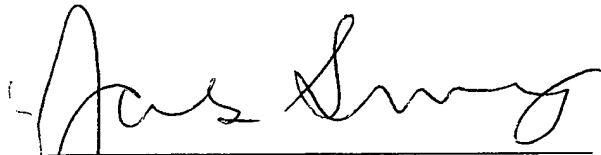
Pursuant to 37 C.F.R. § 1.181 (f), "The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings." The time period for appellant to file a corrected Notice of Appeal in compliance with 37 C.F.R. § 41.61(c), and a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), set forth in the petition decision of July 28, 2011, stands. If a corrected Notice of Appeal and a corrected appellant brief are not timely submitted, the appellant's appeal will be dismissed.



Inter Partes Reexamination Control No. 95/000,565  
Patent No. 6,699,221

DECISION

In view of the foregoing, the request for reconsideration is DENIED.

A handwritten signature in black ink, appearing to read "James Smith", written over a horizontal line.

James Donald Smith  
Chief Administrative Patent Judge

Counsel for Patent Owner:

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,567	08/23/2010	6746773	01035.0069-00000	1682
45511	7590	05/10/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 05/10/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

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WASHINGTON, DC 20001-4413

**MAILED**

**MAY 10 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000567

PATENT NO. : 6746773

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Third Party Requester)

MAILED

MAY 10 2011

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,567  
Filed: August 23, 2010  
For: U.S. Patent No. 6,746,773

:  
:  
: **DECISION**  
:  
: **DISMISSING**  
:  
: **PETITIONS**  
:

This is a decision on the patent owner paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)," filed on February 28, 2011. This is also a decision on the third party requester paper entitled "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947," filed on April 20, 2011.

The patent owner petition under 37 CFR 1.183 and the third party requester petition, which is also a petition under 37 CFR 1.183, are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are dismissed for the reasons set forth herein.

### BACKGROUND

1. On June, 8, 2004, United States Patent No. 6,746,773 ("the '773 patent") issued to Llanos, *et al.*
2. On August 23, 2010, a request for *inter partes* reexamination of the '773 patent was filed by a third party requester (hereinafter "requester"), which request was assigned Reexamination Control No. 95/000,567 ("the '567 proceeding").
3. On November 19, 2010, the Office mailed an order granting *inter pares* reexamination in the '567 proceeding.

4. On December 29, 2010, the Office mailed a non-final Office action on the merits in the '567 proceeding.
5. On February 28, 2011, patent owner filed the instant "PETITION FOR INCREASE OF PAGE LIMIT PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" ("the patent owner petition under 37 CFR 1.183"), concurrently with a patent owner response to the December 29, 2010 non-final Office action ("the patent owner response submission").
6. On March 30, 2011, requester filed "COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947" ("the requester's comments submission"), after patent owner's February 28, 2011 response submission and the December 29, 2010 Office action.
7. On April 20, 2011, requester filed the instant "PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947" ("the requester petition under 37 CFR 1.183").

## DECISION

### I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Patent Owner's February 28, 2011 Petition under 37 CFR 1.183

On February 28, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed response submission. Patent owner asserts that the February 28, 2011 response submission is 39 pages long, excluding the listing of claims.<sup>1</sup> Patent owner further asserts that "[a]ccompanying the response is a

---

<sup>1</sup> Patent owner petition under 37 CFR 1.183 at page 1.

Declaration of Antonios G. Mikos, Ph.D., which presents testimony relevant to the issues raised in the Office Action” (“the Mikos declaration”) and “[t]o the extent that the Office if [sic] of the view that more than 11 pages of Dr. Mikos’ declaration testimony should count against the 50-page limit for Patent Owner’s response, Patent Owner respectfully requests a corresponding increase in page limit.”<sup>2</sup>

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner’s response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In the instant patent owner petition under 37 CFR 1.183, patent owner asserts that waiver of the 50-page limit is “necessitated by the fact that the Office Action set forth 36 separate outstanding grounds of rejection under 35 U.S.C. § 103 (based on seven different references, supported by an additional two references)” and that “the underlying Request from which the rejections have been adopted wholesale, is 194 pages in length....”<sup>3</sup> Patent owner further asserts that the Mikos declaration “is needed not only to address technical issues that are raised by the rejections and the prior publications upon which they are based, but also to provide a full and complete story of the claimed inventions in the context of the relevant technical field.” Thus, patent owner requests, “given the numerous and complex issues embodied in the outstanding Office action and the cited prior publications, that the page limit for Patent Owner’s response be increased to an amount sufficient to include both the 39-page response and any pages from the Mikos Declaration that the Office determines should be counted against the 50-page limit.”<sup>4</sup> Additionally, patent owner has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit, and submitting the resulting response, which is in excess of 50 pages.<sup>5</sup>

### Analysis and Findings

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

---

<sup>2</sup> Id.

<sup>3</sup> Id.

<sup>4</sup> Id. at page 2.

<sup>5</sup> Patent owner’s February 28, 2011 response submission is 39 pages long and appears to be one-and-a-half or double-spaced. The Mikos declaration is 48 pages long and is single-spaced.

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

*See, generally,* 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission.

In this instance, the 39 pages of the remarks portion of patent owner's February 28, 2011 response submission satisfies the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), but the entire Mikos declaration does not. Accordingly, patent owner's February 28, 2011 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is dismissed.

Patent owner is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth herein; otherwise, patent owner's February 28, 2011 response submission will be deemed defective as not being page-length compliant and will not be considered. In the event patent owner files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

#### **Additional Discussion**

It is noted that, in the event patent owner files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a response submission, the content of which is identical to that of the February 28, 2011 response submission, with the exception that the entire Mikos declaration complies with the formatting guidelines set forth herein, such renewed petition would be grantable. In this instance, the specific facts set forth in patent owner's February 28, 2011 petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case, such as, *e.g.*, the incorporation by reference, by the December 29, 2010 Office action, of a substantial number of pages from the August 23, 2010 request for *inter partes* reexamination, demonstrate an extraordinary situation in which justice requires suspension the 50-page limit of 37 CFR 1.943(b).

It is also noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In

determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.<sup>6</sup>

### III. Requester's April 20, 2011 Petition under 37 CFR 1.183

On March 20, 2011, requester's comments submission was filed and, on April 20, 2011, requester filed the instant petition under 37 CFR 1.183 for waiver of the page limit of 37 CFR 1.943(b) with respect to the March 20, 2011 comments submission. Requester's March 20, 2011 comments submission will not be considered, because, given that the February 28, 2011 patent owner response submission has not been entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requester statutorily has no comment right under 35 USC § 314(b)(2). Further, because the March 20, 2011 requester comments submission is not being considered as moot for the reasons set forth herein, requester's April 20, 2011 petition under 37 CFR 1.183 is **dismissed as moot**.

Given that requester statutorily has no comment right to file a comments submission, requester's March 20, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding. If patent owner timely files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37 CFR 1.947, requester may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, **within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant**. Any renewed requester petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) should accompany requester's comments submission that complies with the formatting guidelines set forth herein.<sup>7</sup> In the event requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

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<sup>6</sup> It is noted that, in this instance, at least Section VII of Mikos declaration, spanning pages 20-46, appears to include arguments directed to how an outstanding or proposed rejection is overcome.

<sup>7</sup> Requester's March 20, 2011 comments submission comprises 49 pages of remarks and appears to be one-and-a-half or double-spaced. The accompanying declaration by Michael N. Helmus, Ph. D., contains 81 pages and also appears to be one-and-a-half or double-spaced. The pages drawn to Dr. Helmus' curriculum vitae, work experience and publications are not counted towards the regulatory page limit; however, at least Section V, spanning pages 22-64, appears to contain arguments as to how an outstanding or proposed rejection is supported. Requester is advised to set forth, in any renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the comments submission.



### CONCLUSION

1. Patent owner's February 28, 2011 petition under 37 CFR 1.183 is dismissed.
2. Patent owner is given a time period of **fifteen (15) days from the mailing date of this decision** to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth herein; otherwise, patent owner's February 28, 2011 response submission will be deemed defective as not being page-length compliant and will not be considered (in which case, there would be no response to the Office action, and the Office would proceed accordingly).
3. If patent owner files a grantable petition under 37 CFR 1.183 in response to this decision, then under 37 CFR 1.947, requester may once file written comments, limited to issues raised by the Office action or the patent owner's response submission, **within 30 days from the date of the decision granting patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant**.
4. Requester's April 20, 2011 petition under 37 CFR 1.183 is dismissed as moot.
5. Requester's March 20, 2011 comments submission will not be considered, because, given that the February 28, 2011 patent owner response submission has not been entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requester statutorily has no comment right under 35 USC § 314(b)(2). Requester's March 20, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's IFW system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.
6. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



---

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,567	08/23/2010	6746773	01035.0069-00000	1682

45511 7590 07/26/2011

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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 07/26/2011

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**JUL 26 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000567

PATENT NO. : 6746773

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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WASHINGTON, DC 20001-4413

(For Third Party Requester)

MAILED

JUL 26 2011

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,567  
Filed: August 23, 2010  
For: U.S. Patent No. 6,746,773

:  
:  
: **DECISION**  
:  
: **GRANTING**  
:  
: **PETITION**  
:

This is a decision on the patent owner paper entitled "RENEWED PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. §§1.183 AND 1.943(b)" (the renewed petition under 37 CFR 1.183), filed on May 19, 2011.

The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

**DECISION**

**I. Patent Owner's May 19, 2011 Renewed Petition under 37 CFR 1.183**

On December 29, 2010, the Office mailed a non-final office action in the instant proceeding. On February 28, 2011, patent owner filed a petition under 37 CFR 1.183, requesting waiver of the page limit for its concurrently-filed response submission. On May 10, 2011, the Office mailed a decision dismissing patent owner's February 28, 2011 petition under 37 CFR 1.183 (the May 10, 2011 decision). On May 19, 2011, patent owner filed the instant renewed petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response to the January 30, 2011 Office action.<sup>1</sup>

<sup>1</sup> See the renewed petition under 37 CFR 1.183 at page 1. It is noted that patent owner's reference to the "January 30, 2011 Office action" is in error as the Office action was mailed on December 29, 2010.

Patent owner states that the renewed petition under 37 CFR 1.183 is responsive to the May 10, 2011 decision, dismissing patent owner's February 28, 2011 petition for waiver of the page limit requirements of 37 CFR 1.943(b) for patent owner's February 28, 2011 response submission.<sup>2</sup> The May 10, 2011 decision states that to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that adheres to the formatting guidelines set forth therein to enable the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission.<sup>3</sup> The decision further states that "the 39 pages of the remarks portion of patent owner's February 28, 2011 response submission satisfies the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), but the entire Mikos declaration does not."<sup>4</sup> The decision set a time period of 15 days from the mailing date of the decision for patent owner to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a response submission that complies with the formatting guidelines set forth in the decision.<sup>5</sup>

The May 10, 2011 decision also states:

[I]n the event patent owner files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a response submission, the content of which is identical to that of the February 28, 2011 response submission, with the exception that the entire Mikos declaration complies with the formatting guidelines set forth herein, such renewed petition would be grantable. In this instance, the specific facts set forth in patent owner's February 28, 2011 petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case, such as, *e.g.*, the incorporation by reference, by the December 29, 2010 Office action, of a substantial number of pages from the August 23, 2010 request for *inter partes* reexamination, demonstrate an extraordinary situation in which justice requires suspension the 50-page limit of 37 CFR 1.943(b). [Emphasis added.]<sup>6</sup>

Concurrently with the instant renewed petition under 37 CFR 1.183, patent owner submitted "a corrected Mikos Declaration, which Patent Owner certifies is substantively identical to the previous Declaration, except that the formatting has been revised to comply with the [the May 10, 2011 decision's formatting] guidelines."<sup>7</sup> Patent owner states that "Patent Owner's response, not including the appendix (a listing of claims), is 39 pages long" and that "[a]ccompanying the response is a corrected Declaration of Antonios G. Mikos, Ph.D, which presents testimony

<sup>2</sup> See the renewed petition under 37 CFR 1.183 at page 1.

<sup>3</sup> May 10, 2011 decision at pages 3-4.

<sup>4</sup> *Id.* at page 4.

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> The renewed petition under 37 CFR 1.183 at page 2 (also stating that "[s]ince Patent Owner's Response filed February 28, 2011, was found to comply with the formatting guidelines, it has not been resubmitted.")

relevant to the issues raised in the Office Action.”<sup>8</sup> Patent owner further states that “[t]o the extent that the Office if [sic] of the view that more than 11 pages of Dr. Mikos’ declaration testimony should count against the 50-page limit for Patent Owner’s response, Patent Owner respectfully requests a corresponding increase in that page limit.”<sup>9</sup> Additionally, patent owner reiterates reasons, previously set forth in patent owner’s February 28, 2011 petition for waiver of 37 CFR 1.943(b), why patent owner deems the additional pages are necessary.<sup>10</sup>

The corrected Mikos declaration, submitted concurrently with the instant petition under 37 CFR 1.183 and the content of which patent owner has certified is identical to that of the February 28, 2011 Mikos declaration, is being entered as a substitute declaration for the February 28, 2011 Mikos declaration, which did not comply with the formatting guidelines set forth in the May 10, 2011 decision. Thus, patent owner’s corrected response submission to the December 29, 2010 Office action is deemed to comprise: (1) the 39-pages of remarks, the 1-page “Appendix A” listing of the claims, Exhibit 1 (curriculum vitae for the declarant Antonio G. Mikos) and Exhibits 3-9 (reference materials) of patent owner’s February 28, 2011 response submission, and (2) the May 19, 2011 65-page corrected Mikos declaration.

The portions of patent owner’s corrected response submission that count toward the regulatory page limit satisfy the formatting guidelines set forth in the May 10, 2011 decision and exceed the regulatory page limit by up to 54 pages.<sup>11</sup> For the reasons previously set forth in the May 10, 2011 decision, the individual facts and circumstances of this case demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b) for patent owner’s corrected response submission. Accordingly, patent owner’s May 19, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s corrected response submission to exceed the regulatory page limit by up to 54 pages for the reasons set forth in the decision of May 10, 2011. **This waiver makes patent owner’s corrected response submission page-length compliant.**

## II. Third Party Requester Comments

In the May 10, 2011 decision, the Office dismissed as moot third party requester’s April 20, 2011 petition under 37 CFR 1.183 for waiver of the 37 CFR 1.943(b) page limit requirement with respect to requester’s March 20, 2011 comments submission and expunging requester’s March 20, 2011 comments submission from the record of the instant proceeding.<sup>12</sup> However, on page 3, the May 10, 2011 decision states:

If patent owner timely files a grantable petition under 37 CFR 1.183 in response to the decision, then under 37 CFR 1.947, requester may once file written comments, limited to issues raised by the Office action or the patent owner’s response submission, **within 30 days from the date of the decision granting**

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<sup>8</sup> Id.

<sup>9</sup> Id.

<sup>10</sup> See id.

<sup>11</sup> Included in the regulatory page count are the 39 pages of patent owner’s February 28, 2011 remarks, as well as portions of the May 19, 2011 corrected Mikos declaration (e.g., at least Section VII of Mikos declaration, spanning pages 26-62, includes arguments directed to how an outstanding or proposed rejection is overcome).

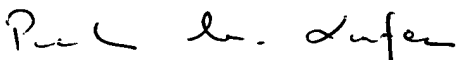
<sup>12</sup> See May 10, 2011 decision at page 3.

**patent owner's renewed petition under 37 CFR 1.183 and entering patent owner's response submission as page-length compliant.** Any renewed requester petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) should accompany requester's comments submission that complies with the formatting guidelines set forth herein. In the event requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted. [Footnote omitted.]

In view of the instant decision granting patent owner's May 19, 2011 renewed petition under 37 CFR 1.183 and entering patent owner's corrected response submission as page-length compliant, third party requester may once file written comments under 37 CFR 1.183 within 30 days of the mailing date of this decision.

### CONCLUSION

1. Patent owner's May 19, 2011 renewed petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's corrected response submission to exceed the regulatory page limit by up to 54 pages. **This waiver makes patent owner's corrected response submission page-length compliant.**
2. Third party requester may once file written comments, limited to issues raised by the December 30, 2010 Office action or the patent owner's corrected response submission, **within 30 days from the mailing date of this decision.**
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

07-25-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,567	08/23/2010	6746773	01035.0069-00000	1682
45511	7590	12/07/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 12/07/2011

Please find below and/or attached an Office communication concerning this application or proceeding.





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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-7-11

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP  
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WASHINGTON, DC 20001-4413

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000567

PATENT NO. : 6746773

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**DEC 07 2011**

(For Patent Owner)

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(For *Inter Partes* Requester)

<i>Inter Partes</i> Reexamination Proceeding	:	<b>DECISION</b>
Control No. 95/000,567	:	<b>DENYING</b>
Filed: August 23, 2010	:	<b>PETITION</b>
For: U.S. Patent No.: 6,746,773	:	

This decision addresses the following:

- The October 7, 2011 patent owner petition entitled "Petition Under 37 C.F.R. § 1.182", filed on October 7, 2011" (the October 7, 2011 patent owner petition under 1.182);
- The November 2, 2011 opposition petition by the *inter partes* requester entitled "Requester's Petition to Respond to Patent Owner's October 7, 2011 Petition Under 37 C.F.R. § 1.182 Seeking Unprecedented Discovery in *Inter Partes* Reexamination Proceedings" (the November 2, 2011 opposition).

The October 7, 2011 patent owner petition under 37 CFR 1.182, the November 2, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's October 7, 2011 petition under 37 CFR 1.182 is **denied**. Discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings.

Patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is **denied**.

This decision is designated as a final agency action under 5 U.S.C. § 704.

## DECISION

The patent owner requests that the Office “clarify” its rules as they relate to the service of a subpoena under 35 U.S.C. 24 in *inter partes* reexamination proceedings. Specifically, the patent owner requests that the Office “confirm that its current rules impose no requirement that parties seeking to enforce subpoenas under § 24 must obtain the Office’s authorization”. Alternatively, the patent owner requests:

if the Office takes the position that such authorization is required for the enforcement of § 24 subpoenas, . . . that the Office grant such authorization so that Patent Owner may (i) obtain important information relevant to nonobviousness that is in the possession of the third party requester in this reexamination . . . , and (ii) cross-examine a witness whose declarative testimony has been entered into the record of this reexamination by Abbott [the third party requester].

35 U.S.C. 24 provides, in pertinent part (emphasis added):

The clerk of any United States court for the district wherein testimony is to be taken for use in *any contested case in the Patent and Trademark Office*, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office....

The *inter partes* reexamination statute, however, does not authorize discovery in *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Optional *inter partes* reexamination was enacted in the American Inventors Protection Act of 1999 (the AIPA). See Public Law 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999), codified at 35 U.S.C. 311–318. 35 U.S.C. 311–318 provide for the filing of a request for *inter partes* reexamination, the Office’s decision on such a request, an examination stage including Office actions on the merits, patent owner responses to the Office actions, and third-party requester comments (where patent owner responds) addressing issues raised by the Office action and/or the patent owner’s response, an appeal stage, and the issuance of a certificate at the conclusion of the proceedings. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the Board of Patent Appeals and Interferences (BPAI) adverse to patent owner to the United States Court of Appeals for the Federal Circuit (Federal Circuit). However, as originally enacted, the AIPA did not permit a third party requester of the *inter partes* reexamination to appeal an adverse decision of the BPAI to the Federal Circuit, and did not provide for third-party-requester participation in an appeal taken by the patent owner to the Federal Circuit. Subsequently, the *21st Century Department of Justice Appropriations Authorization Act* (see Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002)) via section 13106, granted the third party requester the rights to (a) appeal an adverse decision of the BPAI to the Federal Circuit (in which appeal the patent owner may participate), and (b) be a party to a patent

owner appeal to the Federal Circuit. **Such is the extent of third party participation in an *inter partes* reexamination proceeding, as provided by the 1999 and 2002 enactments.**

35 U.S.C. 314 prescribes the procedure for the conduct of *inter partes* reexamination proceedings. 35 U.S.C. 314(a) provides, in pertinent part:

Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.

35 U.S.C. 132 and 133, which govern initial examination, do not provide for a discovery practice. In addition, the initial examination of a patent application is not a “contested case in the Patent and Trademark Office” within the meaning of 35 U.S.C. 24. 35 U.S.C. 132 and 133 address initial examination, and not adjudication, and accordingly do not provide any basis for the authorization of discovery under 35 U.S.C. 24. Moreover, 35 U.S.C. 305, which includes corresponding provisions governing *ex parte* reexamination, similarly specifies that *ex parte* reexamination “will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.” The fact that the same language is used to describe the conduct of *ex parte* reexamination proceedings, which do not provide for discovery, suggests that discovery practice is not within the scope of any reexamination proceeding, whether *inter partes* or *ex parte*. Cf. *Rules to Implement Optional Inter Partes Reexamination Proceeding*, 65 Fed. Reg. 76,756, 76,763 (December 7, 2000) (final rule) (“In a very real sense, the intent of reexamination is to start over and reexamine the patent and examine new and amended claims as *they would have been examined in the original application of the patent.*”) (emphasis added).

35 U.S.C. 314(b) provides for service of parties and for the submission of written comments by the third party requester after a patent owner response during the examination stage. Third party requester’s written comments must be filed within thirty days of the date of service of patent owner’s response. There is no authorization for discovery. Furthermore, it would be impracticable, if not impossible, for the parties to conduct discovery, for the court to resolve any discovery disputes, and for the third party requester to prepare and submit its written comments within the thirty-day period set by statute. The fact that Congress required the third party requester to file written comments within a thirty-day period provides evidence that Congress did not intend to authorize discovery practice in *inter partes* reexamination proceedings.

Both 35 U.S.C. § 314(c), which governs *inter partes* reexamination, and 35 U.S.C. § 305, which governs *ex parte* reexamination, provide that reexamination in *inter partes* reexamination and in *ex parte* reexamination proceedings, respectively, will be conducted with “special dispatch” within the Office. Neither the statute nor the regulations define special dispatch; however, in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit explained:

“Special dispatch” is not defined by statute. . . . According to Webster’s New World Dictionary, special means distinctive, unique, exceptional or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary and common meaning of special dispatch envisions some type of unique, extraordinary or accelerated

movement. In fact, the PTO itself has interpreted special dispatch to require that 'reexamination proceedings will be "special" through their pendency' in the office and provides for an accelerated schedule. MPEP § 2261.

*Ethicon*, 849 F.2d at 1426.

Any provision for discovery would necessarily prolong proceedings before the Office. If Congress had intended for discovery to be permitted in inter partes reexamination proceedings, rather than in ex parte reexamination proceedings, Congress would have expressly provided for such a practice, and it would have circumscribed the discovery in a manner consistent with the statutory requirement for "special dispatch." Thus, the statutory requirement for special dispatch clearly provides evidence that Congress did not contemplate discovery for *inter partes* reexamination proceedings. Regarding the sole exception to the "special dispatch" requirement, i.e., a finding of "good cause" by the Director, the Office has not authorized an exception to the "special dispatch" provision for the purposes of permitting discovery, and is not authorized to do so, given the above-discussed provisions of 35 U.S.C. 314(a).

The above interpretation of the *inter partes* reexamination provisions is consistent with their legislative history. The legislative history makes no mention of discovery, and consistently expresses a concern for providing a low-cost, efficient alternative to litigation, in which a third party requester has the ability to participate by submitting comments, in writing, to the examiner, in response to arguments made by the patentee. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did "not subject the patent to any greater challenge in scope than currently exists today" but "merely allows a reexam requestor the option to further explain why a particular patent should not have been granted"); H.R. Rep. No. 106-287, 106th Cong., 1st Sess. 31, (1999) (Submitted by Rep. Coble) ("The existing patent reexamination system is an ineffective means for bringing relevant prior art unavailable to examiners during their search to the attention of the PTO due to the ex parte nature of the proceeding."); 145 Cong. Rec. S14720, (Nov. 17, 1999) (Statement of Senator Lott) ("Subtitle F is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing *ex parte* reexamination in Chapter 30 of title 35, the option of *inter partes* reexamination proceedings in the USPTO. Congress enacted legislation to authorize *ex parte* reexamination of patents in the USPTO in 1980, but such reexamination has been used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the USPTO. Subtitle F provides that opportunity as an option to the existing *ex parte* reexamination proceedings.").

The Office implicitly understood that the *inter partes* reexamination provisions do not authorize discovery. In response to a reporting requirement of the AIPA (*see* AIPA, Pub. L. 106-113, 1501A-571, § 4606 (1999)), the Office conducted a "round table meeting" to receive views on the effectiveness and possible improvement of *inter partes* reexamination and then drafted a report to Congress. The report points out that "the lack of such procedural mechanisms as discovery and cross-examination that would be available in litigation has apparently resulted in challengers being unwilling to invoke inter partes reexamination and risk its estoppel effect."

United States Patent And Trademark Office Report To Congress On Inter Partes Reexamination (2004) (available at [http://www.uspto.gov/web/offices/dcom/olia/reports/reexam\\_report.htm](http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm)), at 4; *see also* Transcript of February 17, 2004 Roundtable Meeting (available at [http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round\\_tbl\\_transcript.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round_tbl_transcript.pdf)) at 20-21 (discussing the lack of discovery in *inter partes* reexamination). The report contrasts *inter partes* reexamination to a proposed “post-grant review process,” in which “[c]losely controlled discovery and cross-examination would be available in the review, upon the challenger’s presenting sufficient grounds that one or more of the patent claims are unpatentable.” *Id.* at 8. Accordingly, the public and the Office understood that discovery was not available in *inter partes* reexamination, and that additional legislation would be required to provide for such discovery.

On September 16, 2011, Congress enacted The America Invents Act (the AIA), which, replaces *inter partes* reexamination with a new proceeding titled *inter partes* review, effective September 16, 2012. The statute expressly provides for discovery in newly enacted 35 U.S.C. § 316 (Conduct of *inter partes* review), which instructs the Director to “prescribe regulations . . . setting forth standards and procedures for discovery of relevant evidence, including that such discovery will be limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is necessary in the interests of justice.” *See* Pub. L. No. 112-29, Section 6. The legislative history of the new proceeding confirms that Congress intended to provide discovery where none had previously been available:

The Act converts *inter partes* reexamination from an examinational to an adjudicative proceeding, and renames the proceeding “*inter partes* review.” The Act also makes the following improvements to this proceeding:

....

- Discovery. Parties may depose witnesses submitting affidavits or declarations and seek such discovery as the Patent Office determines is otherwise necessary in the interest of justice.

H. Rep. No. 112-98 (Part 1) 112th Cong., 1st Sess., at 46-47 (2011) (available at <http://www.gpo.gov/fdsys/pkg/CRPT-112hrpt98/pdf/CRPT-112hrpt98-pt1.pdf>).

Congress’s characterization of the provision for limited discovery in *inter partes* review as an “improvement” over *inter partes* reexamination settles any dispute concerning the proper interpretation of the *inter partes* reexamination statute. The AIPA does not authorize discovery in *inter partes* reexamination proceedings.

The patent owner argues that case law relating to discovery in patent interferences supports the ability to obtain discovery under 35 U.S.C. 24 without prior Office approval.<sup>1</sup> However, the enactment of the *inter partes* review discovery provision of the AIA, which sets limits on permissible discovery in *inter partes* review, confirms that the patent owner cannot rely on 35 U.S.C. 24 in isolation to provide authorization for discovery in Office proceedings. The anomalous result of patent owner’s argument would be that because the *inter partes* reexamination statute failed to provide for discovery, more discovery would be available under

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<sup>1</sup> See page 3 of the present petition.

*inter partes* reexamination than under *inter partes* review. That result is plainly contrary to Congress's intent.

Furthermore, 35 U.S.C. 24 applies to contested cases within the Patent and Trademark Office. However, an *inter partes* reexamination proceeding is not a contested case, also as argued by the third party requester.<sup>2</sup> The Office's interpretation of 35 U.S.C. 314 to exclude authorization for discovery in *inter partes* reexamination proceedings, including the interpretation that *inter partes* reexamination proceedings are not "contested cases" within the meaning of 35 U.S.C. 24, is confirmed by the Office's promulgation of rules specifically governing discovery for interferences, while none were drafted for *inter partes* reexamination proceedings. *See, e.g.*, 37 CFR 41.150(a), which states: "[a] party is not entitled to discovery except as authorized in this subpart".

Finally, if Congress intended to permit discovery in *inter partes* reexamination proceedings, it would have modeled those proceedings on "contested cases" such as interferences, and not on proceedings such as initial examination or *ex parte* reexamination, which are not contested cases, and which do not include discovery. *See, e.g.*, 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did "not subject the patent to any greater challenge in scope than currently exists today" but "merely allows a reexam requestor the option to further explain why a particular patent should not have been granted").

In summary, discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Accordingly, patent owner's October 7, 2011 petition under 37 CFR 1.182 is **denied**. For the same reasons, patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is **denied**.

This decision constitutes the Office's final decision concerning whether discovery is permissible in *inter partes* reexamination proceedings.

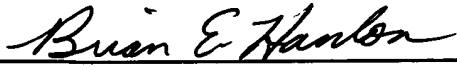
### CONCLUSION

- Patent owner's October 7, 2011 petition under 37 CFR 1.182 is **denied**
- Patent owner's October 7, 2011 alternative petition under 37 CFR 1.182, requesting the Office to authorize discovery under 35 U.S.C. 24 in the present merged proceeding, is **denied**.
- This decision is designated as a final agency action under 5 U.S.C. § 704.

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<sup>2</sup> See the November 2, 2011 opposition by the third party requester, Abbott Laboratories.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.

A handwritten signature in cursive script, reading "Brian E. Hanlon", written in black ink.

Brian E. Hanlon  
Director  
Office of Patent Legal Administration





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,567	08/23/2010	6746773	01035.0069-00000	1682
45511	7590	12/30/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

Date: 12-30-11

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000567  
PATENT NO. : 6746773  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Woodcock Washburn LLP  
Cira Centre, 12<sup>th</sup> Floor  
2929 Arch Street  
Philadelphia, PA 19104-2891

DEC 30 2011

(For Patent Owner)

**CENTRAL REEXAMINATION UNIT**

Finnegan, Henderson, Farabow,  
Garrett & Dunner, LLP  
901 New York Avenue, N.W.  
Washington, DC 20001-4413

(For Third Party Requester)

*In re Llanos et al.*

*Inter Partes* Reexamination Proceeding

Control No. 95/000,567

Filed: August 23, 2010

For: U.S. Patent No. 6,746,773

:  
: **DECISION**  
: **GRANTING**  
: **PETITION**  
:

This is a decision on the third party requester, Abbott Laboratories (Abbott), paper entitled "RENEWED PETITION SEEKING WAIVER OF 37 C.F.R. § 1.943 FOR COMMENTS BY THIRD-PARTY REQUESTER UNDER 37 C.F.R. § 1.947" (the renewed petition under 37 CFR 1.183), filed on August 19, 2011.

The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

**FEEES**

Third party requester filed a petition under 37 CFR 1.183 on April 20, 2011 requesting waiver of the 50-page limit for its March 30, 2011 comments submission. The \$400.00 petition fee under 37 CFR 1.17(f) was applied to requester's credit card on April 21, 2011. On May 10, 2011, the Office mailed a decision, dismissing third party requester's April 20, 2011 petition as moot and stating that "[i]n the event requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted."<sup>1</sup> On August 19, 2011, requester filed the instant renewed petition under 37 CFR 1.183 and, on August 23, 2011, the \$400.00 petition fee under 37 CFR 1.17(f) was applied to requester's deposit account no. 06-0916. Because the instant petition under 37 CFR 1.183 is a renewed petition, no additional petition fee is required for the August 19, 2011 petition. Accordingly, requester is being refunded the \$400.00 petition fee that was charged on August 23, 2011.

<sup>1</sup> May 10, 2011 decision at page 5.

## DECISION

### I. Background

On December 29, 2010, the Office mailed a non-final office action in the instant 95/000,567 proceeding (the '567 proceeding). On February 28, 2011, patent owner filed a petition under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit for its concurrently-filed response submission. On March 30, 2011, third party requester filed a comments submission. On April 20, 2011, third party requester filed a petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its March 30, 2011 comments submission. On May 10, 2011, the Office mailed a decision dismissing patent owner's February 28, 2011 petition and not entering patent owner's response submission, and dismissing as moot third party requester's April 20, 2011 petition and not entering third party requester's comments submission.

On May 19, 2011, in accordance with the May 10, 2011 decision, patent owner filed a renewed petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its concurrently-filed corrected response submission. On July 26, 2011, the Office mailed a decision granting patent owner's May 19, 2011 petition and entering patent owner's May 19, 2011 corrected response submission, giving third party requester 30 days from the mailing date of that decision to file written comments. On August 19, 2011, third party requester filed the instant renewed petition under 37 CFR 1.183, requesting waiver of the regulatory page limit for its concurrently-filed comments submission.<sup>2</sup>

### II. Abbott's August 19, 2011 Renewed Petition under 37 CFR 1.183

Requester Abbott states that the instant renewed petition under 37 CFR 1.183 is responsive to the May 10, 2011 and July 26, 2011 decisions.<sup>3</sup> The May 10, 2011 decision states that to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that adheres to the formatting guidelines set forth therein.<sup>4</sup> The July 26, 2011 decision reiterates the May 10, 2011 decision in stating that "[a]ny renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) should accompany requester's comments submission that complies with the formatting guidelines set forth herein."<sup>5</sup> In the instant renewed petition under 37 CFR 1.183, third party requester states that it timely submitted the instant renewed petition under 37 CFR 1.183, concurrently with its comments and the declaration of Dr. Helmus (the Helmus Declaration).

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR

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<sup>2</sup> See the renewed petition under 37 CFR 1.183 at page 1.

<sup>3</sup> Id.

<sup>4</sup> May 10, 2011 decision at page 5.

<sup>5</sup> July 26, 2011 decision at page 4.

1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of resulting comments that are in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such comments can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments: (1) for justification that more pages are needed to complete the comments, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the comments.

In this instance, third party requester requests waiver of the regulatory page limit so that “Abbott be permitted to fully and fairly address all of the issues raised in the Office Action and in Cordis’s 39-page Response and 65-page Mikos Declaration” and “specifically requests an increase in the regulatory page limit by 26 pages.”<sup>6</sup> Third party requester asserts that “[i]n its 49-page Comments and 42-page Helmus Declaration, Abbott appropriately limits its argumentation to issues raised in the Office Action and in Cordis’s response” and that “Abbott’s Comments and the Helmus Declaration adheres to the formatting guidelines set forth in 37 C.F.R. 1.943(a) and 37 C.F.R. 1.52 and are one-and-a-half spaced and in size 12 font Times New Roman.”<sup>7</sup> Requester also asserts that “its request is lower than the 54-page increase granted to Cordis.”<sup>8</sup>

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for a response or comments submission, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-

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<sup>6</sup> Id. at page 3 and FN 2. (stating, “Abbott’s Comment comprises 49 pages. The accompanying Helmus Declaration contains 42 pages. The pages including Dr. Helmus’ curriculum vitae, work experience and publications, however, were not counted towards the page limit. In accordance with the Office, Abbott believes that only Section V, spanning pages 20-42 contain argument as to how an outstanding or proposed rejection is supported. Although Abbott believes pages 15-20 merely provide background factual information, in an abundance of caution, Abbott has also included those pages in counting the regulatory page limit. Abbott therefore believes that 27 pages of the Helmus Declaration should count toward the regulatory page limit for a total of 76 pages. Accordingly, Abbott specifically requests a 26 page increase in the page limit.”).

<sup>7</sup> Id. at page 2.

<sup>8</sup> Id. at page 3.

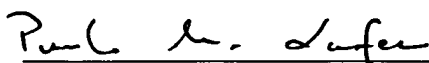
felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, requester has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit, and submitting the resulting comments, and accompanying declaration, which in total exceed 50 pages. Requester's August 19, 2011 comments comprise 49 pages of remarks that count toward the regulatory page limit (the cover page and table of contents pages are excluded from the page count). Additionally, at least portions of the 42-page declaration of Michael N. Helmus, Ph.D., are deemed to be an extension of the arguments of counsel and count toward the regulatory page limit.<sup>9</sup>

Based on third party requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission which is in excess of 50 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent requester's August 19, 2011 comments submission exceeds 50 pages. Accordingly, third party requester's August 19, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of third party requester's August 19, 2011 comments submission. **This waiver makes Abbott's August 19, 2011 comments submission page-length compliant.**

### CONCLUSION

1. Requester Abbott Laboratories' August 19, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of third party requester's August 19, 2011 comments submission. **This waiver makes Abbott's August 19, 2011 comments submission page-length compliant.**
2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

12-27-2011

<sup>9</sup> See, e.g., Section V of the Helmus declaration, spanning pages 20-42.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,568	08/25/2010	7364752		5384

23492 7590 02/28/2012

PAUL D. YASGER  
ABBOTT LABORATORIES  
100 ABBOTT PARK ROAD  
DEPT. 377/AP6A  
ABBOTT PARK, IL 60064-6008

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 02/28/2012

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SUITE 928  
NEW YORK, NY 10003

Date: **MAILED**

**FEB 28 2012**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000568  
PATENT NO. : 7364752  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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CENTRAL REEXAMINATION UNIT

Abbott Laboratories  
100 Abbott Park Rd.  
D377/AP6A-1  
Abbott Park, IL 60064

(For Patent Owner)

Public Patent Foundation  
55 Fifth Avenue, Suite 928  
New York, NY 10003

(For Requester)

In re *Fort et al.*

Reexamination Proceeding

Control No. 95/000,568

Filed: August 25, 2010

For: U.S. Patent No. 7,364,752

: DECISION ON  
: PETITION UNDER  
: 37 CFR 1.182  
:

This is a decision on a petition filed by the patent owner on May 25, 2011 entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR NEW OFFICE ACTION" filed under 37 CFR 1.182. The petition has been treated as a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to withdraw the Action Closing Prosecution (ACP) issued on May 19, 2011. The petition has been followed by a response to the ACP, including amendments to the claims, filed on June 17, 2011.

The petition is before the Director of the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated May 25, 2011 is granted with respect to withdrawing the ACP mailed May 19, 2011.

**REVIEW OF RELEVANT FACTS**

1. U.S. Patent No. 7,364,752 (hereinafter, the '752 patent) issued on April 29, 2008.
2. On August 25, 2010, a third party requester deposited a request for *inter partes* reexamination of the '752 patent, and the resulting reexamination proceeding was assigned Control No. 95/000,568 (hereinafter, the '568 reexamination proceeding).
6. *Inter partes* reexamination was ordered for the '568 reexamination proceeding on October 28, 2010. On the same day, a non-final Office action was mailed in the '568 reexamination proceeding.
7. On December 22, 2011, Patent Owner filed a response to the first Office action. The response included an expert declaration. The response did not amend the claims.
8. Third party requester did not file comments in response to Patent Owner's December 22, 2011 response.
9. Patent Owner then filed Information Disclosure Statements on the following dates: February 15, 2011, April 7, 2011, April 14, 2011, April 25, 2011 and May 23, 2011.
10. On May 19, 2010, the Office issued an Action Closing Prosecution (ACP). The ACP withdrew all previously set forth rejections and presented new grounds of rejection.
11. On May 25, 2011, Patent Owner filed the instant petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the ACP be withdrawn. The petition was followed by a response to the ACP, including amendments to the claims, filed on June 17, 2011.

## DECISION

Patent Owner (petitioner) states that the ACP mailed May 19, 2011 should be reissued as a second, non-final Office action because Patent Owner has not been previously faced with rejections based on the references or substantive positions taken by the examiner in the ACP. Patent Owner also states that the reissuance of the ACP as a second, non-final Office action is consistent with the rules regarding the timing of filing IDSs in reexamination. Patent Owner states that it was not possible in the present *inter partes* reexamination to submit IDSs prior to the issuance of a first Office action because the Office action issued concurrently with the order granting reexamination and it was thus unfair to place Patent Owner at the procedural disadvantage of an ACP based on the incorrect assumption that Patent Owner could have presented the documents to the examiner prior to the issuance of the first Office action. Patent Owner also argues that the rejections contained in the ACP are substantively different from the rejections

contained in the first, non-final Office action because they did not cite the Martin document. Patent Owner also argues that it is likely to submit additional declaration evidence to rebut the new rejections in the ACP and/or amend the claims in response to the ACP and that the one month time period for response set by an ACP is, essentially, too short to compose an adequate response. For all these reasons, Patent Owner argues that the ACP should be reissued as a second, non-final Office action, effectively reopening prosecution.

In response to patent owner's arguments for reopening prosecution in this reexamination proceeding, the director finds that the arguments DO NOT establish good and sufficient reasons to reissue the ACP as a second, non-final Office action. However, a review of the record in accordance with the rules governing the issuance of ACPs does reveal good and sufficient reasons to reissue the ACP as a second, non-final Office action.

Turning to the facts in this proceeding, Patent Owner is reminded that *inter partes* reexamination proceedings are to be conducted with "special dispatch" (see MPEP 2654 and 35 U.S.C. § 314(c)). To this end, it is clearly stated in the MPEP that the order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits (see MPEP 2260 and 37 C.F.R. 1.935). Accordingly, Patent Owner's arguments regarding the unfairness of having the first Office action mailed concurrently with the order granting reexamination are without merit. As noted by Patent Owner, the filing of IDSs in *inter partes* reexamination, while clearly encouraged at the earliest point in the proceedings, can take place after the issuance of a first Office action (see MPEP 2280). Patent Owner is also subject to the duty of disclosure set forth in 37 C.F.R. 1.933 (see MPEP 2684). Patent Owner's filing of IDSs on February 15, April 7, April 14, April 25 and May 23 of 2011 is therefore proper. It is also proper for the examiner to utilize the references cited in these IDSs in making new grounds of rejection.

However, the examiner can only issue an ACP that includes new grounds of rejection when the new grounds of rejection are necessitated by amendment.

Specifically, 37 CFR 1.949 states:

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. ***An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.*** [emphasis added].

A review of the file indicates that in the response to the first Office action (filed December 22, 2011), the Patent Owner did not amend the claims. However, in the ACP, the examiner withdrew all grounds of rejection previously set forth in the first Office action and presented new grounds of rejection. Therefore, the examiner prematurely

closed prosecution because there was no amendment to the claims that necessitated the new ground of rejection, in accordance with 37 CFR 1.949 (see also MPEP 2671.01).

Accordingly, there are good and sufficient reasons to withdraw the ACP and reissue the ACP as a second, non-final Office action and the patent owner's petition is granted.

Due to the vacatur of the May 19, 2011 ACP, patent owner's response filed June 17, 2011 will *not be entered* and is hereby vacated along with the ACP.

#### CONCLUSION

1. The petition under 37 CFR 1.181 for withdrawal of the ACP dated May 25, 2011 is granted.
2. The ACP, dated May 19, 2011, is hereby vacated and the examiner will issue a corrected non-final Office action, in due course, to replace the May 19, 2011 Office action.
3. Patent Owner's response, filed June 17, 2011 will NOT be entered and also hereby vacated.
4. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.

  
\_\_\_\_\_  
Irem Yucel  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,570	09/23/2010	7148359		1781
7590 02/28/2012				
ABBOTT LABORATORIES 100 ABBOTT PARK RD D377/AP6A-1 ABBOTT PARK, IL 60064			EXAMINER	
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2012

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NEW YORK, NY 10003

Date:

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**FEB 28 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000570  
PATENT NO. : 7148359  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Abbott Laboratories  
100 Abbott Park Rd.  
D377/AP6A-1  
Abbott Park, IL 60064

(For Patent Owner)

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**FEB 28 2012**

**CENTRAL REEXAMINATION UNIT**

Public Patent Foundation  
55 Fifth Avenue, Suite 928  
New York, NY 10003

(For Requester)

In re *Chemburkar et al.*  
Reexamination Proceeding  
Control No. 95/000,570  
Filed: September 23, 2010  
For: U.S. Patent No. 7,148,359

:  
: DECISION ON  
: PETITION UNDER  
: 37 CFR 1.182  
:

This is a decision on a petition filed by the patent owner on May 26, 2011 entitled "PETITION UNDER 37 C.F.R § 1.182 FOR NEW OFFICE ACTION" filed under 37 CFR 1.182. The petition has been treated as a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 to withdraw the Action Closing Prosecution (ACP) issued on May 20, 2011. The petition has been followed by a response to the ACP, including amendments to the claims, filed on June 20, 2011.

The petition is before the Director of the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated May 26, 2011 is granted with respect to withdrawing the ACP mailed May 20, 2011.

**REVIEW OF RELEVANT FACTS**

1. U.S. Patent No. 7,148,359 (hereinafter, the '359 patent) issued on May 4, 2005.
2. On September 23, 2010, a third party requester deposited a request for *inter partes* reexamination of the '359 patent, and the resulting reexamination proceeding was assigned Control No. 95/000,570 (hereinafter, the '570 reexamination proceeding).
6. *Inter partes* reexamination was ordered for the '570 reexamination proceeding on November 18, 2010. On the same day, a non-final Office action was mailed in the '570 reexamination proceeding.
7. On January 14, 2011, Patent Owner filed a response to the first Office action. The response included an expert declaration. The response did not amend the claims.
8. Third party requester did not file comments in response to Patent Owner's January 14, 2011 response.
9. Patent Owner then filed Information Disclosure Statements on the following dates: March 25, 2011, April 11, 2011, April 25, 2011 and May 23, 2011.
10. On May 20, 2010, the Office issued an Action Closing Prosecution (ACP). The ACP withdrew all previously set forth rejections and presented new grounds of rejection.
11. On May 26, 2011, Patent Owner filed the instant petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that the ACP be withdrawn. The petition was followed by a response to the ACP, including amendments to the claims, filed on June 20, 2011.

## DECISION

Patent Owner (petitioner) states that the ACP mailed May 20, 2011 should be reissued as a second, non-final Office action because Patent Owner has not been previously faced with rejections based on the references or substantive positions taken by the examiner in the ACP. Patent Owner also states that the reissuance of the ACP as a second, non-final Office action is consistent with the rules regarding the timing of filing IDSs in reexamination. Patent Owner states that it was not possible in the present *inter partes* reexamination to submit IDSs prior to the issuance of a first Office action because the Office action issued concurrently with the order granting reexamination and it was thus unfair to place Patent Owner at the procedural disadvantage of an ACP based on the incorrect assumption that Patent Owner could have presented the documents to the examiner prior to the issuance of the first Office action. Patent Owner also argues that the rejections contained in the ACP are substantively different from the rejections contained in the first, non-final Office action because they did not cite the Martin and Dias documents. Patent Owner also argues that it is likely to submit additional



declaration evidence to rebut the new rejections in the ACP and/or amend the claims in response to the ACP and that the one month time period for response set by an ACP is, essentially, too short to compose an adequate response. For all these reasons, Patent Owner argues that the ACP should be reissued as a second, non-final Office action, effectively reopening prosecution.

In response to patent owner's arguments for reopening prosecution in this reexamination proceeding, the director finds that the arguments DO NOT establish good and sufficient reasons to reissue the ACP as a second, non-final Office action. However, a review of the record in accordance with the rules governing the issuance of ACPs does reveal good and sufficient reasons to reissue the ACP as a second, non-final Office action.

Turning to the facts in this proceeding, Patent Owner is reminded that *inter partes* reexamination proceedings are to be conducted with "special dispatch" (see MPEP 2654 and 35 U.S.C. § 314(c)). To this end, it is clearly stated in the MPEP that the order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits (see MPEP 2260 and 37 C.F.R. 1.935). Accordingly, Patent Owner's arguments regarding the unfairness of having the first Office action mailed concurrently with the order granting reexamination are without merit. As noted by Patent Owner, the filing of IDSs in *inter partes* reexamination, while clearly encouraged at the earliest point in the proceedings, can take place after the issuance of a first Office action (see MPEP 2280). Patent Owner is also subject to the duty of disclosure set forth in 37 C.F.R. 1.933 (see MPEP 2684). Patent Owner's filing of IDSs on March 25, April 11, April 25 and May 23 of 2011 is therefore proper. It is also proper for the examiner to utilize the references cited in these IDSs in making new grounds of rejection.

However, the examiner can only issue an ACP that includes new grounds of rejection when the new grounds of rejection are necessitated by amendment.

Specifically, 37 CFR 1.949 states:

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. ***An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.*** [emphasis added].


A review of the file indicates that in the response to the first Office action (filed January 14, 2011), the Patent Owner did not amend the claims. However, in the ACP, the examiner withdrew all grounds of rejection previously set forth in the first Office action and presented new grounds of rejection. Therefore, the examiner prematurely closed prosecution because there was no amendment to the claims that necessitated the new ground of rejection, in accordance with 37 CFR 1.949 (see also MPEP 2671.01).

Accordingly, there are good and sufficient reasons to withdraw the ACP and reissue the ACP as a second, non-final Office action and the patent owner's petition is granted.

Due to the vacatur of the May 20, 2011 ACP, patent owner's response filed June 20, 2011 will *not be entered* and is hereby vacated along with the ACP.

#### CONCLUSION

1. The petition under 37 CFR 1.181 for withdrawal of the ACP dated May 26, 2011 is granted.
2. The ACP, dated May 20, 2011, is hereby vacated and the examiner will issue a corrected non-final Office action, in due course, to replace the May 20, 2011 Office action.
3. Patent Owner's response, filed June 20, 2011 will NOT be entered and also hereby vacated.
4. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Examiner, at (571) 272-1535.

  
Irem Yucel  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,572	08/30/2010	7,269,847	159291-0010(847)	2886
28661	7590	02/24/2011	EXAMINER	
LEWIS AND ROCA LLP 1663 Hwy 395, Suite 201 Minden, NV 89423			ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
IRELL & MANELLA LLP  
1800 AVENUE OF THE STARS  
SUITE 900  
LOS ANGELES, CA 90067

Date: **MAILED**

**FEB 24 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000572  
PATENT NO. : 7269847  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>Decision on Petition for Extension of Time in Reexamination</b>	Control No.: 95/000,572
--	-------------------------

1. THIS IS A DECISION ON THE PETITION FILED 21 February 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.  
The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 18 January 2011 which sets a two (2) months period for filing a response thereto, be extended by one(1) month

A. ☒ Petition fee per 37 CFR §1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☐ Petition includes authorization to charge a credit card account.

iii. ☐ Other: \_\_\_\_\_.

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

A. ☒ Granted or ☐ Granted-in-part for one (1) months because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).  
☐ Other/comment: \_\_\_\_\_.

B. ☐ Dismissed because:

i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).

ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☐ Other/comment: \_\_\_\_\_.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611 .In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/  
 [Signature]

SPE, AU 3992 Central Reexamination Unit  
 (Title)



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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,577- <del>95/000,546</del>	10/20/2010	7289386	17730-3	7888
20995	7590	03/03/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 03/03/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

Date: 3-3-11

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000577 + 95/000546  
PATENT NO. : 7289386  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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KNOBBE MARTENS OLSON & BEAR LLP (For Patent Owner)  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE CA 92614

FISH & RICHARDSON P.C. (For first *Inter Partes* Requester)  
PO BOX 1022  
MINNEAPOLIS, MN 55440-1022

ORRICK, HERRINGTON & SUTCLIFFE LLP (For second *Inter Partes* Requester)  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,546  
Filed: May 11, 2010  
For: U.S. Patent No. 7,289,386

:  
: **DECISION,**  
: ***SUA SPONTE*,**  
: **TO MERGE**  
: **REEXAMINATION**  
: **PROCEEDINGS**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,577  
Filed: October 20, 2010  
For: U.S. Patent No. 7,289,386

:  
:  
:

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

#### REVIEW OF RELEVANT FACTS

1. On October 30, 2007, U.S. Patent No. 7,289,386 (the '386 patent) issued to Bhakta *et al.* with 13 claims.
2. On May 11, 2010, a first request for *inter partes* reexamination of claims 1-12 of the '386 patent, assigned control No. 95/000,546 ("the '546 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '546 requester").
3. On August 9, 2010, *inter partes* reexamination was ordered on claims 1-12 of the '386 patent in the '546 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.



4. On August 27, 2010, a non-final Office action was mailed in the '546 proceeding, rejecting claims 1-12 of the '386 patent.
5. On October 20, 2010, a second request for *inter partes* reexamination of claims 1-13 of the '386 patent, assigned control No. 95/000,577 ("the '577 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '577 requester").
6. On October 27, 2010, patent owner timely filed, in the '546 proceeding, an amendment and response to the August 27, 2010 Office action, adding new claims 14-30. No claims were amended or canceled.
7. On November 26, 2010, third party request timely filed comments.
8. On January 18, 2011, *inter partes* reexamination was ordered on claims 1-13 of the '386 patent in the '577 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.
9. To date, no Office action has issued in the '577 *inter partes* proceedings, and no further Office action has issued in the '546 *inter partes* proceeding.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination is ordered in the two above-captioned proceedings for overlapping claims of the same patent. Both proceedings are *inter partes* reexamination proceedings. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/000,546 and 95/000,577 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. New claims 14-30 have been proposed by amendment in the '546 proceeding, while there is no corresponding amendment in the '577 proceeding. Thus, the claims are not currently the same in both files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947. It is to be noted that if the '546 requester chooses to file a comments paper after the patent owner response, the filing of such will be treated as comments in substitution for the comments filed on November 26, 2010. In that event, the November 26, 2010 comments paper would not be considered by the examiner. Accordingly, should '546

requester choose to file a substitute comments paper, then '546 requester should include any comments from the November 26, 2010 comments that it wishes considered in any such substitute comments paper.

### III. CONDUCT OF MERGED PROCEEDING

#### A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

#### B. *Inter partes* Third Party Requester Participation:

##### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

##### 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

---

<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '546 *inter partes* third party requester did not propose any rejections of claim 13 in the request for reexamination, the '546 requester does not have an appeal right to claim 13 as it appears in the '386 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to:       Attn: Mail Stop "*Inter Partes* Reexam"  
                      Central Reexamination Unit  
                      Commissioner for Patents  
                      P.O. Box 1450  
                      Alexandria, VA 22313-1450

by FAX to:       (571) 273-9900  
                      Central Reexamination Unit

by Hand to:       Customer Service Window  
                      Attn: Central Reexamination Unit  
                      Randolph Building, Lobby Level  
                      401 Dulany Street  
                      Alexandria, VA 22314

by EFS:           Registered users may submit papers via the  
                      electronic filing system EFS-Web, at:

<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

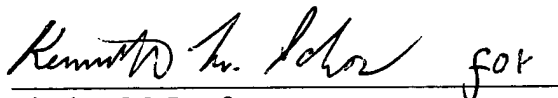
G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each

rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,546 and 95/000,577 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

 for

Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

March 1, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,577 <del>95/000,546</del>	10/20/2010	7289386	17730-3	7888
20995	7590	09/26/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 09/26/2011

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ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

Date: 9-26-11

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000577 + 95/000546  
PATENT NO. : 7289386  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE CA 92614

(For Patent Owner)

FISH & RICHARDSON P.C.  
PO BOX 1022  
MINNEAPOLIS, MN 55440-1022

(For first *Inter Partes* Requester)

ORRICK, HERRINGTON & SUTCLIFFE LLP  
IP PROSECUTION DEPARTMENT  
2050 MAIN STREET, SUITE 1100  
IRVINE, CA 92614

(For second *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,546  
Filed: May 11, 2010  
For: U.S. Patent No. 7,289,386

:  
:  
:  
: **DECISION**  
: **GRANTING**  
: **PETITION**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,577  
Filed: October 20, 2010  
For: U.S. Patent No. 7,289,386

:  
:  
:  
:

This is a decision on patent owner's petition paper entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 CFR § 1.943(b)" filed on July 6, 2011.

The patent owner petition is before the Office of Patent Legal Administration.

The patent owner petition is granted, for the reasons set forth herein.

**BACKGROUND**

1. On October 30, 2007, U.S. Patent No. 7,289,386 (the '386 patent) issued to Bhakta *et al.*
2. On May 11, 2010, a first request for *inter partes* reexamination of the '386 patent, assigned



control No. 95/000,546 ("the '546 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '546 requester").

3. On August 9, 2010, *inter partes* reexamination was ordered in the '546 proceeding.
4. On August 27, 2010, a non-final Office action was mailed in the '546 proceeding.
5. On October 20, 2010, a second request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,577 ("the '577 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '577 requester").
6. On October 27, 2010, patent owner timely filed, in the '546 proceeding, an amendment and response to the August 27, 2010 Office action.
7. On November 26, 2010, third party request timely filed comments in the '546 proceeding.
8. On January 18, 2011, *inter partes* reexamination was ordered in the '577 proceeding.
9. On March 3, 2011, the Office issued a Decision, *Sua Sponte*, merging the '546 and '577 *inter partes* proceedings ("the merged proceeding").
10. On April 6, 2011, an Office action was issued in the merged proceeding, withdrawing the rejections previously set forth in the in the August 27, 2010 Office action in the '546 proceeding and setting forth new or revised grounds of rejection for the merged proceeding.
11. On July 6, 2011, patent owner filed the instant petition entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 CFR § 1.943(b)" (patent owner petition under 37 CFR 1.183) concurrently with a patent owner response to the April 6, 2011 Office action.<sup>1</sup>

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

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<sup>1</sup> Patent Owner filed a "Request for Extension of time under 37 CFR 1.956" on April 15, 2011, seeking a one month extension of time to respond to the Office action mailed on April 6, 2011. The Office granted the petition for extension of time on April 22, 2011, thereby extending the time period for a response to the Office action by one month.

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## **II. Patent Owner Petition Under 37 CFR 1.183**

Patent owner's July 6, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the April 6, 2011 Office action, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner's July 6, 2011 response submission to permit patent owner to submit a 165-page response, including exhibits.<sup>2</sup> In particular, patent owner states that the "Response itself contains 44 pages of argument" and that "[t]aking the full lengths for the arguments of the Response and its three declarations, the 50-page count limit is exceeded by at most 115 pages, while excluding the exhibit pages, the 50-page count limit is exceeded by 33 pages."<sup>3</sup> Patent owner further states that it "attempted to comply with all relevant rules when preparing this Response" and that "despite Patentee's best efforts, the Response exceeded the page count limit...."<sup>4</sup>

In support of waiver of 37 CFR 1.943(b), patent owner states that "[b]ecause the large number of bases were compressed into a single Office Action, Patentee's ability to fully respond to each of the bases in the detailed manner required by 37 C.F.R. § 1.111, within the 50-page limit imposed by 37 C.F.R. § 1.943, is severely compromised."<sup>5</sup> Patent owner further asserts that "[t]he Office Action, on its face, is 31 pages long" but "expressly incorporates by reference substantial

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<sup>2</sup> Patent owner petition under 37 CFR 1.183 at page 4.

<sup>3</sup> *Id.* at page 2.

<sup>4</sup> *Id.*

<sup>5</sup> *Id.* at page 3.

portions of the third-party requesters' requests for reexamination" and that "[b]ecause of the incorporation by reference, the Office Action is effectively more than 350 pages long."<sup>6</sup>

### III. Findings and Analysis

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited** to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, patent owner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a response that is in excess of 50 pages. Based on the guidance set forth above, the July 6, 2011 response submission includes up to 80 pages of arguments. The remarks portion of the July 6, 2011 response includes 42 pages of arguments and 12 pages of support for the new and amended claims, and the 26-page declaration under 37 CFR 1.132 by Dr. Carl Sechen also includes legal argument and is being counted toward the regulatory page limit. The 8-page declaration by Christopher Lopes, submitted with attachments CL-A through CL-O, and the 5-page declaration by Hyun Lee, Ph.D., submitted with exhibits HL-B through HL-E, do not include legal argument and are not being counted toward the regulatory page limit.<sup>7</sup>

Based on patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and

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<sup>6</sup> Id. at page 4.

<sup>7</sup> Patent owner is reminded that to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission that: 1) is one-and-a-half or double-spaced; 2) is in a non-script type font (*e.g.*, Arial, Times New Roman, or Courier); 3) has a font size no smaller than 12-point; 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response submission. Because the declaration by Hyun Lee, Ph.D., is not being counted toward the regulatory page limit, the number of pages need not be accurately determined. Further, despite being single-spaced, the declaration by Hyun Lee, Ph.D., appears to have sufficient clarity and contrast.

submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case such as, for example, the size of the April 6, 2011 Office action, including the number of rejections and incorporation by reference of pages from the requests for *inter partes* reexamination in the '546 and '577 proceedings,<sup>8</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's July 6, 2011 response submission exceeds the regulatory page limit by up to 30 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the April 6, 2011 Office action to exceed the page limit by up to 30 pages. This waiver makes patent owner's July 6, 2011 response submission page-length compliant.

#### IV. Time Period for Submission of the Requesters' Comments

The '546 and '577 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 6, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission.

Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

- 1) is one-and-a-half or double-spaced;<sup>9</sup>
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

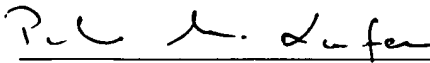
#### CONCLUSION

1. Patent owner's July 6, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 6, 2011 response submission to exceed the page limit by up to 30 pages. This waiver makes patent owner's July 6, 2011 response submission page-length compliant.

<sup>8</sup> See Office action at pages 13-25.

<sup>9</sup> Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

2. The '546 and '577 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 6, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



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Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

9-22-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,577	10/20/2010	7289386	17730-3	7888
25224	7590	01/18/2012	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

Date: *MAILED*

*JAN 18 2012*  
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000577

PATENT NO. : 7289386

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

1571  
JAN 10 2012  
CENTRAL REEXAMINATION  
Commissioner for Patents  
United States Patent and Trademark Office  
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(For Patent Owner)

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(For '546 *Inter Partes* Requester)

ORRICK, HERRINGTON & SUTCLIFFE LLP  
IP PROSECUTION DEPARTMENT  
2050 MAIN STREET, SUITE 1100  
IRVINE, CA 92614

(For '577 *Inter Partes* Requester)

MORRISON & FOERSTER, LLP  
555 WEST FIFTH STREET  
SUITE 3500  
LOS ANGELES, CA 90013-1024

(Courtesy Copy)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,546  
Filed: May 11, 2010  
For: U.S. Patent No. 7,289,386

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:  
: **DECISION**  
: **GRANTING**  
: **PETITION**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,577  
Filed: October 20, 2010  
For: U.S. Patent No. 7,289,386

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This is a decision on the '546 *Inter Partes* requester's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183," filed on October 27, 2011, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission.

The petition is before the Office of Patent Legal Administration.

The petition is granted, for the reasons set forth herein.

**PATENT OWNER'S ADDRESS**

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. Different patent owner addresses are of record for the patent



and reexamination proceedings. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Knobbe Martens Olson & Bear LLP, 2040 Main Street, Fourteenth Floor, Irvine, CA 92614. Accordingly, all future correspondence will be directed to Knobbe Martens Olson & Bear LLP, 2040 Main Street, Fourteenth Floor, Irvine, CA 92614, unless, **within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123.**

## BACKGROUND

1. On October 30, 2007, U.S. Patent No. 7,289,386 (the '386 patent) issued to Bhakta *et al.*
2. On May 11, 2010, a first request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,546 ("the '546 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '546 requester").
3. On August 9, 2010, *inter partes* reexamination was ordered in the '546 proceeding.
4. On August 27, 2010, a non-final Office action was mailed in the '546 proceeding.
5. On October 20, 2010, a second request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,577 ("the '577 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '577 requester").
6. On October 27, 2010, patent owner timely filed, in the '546 proceeding, an amendment and response to the August 27, 2010 Office action.
7. On November 26, 2010, third party request timely filed comments in the '546 proceeding.
8. On January 18, 2011, *inter partes* reexamination was ordered in the '577 proceeding.
9. On March 3, 2011, the Office issued a Decision, *Sua Sponte*, merging the '546 and '577 *inter partes* proceedings ("the merged proceeding").
10. On April 6, 2011, a non-final Office action was issued in the merged proceeding.
11. On July 6, 2011, patent owner filed a petition entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 CFR § 1.943(b)", concurrently with a patent owner response to the April 6, 2011 Office action, including an amendment presenting new claims.<sup>1</sup>
12. On September 26, 2011 the Office issued a decision granting the July 6, 2011 patent owner

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<sup>1</sup> Patent Owner filed a "Request for Extension of time under 37 CFR 1.956" on April 15, 2011, seeking a one month extension of time to respond to the Office action mailed on April 6, 2011. The Office granted the petition for extension of time on April 22, 2011, thereby extending the time period for patent owner's response to the Office action by one month.

petition for suspension of the page limit under 37 CFR 1.943(b). The decision included guidance on the time period for submission of third party requesters' comments.

13. On October 26, 2011, the '577 requester filed a petition entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)" (the '577 requester's petition under 37 CFR 1.183) seeking waiver of the page limit under 37 CFR 1.943(b) for its concurrently-filed comments submission.<sup>2</sup>
14. On October 27, 2011, the '546 requester filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183" (the '546 requester's petition under 37 CFR 1.183) seeking waiver of the page limit under 37 CFR 1.943(b) for its concurrently-filed comments submission.<sup>3</sup>

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. The Petition Under 37 CFR 1.183

The '546 requester's October 27, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

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<sup>2</sup> The '577 requester petition will be addressed in a separate decision by OPLA. It is also noted that the title of the petition is in error, and the body of the petition requests waiver of 37 CFR 1.943(b) (not 37 CFR 1.946(b)).

<sup>3</sup> The '546 requester's petition under 37 CFR 1.183 captioned reexamination proceeding Control Nos. 95/000,546, 95/000,577 and 95/000,579. It is noted that the instant merged *inter partes* reexamination proceeding comprises only the '546 and '577 proceeding. Reexamination proceeding Control No. 95/000,579 is not part of the instant merged proceeding.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response or third party requester comments submission in compliance with the 50-page limit, and submission of a resulting response or comments submission that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the proposed submission. Such a response or comments submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response or comments submission: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response or comments submission.

### III. Findings and Analysis

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In the instant petition under 37 CFR 1.183, the '546 requester requests that the page limit requirement of 37 CFR 1.943(b) be waived for its October 27, 2011 comments submission to permit a submission of 21 pages of comments, 29 pages comprising two claim charts, and a 25-page declaration by Dr. Kozyrakis.<sup>4</sup> In particular, requester asserts that "Petitioner has limited its remarks to 21 pages, separate from the claim charts, in the interest of brevity"<sup>5</sup> and that the pages of claim charts and responsive declaration are "due to the number of new claims submitted by the Patent Owner and the length of the supporting declaration, which are outside Petitioner's control."<sup>6</sup>

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<sup>4</sup> Petition under 37 CFR 1.183 at page 2.

<sup>5</sup> Id.

<sup>6</sup> Id.

In this instance, the '546 requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a comments submission that is in excess of 50 pages. Based on the guidance set forth above, the October 27, 2011 comments submission includes up to 75 pages of arguments. The remarks portion of the October 27, 2011 comments submission includes 21 pages of arguments that count toward the regulatory page limit. The 29 pages of claim charts for the new and amended claims (presented as Exhibits 1 and 2) also count toward the regulatory page limit. The 25-page declaration by Dr. Christoforos Kozyrakis includes legal argument and is being counted toward the regulatory page limit.

Based on requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission which is in excess of 50 pages, and the individual facts and circumstances of this case such as, for example, the addition of 47 new claims in the July 6, 2011 patent owner amendment and response,<sup>7</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '546 requester's October 27, 2011 comments submission exceeds the regulatory page limit by up to 25 pages. Accordingly, the '546 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '546 requester's October 27, 2011 comments submission to exceed the page limit by up to 25 pages. This waiver makes the '546 requester's October 27, 2011 comments submission page-length compliant.

### ADDITIONAL DISCUSSION

The parties to the instant merged proceeding are reminded that, pursuant to Section (III)(C) of the March 3, 2011 merger decision:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, filed in **duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

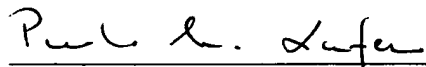
### CONCLUSION

1. The '546 requester's October 27, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '546 requester's October 27, 2011 comments submission to exceed the regulatory page limit by up to 25 pages. This waiver makes the '546 requester's October 27, 2011 comments submission page-length compliant.

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<sup>7</sup> See July 6, 2011 patent owner response "Amendments to the Claims" at pages 2-11, presenting new claims 14-60.

2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



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Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

01-17-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,577	10/20/2010	7289386	17730-3	7888
25224	7590	01/27/2012	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2012

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IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614-2558

Date:

**MAILED**

**JAN 27 2012**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000577  
PATENT NO. : 7289386  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(Courtesy Copy)

MAILED

JAN 27 2012

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,546  
Filed: May 11, 2010  
For: U.S. Patent No. 7,289,386

:  
:  
:  
: **DECISION**  
: **ON**  
: **PETITION**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,577  
Filed: October 20, 2010  
For: U.S. Patent No. 7,289,386

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This is a decision on the '577 *Inter Partes* requester's petition entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)," filed on October 26, 2011.

The petition is before the Office of Patent Legal Administration.

Third party requester's October 26, 2011 petition is dismissed to the extent requested, but is granted-in-part for the reasons set forth below.



Third party requester's October 26, 2011 comments submission is an improper paper and is being expunged for the reasons set forth below.

### BACKGROUND

1. On October 30, 2007, U.S. Patent No. 7,289,386 (the '386 patent) issued to Bhakta *et al.*
2. On May 11, 2010, a first request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,546 ("the '546 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '546 requester").
3. On August 9, 2010, *inter partes* reexamination was ordered in the '546 proceeding.
4. On August 27, 2010, a non-final Office action was mailed in the '546 proceeding.
5. On October 20, 2010, a second request for *inter partes* reexamination of the '386 patent, assigned control No. 95/000,577 ("the '577 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '577 requester" and also referred to herein as "SMART").
6. On October 27, 2010, patent owner timely filed, in the '546 proceeding, an amendment and response to the August 27, 2010 Office action.
7. On November 26, 2010, third party request timely filed comments in the '546 proceeding.
8. On January 18, 2011, *inter partes* reexamination was ordered in the '577 proceeding.
9. On March 3, 2011, the Office issued a Decision, *Sua Sponte*, merging the '546 and '577 *inter partes* proceedings ("the merged proceeding").
10. On April 6, 2011, a non-final Office action was issued in the merged proceeding.
11. On July 6, 2011, patent owner filed a petition entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 CFR § 1.943(b)", concurrently with a patent owner response to the April 6, 2011 Office action, including an amendment presenting new claims.<sup>1</sup>
12. On September 26, 2011 the Office issued a decision granting the July 6, 2011 patent owner petition for suspension of the page limit under 37 CFR 1.943(b). The decision included guidance on the time period for submission of third party requesters' comments.
13. On October 26, 2011, the '577 requester filed the instant petition entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION

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<sup>1</sup> Patent Owner filed a "Request for Extension of time under 37 CFR 1.956" on April 15, 2011, seeking a one month extension of time to respond to the Office action mailed on April 6, 2011. The Office granted the petition for extension of time on April 22, 2011, thereby extending the time period for patent owner's response to the Office action by one month.

PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)” (the ‘577 requester’s petition under 37 CFR 1.183) seeking waiver of the page limit under 37 CFR 1.943(b) for its concurrently-filed comments submission.<sup>2</sup>

14. On October 27, 2011, the ‘546 requester filed a petition entitled “PETITION UNDER 37 C.F.R. § 1.183” (the ‘546 requester’s petition under 37 CFR 1.183) seeking waiver of the page limit under 37 CFR 1.943(b) for its concurrently-filed comments submission, and the Office mailed a decision granting the ‘546 requester’s petition under 37 CFR 1.183 on January 17, 2012.

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. The Petition Under 37 CFR 1.183

The ‘577 requester’s October 26, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

In the instant petition under 37 CFR 1.183, the ‘577 requester asserts that it has attempted to comply with all of the relevant rules and formatting requirements for seeking waiver of the page limit requirement of 37 CFR 1.943(b) when preparing the comments submission but that “[d]espite SMART’s best efforts, the Comments exceeded the page count limit of 50 pages....”<sup>3</sup> The ‘577 requester asserts that the October 26, 2011 submission contains: “(1) a 369-page set of comments comprising a 1-page cover sheet, table of contents, table of exhibits, and 356 pages of

<sup>2</sup> It is noted that the title of the petition is in error, and the body of the petition requests waiver of 37 CFR 1.943(b) (not 37 CFR 1.946(b)).

<sup>3</sup> Petition under 37 CFR 1.183 at page 2.

remarks, (2) a 21-page declaration of Nader Bagherzadeh (the Bagherzadeh Declaration), (3) 238 pages comprising two claim charts demonstrating the invalidity of the 47 newly added claims, (4) 225 pages of additional prior art references, and (5) 938 pages of additional exhibits.”<sup>4</sup> In particular, the ‘577 requester asserts that “SMART’s comments submission exceeds the 50-page limit by up to 327 pages.”<sup>5</sup>

Among other arguments in support of waiver of 37 CFR 1.943(b), the ‘577 requester asserts on page 4 of the petition under 37 CFR 1.183 that:

- The 47 new claims Patent Owner has added are complicated and require substantial comment. In some instances the claims reached over four levels of dependency. Claim 25 for example depends on claim 24, which depends on claim 23, which depends on claim 20, which depends on claim 1.
- SMART has kept its comments to the original 13 claims that were rejected under the 50-page limit, using only 18 pages of remarks and 8 pages of declaration. The remainder of SMART’s comments addresses only the 47 claims Patent Owner added in its response.
- SMART has kept its comments to the original 13 claims of the reexamination to much less than [sic] the regulatory 50-page limit. The comments addressed to the original claims are limited to only 18 pages of remarks and 8 pages of declaration. The remaining pages were directed only to the 47 newly added claims. Further, the newly added claims were very complicated and required substantial comment. In some instances, the claims reached over four levels of dependency. Claim 25, for example, depends on claim 24, which depends on claim 23, which depends on claim 20, which depends on claim 1.

### **III. Findings and Analysis**

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner’s response or third party requester comments submission in compliance with the 50-page limit, and submission of a resulting response or comments submission that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the proposed submission. Such a response or comments submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response or comments submission: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response or comments submission.

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<sup>4</sup> Petition under 37 CFR 1.183 at page 2.

<sup>5</sup> *Id.* A review of the submission indicates that the submission exceeds the regulatory page limit by up to 560 pages, as set forth in Section III (Findings and Analysis).

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Based on the guidance set forth above, the '577 requester's October 26, 2011 comments submission includes up to 610 pages that count toward the regulatory page limit. The remarks portion of the October 26, 2011 comments submission includes 355 pages that count toward the regulatory page limit. Additionally, the 112-page claim chart "EXHIBIT CC-G" and 126-page claim chart "Exhibit CC-F" also count toward the regulatory page limit. Further, up to 17 pages of the Bagherzadeh declaration include legal argument that count toward the regulatory page limit. Thus, the October 26, 2011 comments submission exceeds the regulatory page limit by up to 560 pages.

In this instance, requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a proposed comments submission that is in excess of 50 pages; however, upon review of the submission, requester has not demonstrated that it economized or attempted to minimize duplicative or redundant material in the submission. For instance, Section VI of the comments submission spans over 300 pages of remarks and presents a claim-by-claim analysis of each of the 47 new claims, which remarks are, in some instances, duplicative of remarks presented elsewhere in the claim-by-claim analysis section and in the 238 pages of claim charts.<sup>6</sup> Further, contrary to requester's assertion, fewer pages should be needed to address claims having multiple levels of dependency because requester can make reference to, and need not repeat, discussion of the limitations of the parent claim(s).

Based on the evaluation of the '577 requester's October 26, 2011 comments submission for economizing, extraneous material, and arrangement, without repetition of information already of record, and the individual facts and circumstances of this case, it is not deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to permit the '577 requester's

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<sup>6</sup> As shown by the chart on page 40 of the remarks, the '577 requester has proposed five grounds of rejection under 35 U.S.C. 103, each being applied to various subsets of the 47 new claims. Requester has chosen to discuss each claim with the associated prior art individually. Additionally, there appears to be repetition of the pasted figures in the remarks and claim charts.

October 26, 2011 comments submission to exceed the regulatory page limit by up to 560 pages. The granting of a waiver for 560 additional pages based upon patent owner's inclusion of 47 new claims is not commensurate with the requirements of justice in this situation. Accordingly, the '577 requester's petition under 37 CFR 1.183 is **dismissed**.

The page limit requirement of 37 CFR 1.943(b) is instead waived to the extent that justice requires in this circumstance to permit the '577 requester's comments submission to exceed the page limit requirements by up to 250 pages, for a total of 300 pages.<sup>7</sup>

This waiver does not make the '577 requester's October 26, 2011 comments submission page-length compliant. Therefore, the '577 requester's October 26, 2011 comments submission is an improper paper and it will not be considered. The '577 requester's October 26, 2011 comments submission is being expunged by marking the papers "closed" and "not public" in the Image File Wrapper (IFW) of the merged proceeding. The '577 requester's October 26, 2011 comments submission will not constitute part of the record of the instant merged reexamination proceeding.

#### IV. Guidance for the '577 Third Party Requester

For the reasons given above, the 610 pages of the '577 requester's October 26, 2011 comments submission that count toward the regulatory page limit exceed the regulatory page limit established by 37 CFR 1.943(b) and this decision by 310 pages. However, from the record it is apparent that requester's October 26, 2011 comments submission was a *bona fide* attempt to respond and advance prosecution. Accordingly, requester may, **within 15 days from the date of this notice**, exercise one of the following two options:

1. Submit a re-drafted comments submission that does not exceed the 300-page limit established by this decision; or,
2. File a copy of the October 26, 2011 comments submission with pages redacted to satisfy the 300-page limit established by this decision.

This 15-day period for reply is not extendable.

If no comments submission from requester is received within the allotted time, the reexamination proceeding will be forwarded to the examiner for appropriate action, without written comments from the '577 requester.

The '577 requester is advised that submissions must be of sufficient size, 12 point font, 1.5 line spaced and conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See 37 CFR 1.52.

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<sup>7</sup> Note that waiver in this instance is not to be taken as an indication that the regulatory page limit would be waived to the same extent in similar circumstances in other cases; however, in the interest of special dispatch and in an effort to prevent substantial re-drafting by the '577 requester, permitting a comments submission of up to 300 pages is deemed equitable under the individual facts and circumstances in this case.

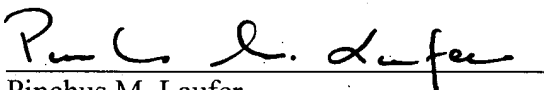
### ADDITIONAL DISCUSSION

The parties to the instant merged proceeding are reminded that, pursuant to Section (III)(C) of the March 3, 2011 merger decision:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, filed in **duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

### CONCLUSION

1. The '577 requester's October 26, 2011 petition under 37 CFR 1.183 is **dismissed to the extent requested.**
2. The '577 requester's request for waiver of the 37 CFR 1.943(b) is **granted-in-part to permit 250 additional pages** to respond to patent owner's July 6, 2011 response submission and the April 6, 2011 Office action. The '577 requester is given a time period of **15 days from the mailing date of this decision** to submit a comments submission in compliance with this decision. This time period is not extendable.
3. The '577 requester's October 26, 2011 comments submission is an improper paper and will not be considered. The comments submission is being expunged by marking the papers "closed" and "not public" in Image File Wrapper (IFW) of the merged proceeding. The October 26, 2011 comments submission will not constitute part of the record of the instant merged reexamination proceeding.
4. A copy of this decision will be made of public record.
5. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

01-26-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,578	10/20/2010	7619912	17730-3	8810
20995	7590	02/28/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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Date:

**MAILED**

**FEB 28 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000578  
PATENT NO. : 7619912  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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(For third *Inter Partes* Requester)

MAILED

FEB 28 2011

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,578  
Filed: October 20, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,579  
Filed: October 21, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 90/001,339  
Filed: June 8, 2010  
For: U.S. Patent No. 7,619,912

DECISION,  
*SUA SPONTE*,  
TO MERGE  
REEXAMINATION  
PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

## REVIEW OF RELEVANT FACTS

1. On November 17, 2009, U.S. Patent No. 7,619,912 (the '912 patent) issued to Bhakta *et al.* with 51 claims.
2. On April 20, 2010, a first request for *inter partes* reexamination of claims 1-51 of the '912 patent, assigned control No. 95/001,339 ("the '1339 proceeding"), was filed by a third party requester. The real party in interest was not identified.
3. On April 27, 2010, the Office issued a notice of failure to comply with *inter partes* reexamination request filing requirements under 37 CFR 1.915(d).
4. On May 7, 2010, a corrected original request for *inter partes* reexamination was filed.
5. On June 4, 2010, the Office issued *sua sponte* a decision vacating the '1339 proceeding due to the third party requester's failure to identify the real party of interest for the request for reexamination.
6. On June 8, 2010, the third party requester responded to the June 4, 2010 Office decision and identified the real party in interest, Inphi, Corp. ("the '1339 requester"). The Office reinstated the '1339 proceeding, according it a filing date of June 8, 2010.
7. On September 1, 2010, *inter partes* reexamination was ordered on claims 1-51 of the '912 patent in the '1339 proceeding. An Action Closing Prosecution (ACP) Office action confirming all the claims was concurrently issued.
8. On October 20, 2010, a second request for *inter partes* reexamination of claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent, assigned control No. 95/000,578 ("the '578 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '578 requester").
9. On October 21, 2010, a third request for *inter partes* reexamination of claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent, assigned control No. 95/000,579 ("the '579 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '579 requester").
10. On January 14, 2011, *inter partes* reexamination was ordered on claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent in the '579 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.
11. On January 18, 2011, *inter partes* reexamination was ordered on claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent in the '578 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

12. To date, no Office action has issued in the '578 or 579 *inter partes* proceedings, and no further Office action has issued in the '1339 *inter partes* proceeding.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination is ordered in the three above-captioned proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/000,578, 95/000,579 and 95/001,339 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

### III. CONDUCT OF MERGED PROCEEDING

#### A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

#### B. *Inter partes* Third Party Requester Participation:

##### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the

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<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

## 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because neither the '578 and '579 *inter partes* third party requester propose any rejections of claims 2, 5, 12-14, 16-17, 23, 26, 30, 35, 40, 46-49 and 51 in their requests for reexamination, neither requester has any appeal rights as to those claims as they appear in the '912 patent.

## C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900  
Central Reexamination Unit

by Hand to: Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

by EFS: Registered users may submit papers via the  
electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For

example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,578 and 95/000,579 and 95/001,339 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

February 25, 2011



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United States Patent and Trademark Office  
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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,578	10/20/2010	7619912	17730-3	8810
20995	7590	07/29/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 07/29/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

ORRICK, HERRINGTON & SUTCLIFFE, LLP

**MAILED**

IP PROSECUTION DEPARTMENT

**JUL 29 2011**

4 PARK PLAZA, SUITE 1600

**CENTRAL REEXAMINATION UNIT**

IRVINE, CA 92614-2558

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000578

PATENT NO. : 7619912

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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JUL 29 2011

CENTRAL REEXAMINATION UNIT

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ALEXANDRIA, VA 22313-1450  
www.uspto.gov

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(For Patent Owner)

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(For '0578 *Inter Partes* Requester)

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(For '0579 *Inter Partes* Requester)

Pillsbury Winthrop Shaw Pittman LLP  
P.O. Box 10500  
McLean, VA 22102

(For '1339 *Inter Partes* Requester)

<i>Inter Partes</i> Reexamination Proceeding	:	
Control No. 95/000,578	:	
Filed: October 20, 2010	:	
For: U.S. Patent No. 7,619,912	:	
<i>Inter Partes</i> Reexamination Proceeding	:	<b>DECISION</b>
Control No. 95/000,579	:	<b>GRANTING</b>
Filed: October 21, 2010	:	<b>PETITION</b>
For: U.S. Patent No. 7,619,912	:	
<i>Inter Partes</i> Reexamination Proceeding	:	
Control No. 95/001,339	:	
Filed: June 8, 2010	:	
For: U.S. Patent No. 7,619,912	:	

This is a decision on the patent owner paper entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.943(b)" (the petition under 37 CFR 1.183), filed on July 5, 2011.

The patent owner petition is before the Office of Patent Legal Administration for consideration.

The patent owner petition under 37 CFR 1.183 is granted for the reasons set forth herein.

## BACKGROUND

1. On November 17, 2009, United States Patent No. 7,619,912 (the '912 patent) issued to Bhakta et al.
2. On April 20, 2010, a first request for *inter partes* reexamination of the '912 patent was deposited by a third party requester (the '1339 requester), which request was assigned Reexamination Control No. 95/001,339 (the '1339 proceeding). The '1339 proceeding was assigned a filing date of June 8, 2010.
3. On September 1, 2010, the Office ordered reexamination of the '912 patent in the '1339 proceeding and concurrently issued an action closing prosecution (ACP), confirming all of the claims of the '912 patent under reexamination.
4. On October 20, 2010, a second request for *inter partes* reexamination of the '912 patent was filed by another third party requester (the '0578 requester), which request was assigned Reexamination Control No. 95/000,578 (the '0578 proceeding).
5. On October 21, 2010, a third request for *inter partes* reexamination of the '912 patent was filed by another third party requester (the '0579 requester), which request was assigned Reexamination Control No. 95/000,579 (the '0579 proceeding).
6. On January 14, 2011, the Office ordered reexamination of the '912 patent in the '0579 proceeding.
7. On January 18, 2011, the Office ordered reexamination of the '912 patent in the '0578 proceeding.
8. On February 28, 2011, the Office issued a decision merging, *sua sponte*, the '0578, '0579 and '1339 proceedings (the merged proceeding).
9. On April 4, 2011, the Office issued a non-final Office action in the merged proceeding.
10. On July 5, 2011, the patent owner timely filed a response submission in the merged proceeding, concurrently with the instant petition under 37 CFR 1.183.<sup>1</sup>

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be

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<sup>1</sup> See April 20, 2011 decision granting a one-month extension of time for patent owner to file a response to the April 4, 2011 Office action.

suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## II. Patent Owner Petition Under 37 CFR 1.183

On July 5, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its July 5, 2011 response submission. Petitioner asserts that "Patentee attempted to comply with all relevant rules when preparing this Response" but "despite Patentee's best efforts, the Response exceeded the page count limit of 37 C.F.R. § 1.943(b)."<sup>2</sup> Petitioner states that "[t]he Response itself contains 48 pages of argument (excluding the 'Amendment to the Claims' and 'Claim Status and Support for New and Amended Claims' sections" and that "the Response also includes three declarations" (two of which include exhibits), such that "[t]aking the full lengths of the arguments of the Response and its three declarations, the 50-page count limit is exceeded by at most 130 pages, while excluding the exhibit pages, the 50-page count limit is exceeded by 48 pages."<sup>3</sup> Thus, petitioner requests waiver of 37 CFR 1.943(b) to "permit Patentee to file its 180 page Response, including exhibits."<sup>4</sup>

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In support of waiver of the rule, petitioner asserts that the "Office Action states 8 bases for rejecting the 51 claims previously pending in the reexamination," "[t]he Office Action, on its face, is 59 pages long, which already exceeds Patentee's 50-page limit for response," and "the

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<sup>2</sup> See Petition at page 2.

<sup>3</sup> *Id.*

<sup>4</sup> *Id.* at pages 2-3.

three Requests from the three merged proceedings included 202 pages, 2,254 pages, and 151 pages, respectively, of arguments (excluding prior art references).<sup>5</sup> Hence, petitioner asserts that “it was impossible for Patentee to fully respond to each of the grounds in the detailed manner required by 37 C.F.R. § 1.111, within the 50 page limit imposed by 37 C.F.R. § 1.943.”<sup>6</sup> Additionally, petitioner has made a showing in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a patent owner’s response in compliance with the 50-page limit, and submitting the resulting response that is in excess of 50 pages.

### III. Findings and Analysis

37 CFR 1.943(b) expressly excludes from the regulatory page count “amendments, appendices of claims, and reference materials such as prior art references.” However, 37 CFR 1.943(b) does not expressly exclude from the regulatory page count an “explanation of the support in the disclosure of the patent for changes to the claims made by [an] amendment paper” pursuant to 37 CFR 1.530(e).

Further, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited** to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Patent owner’s July 5, 2011 response submission includes: (1) an 81-page response comprising a 1-page cover sheet, 19 pages of claim amendments, 13 pages of explanation of support for the claim amendments, and 48 pages of remarks, (2) a 37-page declaration of Carl Sechen (the Sechen declaration), (3) an 8-page declaration of Hyun Lee (the Lee declaration) with accompanying exhibits of reference materials, and (4) an 8-page declaration of Christopher Lopes (the Lopes declaration) with accompanying exhibits of reference materials. In this instance, the explanation of support for claim amendments, remarks, and the Sechen declaration are included in the regulatory page count such that patent owner’s July 5, 2011 response

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<sup>5</sup> See *id.*

<sup>6</sup> *Id.*

submission is deemed to exceed the 50-page limit by up to 48 pages.<sup>7</sup> Unlike the Sechen declaration, portions of which are deemed to include legal argument, the Lee declaration and the Lopes declaration are limited to providing factual evidence, hence they are *not* subject to the 50-page length requirement.

Based on the individual facts and circumstances of this case such as, for example, the nature of the April 4, 2011 Office action in adopting ten grounds of rejection of fifty claims, based on a synthesis of the three requests for *inter partes* reexamination.<sup>8</sup> Additionally, it is recognized that the *inter partes* reexamination statute provides for proposed patent owner amendments and new claims and that, to comply with the rules, patent owner must provide an explanation of the support for any such proposed amendments and new claims. See 35 U.S.C. 314(a) and 37 CFR 1.530(e). Therefore, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the portions of patent owner's response submission that are included in the regulatory page count not exceed 98 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 5, 2011 response submission to exceed the regulatory page limit by 48 pages. **This waiver makes patent owner's July 5, 2011 response submission page-length compliant.**

#### IV. Time Period for Submission of Third Party Requesters' Comments

The '0578, '0579 and '1339 *inter partes* requesters have **30 days from the mailing date of this decision**, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 5, 2011 response submission page-length compliant, **to file a comments paper pursuant to 37 CFR 1.947**. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

- 1) is one-and-a-half or double-spaced;<sup>9</sup>
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

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<sup>7</sup> It is noted that the pages of the July 5, 2011 response submission that are being counted toward the 50-page limit appear to comply with the formatting guidelines for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) (i.e., one-and-a-half or double-spaced; in a non-script type font (e.g., Arial, Times New Roman, or Courier); has a font size no smaller than 12-point; conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition).

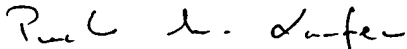
<sup>8</sup> See April 4, 2011 Office action at pages 3-5.

<sup>9</sup> Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

*See, generally,* 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

### CONCLUSION

1. Patent owner's July 5, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 48 pages. This waiver makes patent owner's July 5, 2011 response submission page-length compliant.
2. The '0578, '0579 and '1339 *inter partes* requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 5, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



---

Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

07-29-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,578	10/20/2010	7619912	17730-3	8810
20995	7590	11/18/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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IP PROSECUTION DEPARTMENT  
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IRVINE, CA 92614-2558

Date:

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**NOV 18 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000578  
PATENT NO. : 7619912  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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(For Patent Owner)

**MAILED**

**NOV 18 2011**

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McLean, VA 22102

(For '1339 *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,578  
Filed: October 20, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,579  
Filed: October 21, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,339  
Filed: June 8, 2010  
For: U.S. Patent No. 7,619,912

**DECISION  
GRANTING  
PETITIONS**

This is a decision on the following petitions under 37 CFR 1.183, filed on August 29, 2011 in the 95/000,578, 95/000,579, and 95/001,339 merged *inter partes* reexamination proceeding (the merged proceeding):

1. The petition paper entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)," filed by the third party requester of the 95/000,578 proceeding (the '578 requester);

2. The petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183," filed by the third party requester of the 95/000,579 proceeding (the '579 requester); and
3. The petition paper entitled "PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. §§ 1.182 and 1.183," filed by the third party requester of the 95/001,339 proceeding (the '1339 requester).

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration for consideration.

On April 4, 2011, the Office mailed a non-final Office action in the merged proceeding, and on July 5, 2011, patent owner filed a response to the April 4, 2011 Office action, concurrently with a petition under 37 CFR 1.183 for waiver of the 37 CFR 1.943(b) page limit.<sup>1</sup> On July 29, 2011, the Office mailed a decision granting patent owner's July 5, 2011 petition under 37 CFR 1.183, and entering patent owner's July 5, 2011 response submission as page-length compliant. On August 29, 2011, the third party requesters in the merged proceeding filed their respective petitions under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit, concurrently with their respective third party requester comments submissions after the April 4, 2011 non-final Office action and the July 5, 2011 patent owner response submission.

On October 4, 2011, the Office mailed a second non-final Office action in the merged proceeding. On October 14, 2011, the Office mailed another non-final Office action in the merged proceeding, superseding the October 4, 2011 Office action and addressing the patent owner's July 5, 2011 response submission and the three third party requester August 29, 2011 comments submissions.<sup>2</sup>

In view of the examiner's consideration, in the October 14, 2011 Office action, of the three third party requester August 29, 2011 comments submissions, the instant petitions under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit with respect to the August 29, 2011 comments submissions, are granted *nunc pro tunc*. The granting of the petitions under 37 CFR 1.183 in this instance is not an indication that any future such petitions would be so granted without a sufficient showing under 37 CFR 1.183 for waiver of the regulatory page limit.

Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

11-17-2011

<sup>1</sup> On April 20, 2011, the Office granted a one-month extension of time for filing patent owner's response to the April 4, 2011 Office action.

<sup>2</sup> See October 14, 2011 Office action at page 2 and FN 1.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,578	10/20/2010	7619912	17730-3	8810
25224	7590	01/24/2012	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
ORRICK, HERRINGTON & SUTCLIFFE, LLP  
IP PROSECUTION DEPARTMENT  
2050 MAIN STREET, SUITE 1100  
IRVINE, CA 92614-2558

Date:

**MAILED**

**JAN 24 2012**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000578  
PATENT NO. : 7619912  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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JAN 24 2012

MORRISON & FOERSTER, LLP  
555 WEST FIFTH STREET  
SUITE 3500  
LOS ANGELES, CA 90013-1024

(For Patent Owner) CENTRAL REEXAMINATION UNIT

Orrick, Herrington & Sutcliffe, LLP  
IP Prosecution Department  
2050 Main Street, Suite 1100  
Irvine, CA 92614

(For '0578 *Inter Partes* Requester)

Fish & Richardson P.C.  
PO Box 1022  
Minneapolis, MN 55440-1022

(For '0579 *Inter Partes* Requester)

Pillsbury Winthrop Shaw Pittman LLP (SV)  
PO Box 10500  
McLean, VA 22102

(For '1339 *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,578  
Filed: October 20, 2010  
For: U.S. Patent No. 7,619,912

DECISION ON PETITIONS

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,579  
Filed: October 21, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,339  
Filed: June 8, 2010  
For: U.S. Patent No. 7,619,912

This is a decision on the Patent Owner petition filed on February 07, 2011, as well as the Third Party opposition petition filed March 02, 2011. Patent Owner requests under 37 C.F.R. 1.181 to

vacate *ultra vires* the assignment of a filing date and the grant of request for re-examination. Third Party Requester's opposition opposes the request for relief and requests entry of a new IDS for fixing a typographical error.

The petitions are considered pursuant to 37 CFR 1.181; No fee is required.

Patent Owner's petition is denied and Third Party Requester's petition is moot.

### REVIEW OF RELEVANT FACTS

1. Reexamination Request 95/000,578 was granted a filing date of October 20, 2010.
2. Reexamination of U.S. Patent No. 7,619,912 was ordered in the Order mailed January 18, 2011.
3. The Order determined that a substantial new question (SNQ) of patentability existed for multiple references cited by the Requester, including U.S. Pat 6,414,868 to Wong (Wong '868). However, the IDS which was signed by the examiner did not include Wong '868.
4. On February 7, 2011, the current Patent Owner's petition was filed.
5. On March 02, 2011, the current Third Party Requester's opposition petition was filed, which included an updated IDS listing the Wong '868 Patent.
6. On January 12, 2012, the examiner considered and initialed the Information Disclosure Statement (IDS) submitted by Third Party Requester.

### DECISION

#### **37 CFR §1.919 states**

*Filing date of request for inter partes reexamination.*

(a)

*The filing date of a request for inter partes reexamination is the date on which the request satisfies the fee requirement of § 1.915(a).*

#### **37 C.F.R. §1.915 states**

*Content of request for inter partes reexamination.*

(b)

*A request for inter partes reexamination must include the following parts:*

(2)

*A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.*

In view of the relevant facts above, the Request was properly accorded a filing date as it satisfies the requirements of 37 C.F.R. 1.915. The Request filed October 20, 2010 correctly identifies Wong '868 on Page 29. The incorrect citations to Wong in the Table of Exhibits at page xvii and in form PTO/SB/08A were mere typographical errors. Further evidence is provided in the Order mailed January 18, 2011, in which the examiner correctly cited Wong '868 on Page 2.

With regard to the Third Party Requester's opposition petition, the corrected IDS has been considered and initialed by the examiner as of January 12, 2012.

Accordingly, Patent Owner's petition to vacate *ultra vires* the assignment of a filing date and the grant of request for re-examination is denied as the filing date assignment and grant of the Request were proper. Third Party Requester's opposition petition is therefore moot in view of Patent Owner's petition being denied and in view of examiner's consideration of the corrected IDS.

### CONCLUSION

1. Patent Owner's petition is **DENIED**. Third Party Requester's petition is **MOOT**.
2. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at  
<https://efs.uspto.gov/efile/myportal/efs-registered>

By Mail to: Mail Stop *Inter Partes* Reexam  
Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

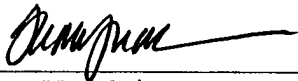
By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for

reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Alexander Kosowski, at (571) 272-3744, Mark Reinhart, at (571) 272-1611 or Sudhanshu Pathak at (571) 272-5509.

This decision is final and nonappealable. See 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.



---

İrem Yücel  
Director, Central Reexamination Unit





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United States Patent and Trademark Office  
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Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,579	10/21/2010	7619912	19473-0099RX1	3547
20995	7590	02/28/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

FISH & RICHARDSON P.C.

**MAILED**

P.O. BOX 1022

**FEB 23 2011**

MINNEAPOLIS, MN 55440-1022

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000579

PATENT NO. : 7619912

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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ALEXANDRIA, VA 22313-1450  
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KNOBBE MARTENS OLSON & BEAR LLP  
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(For Patent Owner)

PILLSBURY WINTHROP SHAW PITTMAN, LLP  
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MCLEAN, VA 22102

(For first *Inter Partes* Requester)

FISH & RICHARDSON P.C.  
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MINNEAPOLIS, MN 55440

(For second *Inter Partes* Requester)

ORRICK, HERRINGTON & SUTCLIFFE LLP  
IP PROSECUTION DEPARTMENT  
4 PARK PLAZA, SUITE 1600  
IRVINE, CA 92614

(For third *Inter Partes* Requester)

MAILED

FEB 23 2011

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,578  
Filed: October 20, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,579  
Filed: October 21, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 90/001,339  
Filed: June 8, 2010  
For: U.S. Patent No. 7,619,912

DECISION,  
*SUA SPONTE*,  
TO MERGE  
REEXAMINATION  
PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

## REVIEW OF RELEVANT FACTS

1. On November 17, 2009, U.S. Patent No. 7,619,912 (the '912 patent) issued to Bhakta *et al.* with 51 claims.
2. On April 20, 2010, a first request for *inter partes* reexamination of claims 1-51 of the '912 patent, assigned control No. 95/001,339 ("the '1339 proceeding"), was filed by a third party requester. The real party in interest was not identified.
3. On April 27, 2010, the Office issued a notice of failure to comply with inter partes reexamination request filing requirements under 37 CFR 1.915(d).
4. On May 7, 2010, a corrected original request for *inter partes* reexamination was filed.
5. On June 4, 2010, the Office issued *sua sponte* a decision vacating the '1339 proceeding due to the third party requester's failure to identify the real party of interest for the request for reexamination.
6. On June 8, 2010, the third party requester responded to the June 4, 2010 Office decision and identified the real party in interest, Inphi, Corp. ("the '1339 requester"). The Office reinstated the '1339 proceeding, according it a filing date of June 8, 2010.
7. On September 1, 2010, *inter partes* reexamination was ordered on claims 1-51 of the '912 patent in the '1339 proceeding. An Action Closing Prosecution (ACP) Office action confirming all the claims was concurrently issued.
8. On October 20, 2010, a second request for *inter partes* reexamination of claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent, assigned control No. 95/000,578 ("the '578 proceeding"), was filed by a third party requester on behalf of real party in interest SMART Modular Technologies (WWH), Inc. ("the '578 requester").
9. On October 21, 2010, a third request for *inter partes* reexamination of claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent, assigned control No. 95/000,579 ("the '579 proceeding"), was filed by a third party requester on behalf of real party in interest Google, Inc. ("the '579 requester").
10. On January 14, 2011, *inter partes* reexamination was ordered on claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent in the '579 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.
11. On January 18, 2011, *inter partes* reexamination was ordered on claims 1, 3-4, 6-11, 15, 18-22, 24-25, 27-29, 31-34, 36-39, 41-45 and 50 of the '912 patent in the '578 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

12. To date, no Office action has issued in the '578 or 579 *inter partes* proceedings, and no further Office action has issued in the '1339 *inter partes* proceeding.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination is ordered in the three above-captioned proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/000,578, 95/000,579 and 95/001,339 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

### III. CONDUCT OF MERGED PROCEEDING

#### A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

#### B. *Inter partes* Third Party Requester Participation:

##### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the

---

<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

## 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because neither the '578 and '579 *inter partes* third party requester propose any rejections of claims 2, 5, 12-14, 16-17, 23, 26, 30, 35, 40, 46-49 and 51 in their requests for reexamination, neither requester has any appeal rights as to those claims as they appear in the '912 patent.

## C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

- by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450
- by FAX to: (571) 273-9900  
Central Reexamination Unit
- by Hand to: Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314
- by EFS: Registered users may submit papers via the  
electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For

example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,578 and 95/000,579 and 95/001,339 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

February 25, 2011





# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,579	10/21/2010	7619912	19473-0099RX1	3547
20995	7590	07/29/2011		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
			EXAMINER	
			ART UNIT	PAPER NUMBER

DATE MAILED: 07/29/2011

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Date:

FISH & RICHARDSON P.C.

**MAILED**

P.O. BOX 1022

**JUL 29 2011**

MINNEAPOLIS, MN 55440-1022

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000579

PATENT NO. : 7619912

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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JUL 29 2011

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Minneapolis, MN 55440-1022

(For '0579 *Inter Partes* Requester)

Pillsbury Winthrop Shaw Pittman LLP  
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McLean, VA 22102

(For '1339 *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding :  
Control No. 95/000,578 :  
Filed: October 20, 2010 :  
For: U.S. Patent No. 7,619,912 :  
*Inter Partes* Reexamination Proceeding :  
Control No. 95/000,579 :  
Filed: October 21, 2010 :  
For: U.S. Patent No. 7,619,912 :  
*Inter Partes* Reexamination Proceeding :  
Control No. 95/001,339 :  
Filed: June 8, 2010 :  
For: U.S. Patent No. 7,619,912 :

**DECISION**  
**GRANTING**  
**PETITION**

This is a decision on the patent owner paper entitled "PATENTEE'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.943(b)" (the petition under 37 CFR 1.183), filed on July 5, 2011.

The patent owner petition is before the Office of Patent Legal Administration for consideration.

The patent owner petition under 37 CFR 1.183 is granted for the reasons set forth herein.

## BACKGROUND

1. On November 17, 2009, United States Patent No. 7,619,912 (the '912 patent) issued to Bhakta et al.
2. On April 20, 2010, a first request for *inter partes* reexamination of the '912 patent was deposited by a third party requester (the '1339 requester), which request was assigned Reexamination Control No. 95/001,339 (the '1339 proceeding). The '1339 proceeding was assigned a filing date of June 8, 2010.
3. On September 1, 2010, the Office ordered reexamination of the '912 patent in the '1339 proceeding and concurrently issued an action closing prosecution (ACP), confirming all of the claims of the '912 patent under reexamination.
4. On October 20, 2010, a second request for *inter partes* reexamination of the '912 patent was filed by another third party requester (the '0578 requester), which request was assigned Reexamination Control No. 95/000,578 (the '0578 proceeding).
5. On October 21, 2010, a third request for *inter partes* reexamination of the '912 patent was filed by another third party requester (the '0579 requester), which request was assigned Reexamination Control No. 95/000,579 (the '0579 proceeding).
6. On January 14, 2011, the Office ordered reexamination of the '912 patent in the '0579 proceeding.
7. On January 18, 2011, the Office ordered reexamination of the '912 patent in the '0578 proceeding.
8. On February 28, 2011, the Office issued a decision merging, *sua sponte*, the '0578, '0579 and '1339 proceedings (the merged proceeding).
9. On April 4, 2011, the Office issued a non-final Office action in the merged proceeding.
10. On July 5, 2011, the patent owner timely filed a response submission in the merged proceeding, concurrently with the instant petition under 37 CFR 1.183.<sup>1</sup>

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be

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<sup>1</sup> See April 20, 2011 decision granting a one-month extension of time for patent owner to file a response to the April 4, 2011 Office action.

suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## II. Patent Owner Petition Under 37 CFR 1.183

On July 5, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its July 5, 2011 response submission. Petitioner asserts that "Patentee attempted to comply with all relevant rules when preparing this Response" but "despite Patentee's best efforts, the Response exceeded the page count limit of 37 C.F.R. § 1.943(b)."<sup>2</sup> Petitioner states that "[t]he Response itself contains 48 pages of argument (excluding the 'Amendment to the Claims' and 'Claim Status and Support for New and Amended Claims' sections" and that "the Response also includes three declarations" (two of which include exhibits), such that "[t]aking the full lengths of the arguments of the Response and its three declarations, the 50-page count limit is exceeded by at most 130 pages, while excluding the exhibit pages, the 50-page count limit is exceeded by 48 pages."<sup>3</sup> Thus, petitioner requests waiver of 37 CFR 1.943(b) to "permit Patentee to file its 180 page Response, including exhibits."<sup>4</sup>

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In support of waiver of the rule, petitioner asserts that the "Office Action states 8 bases for rejecting the 51 claims previously pending in the reexamination," "[t]he Office Action, on its face, is 59 pages long, which already exceeds Patentee's 50-page limit for response," and "the

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<sup>2</sup> See Petition at page 2.

<sup>3</sup> *Id.*

<sup>4</sup> *Id.* at pages 2-3.

three Requests from the three merged proceedings included 202 pages, 2,254 pages, and 151 pages, respectively, of arguments (excluding prior art references).<sup>5</sup> Hence, petitioner asserts that “it was impossible for Patentee to fully respond to each of the grounds in the detailed manner required by 37 C.F.R. § 1.111, within the 50 page limit imposed by 37 C.F.R. § 1.943.”<sup>6</sup> Additionally, petitioner has made a showing in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a patent owner’s response in compliance with the 50-page limit, and submitting the resulting response that is in excess of 50 pages.

### III. Findings and Analysis

37 CFR 1.943(b) expressly excludes from the regulatory page count “amendments, appendices of claims, and reference materials such as prior art references.” However, 37 CFR 1.943(b) does not expressly exclude from the regulatory page count an “explanation of the support in the disclosure of the patent for changes to the claims made by [an] amendment paper” pursuant to 37 CFR 1.530(e).

Further, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited** to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Patent owner’s July 5, 2011 response submission includes: (1) an 81-page response comprising a 1-page cover sheet, 19 pages of claim amendments, 13 pages of explanation of support for the claim amendments, and 48 pages of remarks, (2) a 37-page declaration of Carl Sechen (the Sechen declaration), (3) an 8-page declaration of Hyun Lee (the Lee declaration) with accompanying exhibits of reference materials, and (4) an 8-page declaration of Christopher Lopes (the Lopes declaration) with accompanying exhibits of reference materials. In this instance, the explanation of support for claim amendments, remarks, and the Sechen declaration are included in the regulatory page count such that patent owner’s July 5, 2011 response

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<sup>5</sup> See *id.*

<sup>6</sup> *Id.*

submission is deemed to exceed the 50-page limit by up to 48 pages.<sup>7</sup> Unlike the Sechen declaration, portions of which are deemed to include legal argument, the Lee declaration and the Lopes declaration are limited to providing factual evidence, hence they are *not* subject to the 50-page length requirement.

Based on the individual facts and circumstances of this case such as, for example, the nature of the April 4, 2011 Office action in adopting ten grounds of rejection of fifty claims, based on a synthesis of the three requests for *inter partes* reexamination.<sup>8</sup> Additionally, it is recognized that the *inter partes* reexamination statute provides for proposed patent owner amendments and new claims and that, to comply with the rules, patent owner must provide an explanation of the support for any such proposed amendments and new claims. See 35 U.S.C. 314(a) and 37 CFR 1.530(e). Therefore, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the portions of patent owner's response submission that are included in the regulatory page count not exceed 98 pages.

Accordingly, patent owner's petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 5, 2011 response submission to exceed the regulatory page limit by 48 pages. **This waiver makes patent owner's July 5, 2011 response submission page-length compliant.**

#### **IV. Time Period for Submission of Third Party Requesters' Comments**

The '0578, '0579 and '1339 *inter partes* requesters have **30 days from the mailing date of this decision**, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 5, 2011 response submission page-length compliant, **to file a comments paper pursuant to 37 CFR 1.947**. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

- 1) is one-and-a-half or double-spaced;<sup>9</sup>
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

<sup>7</sup> It is noted that the pages of the July 5, 2011 response submission that are being counted toward the 50-page limit appear to comply with the formatting guidelines for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) (i.e., one-and-a-half or double-spaced; in a non-script type font (e.g., Arial, Times New Roman, or Courier); has a font size no smaller than 12-point; conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition).

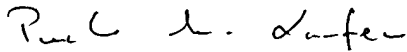
<sup>8</sup> See April 4, 2011 Office action at pages 3-5.

<sup>9</sup> Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

*See, generally,* 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

### CONCLUSION

1. Patent owner's July 5, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 48 pages. This waiver makes patent owner's July 5, 2011 response submission page-length compliant.
2. The '0578, '0579 and '1339 *inter partes* requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 5, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



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Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

07-29-2011





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,579	10/21/2010	7619912	19473-0099RX1	3547
20995	7590	11/18/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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Date:

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**NOV 18 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000579  
PATENT NO. : 7619912  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Knobbe Martens Olson & Bear LLP  
2040 Main Street, Fourteenth Floor  
Irvine, CA 92614

(For Patent Owner)

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NOV 18 2011

CENTRAL REEXAMINATION UNIT

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(For '0578 *Inter Partes* Requester)

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Minneapolis, MN 55440-1022

(For '0579 *Inter Partes* Requester)

Pillsbury Winthrop Shaw Pittman LLP (SV)  
P.O. Box 10500  
McLean, VA 22102

(For '1339 *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,578  
Filed: October 20, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,579  
Filed: October 21, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,339  
Filed: June 8, 2010  
For: U.S. Patent No. 7,619,912

DECISION  
GRANTING  
PETITIONS

This is a decision on the following petitions under 37 CFR 1.183, filed on August 29, 2011 in the 95/000,578, 95/000,579, and 95/001,339 merged *inter partes* reexamination proceeding (the merged proceeding):

1. The petition paper entitled "THIRD PARTY REQUESTOR SMART MODULAR TECHNOLOGIES (WWH) INC.'S PETITION PURSUANT TO 37 C.F.R. § 1.183 TO SUSPEND OR WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.946(B)," filed by the third party requester of the 95/000,578 proceeding (the '578 requester);

2. The petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183," filed by the third party requester of the 95/000,579 proceeding (the '579 requester); and
3. The petition paper entitled "PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. §§ 1.182 and 1.183," filed by the third party requester of the 95/001,339 proceeding (the '1339 requester).

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration for consideration.

On April 4, 2011, the Office mailed a non-final Office action in the merged proceeding, and on July 5, 2011, patent owner filed a response to the April 4, 2011 Office action, concurrently with a petition under 37 CFR 1.183 for waiver of the 37 CFR 1.943(b) page limit.<sup>1</sup> On July 29, 2011, the Office mailed a decision granting patent owner's July 5, 2011 petition under 37 CFR 1.183, and entering patent owner's July 5, 2011 response submission as page-length compliant. On August 29, 2011, the third party requesters in the merged proceeding filed their respective petitions under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit, concurrently with their respective third party requester comments submissions after the April 4, 2011 non-final Office action and the July 5, 2011 patent owner response submission.

On October 4, 2011, the Office mailed a second non-final Office action in the merged proceeding. On October 14, 2011, the Office mailed another non-final Office action in the merged proceeding, superseding the October 4, 2011 Office action and addressing the patent owner's July 5, 2011 response submission and the three third party requester August 29, 2011 comments submissions.<sup>2</sup>

In view of the examiner's consideration, in the October 14, 2011 Office action, of the three third party requester August 29, 2011 comments submissions, the instant petitions under 37 CFR 1.183, requesting waiver of the 37 CFR 1.943(b) page limit with respect to the August 29, 2011 comments submissions, are granted *nunc pro tunc*. The granting of the petitions under 37 CFR 1.183 in this instance is not an indication that any future such petitions would be so granted without a sufficient showing under 37 CFR 1.183 for waiver of the regulatory page limit.

Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

11-17-2011

<sup>1</sup> On April 20, 2011, the Office granted a one-month extension of time for filing patent owner's response to the April 4, 2011 Office action.

<sup>2</sup> See October 14, 2011 Office action at page 2 and FN 1.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,579	10/21/2010	7619912	19473-0099RX1	3547
25224	7590	01/24/2012	EXAMINER	
MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			ART UNIT	PAPER NUMBER

DATE MAILED: 01/24/2012

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**JAN 24 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000579  
PATENT NO. : 7619912  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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JAN 24 2012

MORRISON & FOERSTER, LLP  
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LOS ANGELES, CA 90013-1024

(For Patent Owner) CENTRAL REEXAMINATION UNIT

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Minneapolis, MN 55440-1022

(For '0579 *Inter Partes* Requester)

Pillsbury Winthrop Shaw Pittman LLP (SV)  
PO Box 10500  
McLean, VA 22102

(For '1339 *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,578  
Filed: October 20, 2010  
For: U.S. Patent No. 7,619,912

DECISION ON PETITIONS

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,579  
Filed: October 21, 2010  
For: U.S. Patent No. 7,619,912

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,339  
Filed: June 8, 2010  
For: U.S. Patent No. 7,619,912

This is a decision on the Patent Owner petition filed on February 07, 2011, as well as the Third Party opposition petition filed March 02, 2011. Patent Owner requests under 37 C.F.R. 1.181 to

vacate *ultra vires* the assignment of a filing date and the grant of request for re-examination. Third Party Requester's opposition opposes the request for relief and requests entry of a new IDS for fixing a typographical error.

The petitions are considered pursuant to 37 CFR 1.181; No fee is required.

Patent Owner's petition is denied and Third Party Requester's petition is moot.

### REVIEW OF RELEVANT FACTS

1. Reexamination Request 95/000,578 was granted a filing date of October 20, 2010.
2. Reexamination of U.S. Patent No. 7,619,912 was ordered in the Order mailed January 18, 2011.
3. The Order determined that a substantial new question (SNQ) of patentability existed for multiple references cited by the Requester, including U.S. Pat 6,414,868 to Wong (Wong '868). However, the IDS which was signed by the examiner did not include Wong '868.
4. On February 7, 2011, the current Patent Owner's petition was filed.
5. On March 02, 2011, the current Third Party Requester's opposition petition was filed, which included an updated IDS listing the Wong '868 Patent.
6. On January 12, 2012, the examiner considered and initialed the Information Disclosure Statement (IDS) submitted by Third Party Requester.

### DECISION

#### **37 CFR §1.919 states**

*Filing date of request for inter partes reexamination.*

(a)

*The filing date of a request for inter partes reexamination is the date on which the request satisfies the fee requirement of § 1.915(a).*

#### **37 C.F.R. §1.915 states**

*Content of request for inter partes reexamination.*

(b)

*A request for inter partes reexamination must include the following parts:*

(2)

*A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.*



In view of the relevant facts above, the Request was properly accorded a filing date as it satisfies the requirements of 37 C.F.R. 1.915. The Request filed October 20, 2010 correctly identifies Wong '868 on Page 29. The incorrect citations to Wong in the Table of Exhibits at page xvii and in form PTO/SB/08A were mere typographical errors. Further evidence is provided in the Order mailed January 18, 2011, in which the examiner correctly cited Wong '868 on Page 2.

With regard to the Third Party Requester's opposition petition, the corrected IDS has been considered and initialed by the examiner as of January 12, 2012.

Accordingly, Patent Owner's petition to vacate *ultra vires* the assignment of a filing date and the grant of request for re-examination is denied as the filing date assignment and grant of the Request were proper. Third Party Requester's opposition petition is therefore moot in view of Patent Owner's petition being denied and in view of examiner's consideration of the corrected IDS.

### CONCLUSION

1. Patent Owner's petition is **DENIED**. Third Party Requester's petition is **MOOT**.
2. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://efs.uspto.gov/efile/myportal/efs-registered>

By Mail to: Mail Stop *Inter Partes* Reexam  
Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

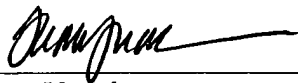
By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for

reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Alexander Kosowski, at (571) 272-3744, Mark Reinhart, at (571) 272-1611 or Sudhanshu Pathak at (571) 272-5509.

This decision is final and nonappealable. See 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.



Irem Yucel  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,580	10/22/2010	6921985	341710US20RX	4289
8791	7590	01/18/2011	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
			ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

Date:

MAILED

JAN 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000580

PATENT NO. : 6921985

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension  
of Time in Reexamination**

Control No.: 95/000,580

1. THIS IS A DECISION ON THE PETITION FILED 13 January 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 21 December 2010 which sets a one (1) month period for filing a response thereto, be extended by and additional one (1) month.

- A. ☒ Petition fee per 37 CFR §1.17(g)):
- i. ☐ Petition includes authorization to debit a deposit account.
  - ii. ☐ Petition includes authorization to charge a credit card account.
  - iii. ☐ Other: electronic payment via EFS.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for an additional one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).  
☒ Other/comment: MPEP § 2265 notes "requests for more than one month will be granted only in extraordinary situations."
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
  - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
  - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
  - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
  - v. ☐ The petition is moot.
  - vi. ☐ Other/comment: \_\_\_\_\_

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

\_\_\_\_\_/Mark Reinhart/  
[Signature]

\_\_\_\_\_  
(Title) SPE AU 3992\_\_



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,580	10/22/2010	6921985	1299600.00188US1	4289
23483	7590	08/08/2011	EXAMINER	
WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109			ART UNIT	PAPER NUMBER

DATE MAILED: 08/08/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.

1940 DUKE STREET

ALEXANDRIA, VA 22314

Date:

MAILED  
AUG 08 2011  
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000580

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WILMERHALE/BOSTON  
60 STATE STREET  
BOSTON MA 02109

(For Patent Owner)

MAILED

AUG 8 2011

OBLON, SPIVAK, MCCLELLAND,  
MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,580  
Filed: October 22, 2010  
For: U.S. Patent No. 6,921,985

: **DECISION GRANTING**  
: **PETITIONS AND**  
: **WAIVING PAGE LIMIT**  
:

This is a decision on patent owner's petition papers entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. 1.183 AND 1.943(b)," filed February 28, 2011 and "SUPPLEMENTAL PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. 1.183 AND 1.943(b)," filed March 21, 2011 and third party requester's petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF RULE 37 CFR § 1.943(b)," filed on April 20, 2011.

The patent owner and third party requester petitions are before the Office of Patent Legal Administration.

Both the patent owner petition and the third party requester petitions are granted, for the reasons set forth herein.

**BACKGROUND**

1. On July 26, 2005, United States Patent No. 6,921,985 (the '985 patent) issued to Jenssen *et al.*
2. On October 22, 2010, a request for *inter partes* reexamination of the '985 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/000,580 (the '580 proceeding).



3. On December 21, 2010, *inter partes* reexamination was ordered in the '580 proceeding. Concurrently on December 21, 2010, a non-final Office action was mailed in the '580 proceeding.
4. On February 28, 2011, patent owner filed a petition paper entitled "PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. 1.183 AND 1.943(b)."
5. On March 21, 2011, patent owner timely a response to the December 21, 2010 Office action.<sup>1</sup> Concurrently, patent owner filed a supplemental petition entitled, "SUPPLEMENTAL PETITION FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. 1.183 AND 1.943(b)," (patent owner petition under 37 CFR 1.183). The instant decision addresses patent owner's petition under 37 CFR 1.183 as supplemented.
6. On April 20, 2011, requester timely filed comments to the March 21, 2011 patent owner response and to the December 21, 2010 Office action. Concurrently, third party requester filed a petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF RULE 37 CFR § 1.943(b)," (requester petition under 37 CFR 1.183). The instant decision also addresses third party requester's petition under 37 CFR 1.183.

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition

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<sup>1</sup> Patent owner was granted a one month extension of time to file a response.

of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### **III. Patent Owner Petition Under 37 CFR 1.183**

Patent owner's February 28, 2011 petition under 37 CFR 1.183, as supplemented on March 21, 2011, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for patent owner's response to the December 21, 2010 Office action, has been fully considered.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner's March 21, 2011 to increase the page limit for patent owner's response to 75 pages. In particular, patent owner states that increasing the March 21, 2011 response "to 75 pages is necessary to address the Office action and the numerous and complex issues raised in the Office action."<sup>2</sup> Patent owner also states "[p]atent [o]wner is

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<sup>2</sup> Patent owner supplemental petition at page 2.

mindful of the need for brevity and conciseness in the response to the Office Action”<sup>3</sup> Further patent owner asserts the declarations that accompany patent owner’s response are factual.<sup>4</sup> Patent owner does NOT request waiver of the 50-page limit for the combination of the response and any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b).

In support of waiver of 37 CFR 1.943(b), patent owner states that “[T]he Office Action presents 33 different rejections,”<sup>5</sup> “31 of the outstanding grounds of rejection are for alleged obviousness”<sup>6</sup> and “approximately 230 pages from the [r]equest for [r]eexamination are incorporated by reference, including the content of the expert declaration provided by the [t]hird [p]arty requester.”<sup>7</sup> Patent owner also notes the Office action itself consist of 28 pages.<sup>8</sup> Patent owner asserts that the present facts present an extraordinary situation in which justice requires waiver of the page limit “given the numerous complex legal issues embodied in the outstanding Office Action.”<sup>9</sup> Patent owner asserts that “Principles of basic fairness and due process would warrant that [p]atent [o]wner be given an equal number of pages to respond, i.e. a 260 page limit; but [p]atent owner is only requesting that the page limit be extended to 75 pages.”<sup>10</sup>

Patent owner’s response is found to consist of *inter alia* a 78 page patent owner response along with three declarations under 37 CFR 1.131 and three declarations under 37 CFR 1.132. The patent owner response was found to consist of a cover/caption page, a two page table of contents, a seven page listing of claims, a 63 page remarks section (double spaced), a two page listing of issues section, a two page listing of support for new claims section, and a signature page. All three declarations under 37 CFR 1.131 and the 37 CFR 1.132 declarations by Dr. Lyon and Mr. McGinness have been found to be factual. The 37 CFR 1.132 declaration executed by Dr. Kirtley, (“the Kirtley declaration”), totaling 87 pages, is in response to third party requester’s declaration executed by Dr. Harley (“the first Harley declaration”). The Kirtley declaration was found to contain several portions of legal argumentation, see *e.g.* pages 46-47, paragraphs 94-99; pages 57-58, paragraphs 117-122 etc. Therefore, the Kirtley declaration’s 87 pages are considered part of patent owner’s substantive response. Accordingly, the length of patent owner’s substantive response exceeds the page limit, and the extent of the waiver actually being requested, is to submit a total of approximately 154 pages.<sup>11</sup>

Based upon the individual facts and circumstances of this case, including the size of the December 21, 2010 Office action, containing a number of rejections and incorporation by

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<sup>3</sup> Id.

<sup>4</sup> Id. at page 3.

<sup>5</sup> Id.

<sup>6</sup> Id.

<sup>7</sup> Id. at page 2.

<sup>8</sup> Id.

<sup>9</sup> Id.

<sup>10</sup> Id. Note that due process is not at issue in light of *Patlex Corp. v. Mossinghoff*, 771 F.2d 480 (Fed. Cir. 1985) (Citing *Mathews v. Eldridge*, 424 U.S. 319 (1976))

<sup>11</sup> The sum of the patent owner 63 page remarks section, two page listing of issues section, two page listing of support for new claims section and the 87 page Kirtley declaration.

reference of 157 pages from the request for reexamination in the '580 proceeding,<sup>12</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent of patent owner's March 21, 2011 response. In this connection, it is observed that the total number of pages of patent owner's March 21, 2011 response submission is less than the total number of pages of the substantive portion of the December 21, 2010 Office action, which has been determined to span approximately 177 pages.<sup>13</sup> Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the December 21, 2010 Office action exceeds 50 pages.

In view of the above, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's March 21, 2011 response submission. This waiver makes patent owner's March 21, 2011 response submission page-length compliant.

### III. Third Party Requester Petition Under 37 CFR 1.183

Third party requester's April 20, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

Third party requester petitions for "waiver of [r]ule 1.943(b) and that the 65 pages of [t]hird [p]arty [c]omments be accepted."<sup>14</sup> In support of waiver of 37 CFR 1.943(b), requester states that "[p]atent [o]wner's response of March 21, 2010[sic-2011] has exceeded the 50-page limit, including 450 pages (counting all declarations, arguments and exhibits filed on March 21, 2010 [sic-2011])."<sup>15</sup> Waiver of 37 CFR 1.943(b) is requested due to "[p]atent [o]wner's arguments, declarations, and exhibits are directed to: the patentability of the 45 original claims, the patentability of 20 claims newly added by [p]atent [o]wner, alleged secondary considerations provided to rebut the *prima facie* case of obviousness (copying, long felt need, and commercial success), and 1.131 declaration evidence purported to antedate a prior art reference."<sup>16</sup> Requester asserts that it "has attempted to comply with [r]ule 1.943(b) by revising and limiting commentary to an absolute minimum of the disputed issues, and presenting proposed rejections for the new claims added by [p]atent [o]wner using a prose style after determining that this substantially reduces the number of pages as compared to a chart style. However, such efforts have still resulted in a total of 15 pages over the 50 page limit."<sup>17</sup> Accordingly, requester petitions for waiver of the rule to exceed the page limit by 15 pages.

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<sup>12</sup> See Office action at pages 5-21.

<sup>13</sup> On its face, the December 21, 2010 Office action spans 31 pages, but for patent owner's response purposes only pages 2-21 are substantive as page 1 is form PTOL-466, pages 22-26 are non-adoption discussion and pages 27-31 are purely administrative; pages 5-21 incorporate by reference 157 pages of the request. Contrary to patent owner's assertion the Office action does not incorporate by reference an expert declaration. The December 21, 2010 Office Action, at page 4, merely states it was reviewed and considered and in fact notes that it was partially not considered due to improper legal conclusions. Accordingly, the relevant substantive portion of the Office action consists of 20 pages of text coupled with 157 pages of the request, which was incorporated by reference, for a total of 177 pages.

<sup>14</sup> Third party requester petition at page 3.

<sup>15</sup> Id. at page 1.

<sup>16</sup> Id. at page 2.

<sup>17</sup> Id. at pages 1-2.

Third party requester's response is found to consist of a 50 page comments section and a single 15 page declaration under 37 CFR 1.132. Third party requester's comments section was found to consist of a cover/caption page and signature page integrated into the corpus of requester's substantive remarks, which were 1 ½ line spaced<sup>18</sup> and substantially free of inserted figures, thus maximizing the usage of requester's 50-page regulatory limit. The 37 CFR 1.132 declaration executed by Dr. Harley, totaling 15 pages ("the second Harley declaration"), is in response to, *inter alia*, "the Kirtley declaration." The second Harley declaration was found to contain several portions of legal argumentation, see *e.g.* page 10, paragraphs 22-23; pages 13-14, paragraphs 34-35 etc. Therefore, the second Hartley declaration's 15 pages are considered part of third party requester's substantive response. Accordingly, the length of third party requester's substantive response, and the extent of the waiver being requested, is at most 65 pages.<sup>19</sup>

Based on the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance, to the extent stated. The total number of pages of third party requester's April 20, 2011 comments submission that counts toward the page limit is 65 pages.<sup>20</sup> Requester's petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting third party requester's comments submission exceed the page limit by up to 15 pages. This waiver makes third party requester's April 20, 2011 comments submission page-length compliant.

### CONCLUSION

1. Patent owner's February 28, 2011 petition under 37 CFR 1.183, as supplemented on March 21, 2011, is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of making patent owner's March 21, 2011 response submission page-length compliant.
2. Third party requester's April 20, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of making requester's April 20, 2011 comments submission page-length compliant.
3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

/Kenneth M. Schor/

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Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

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<sup>18</sup> In accordance with the minimum requirements for line spacing in 37 CFR 1.52(b)(2)(i)

<sup>19</sup> The sum of requester's 50 page comments section plus the 15 page second Harley declaration.

<sup>20</sup> Id.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,583	11/01/2010	6,825,422	P71C1-RX	1575
50905	7590	07/08/2011	EXAMINER	
Ken Burraston/FormFactor KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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EAST PALO ALTO, CA 94303-2248

Date: **MAILED**

**JUL 08 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000583  
PATENT NO. : 6825422  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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Ken Burraston/FormFactor  
KIRTON & MCCONKIE  
P.O. BOX 45120  
SALT LAKE CITY UT 84145-0120

(For Patent Owner)

MAILED

JUL 08 2011

DLA PIPER LLP (US )  
2000 UNIVERSITY AVENUE  
EAST PALO ALTO, CA 94303-2248.

(For Requester) **CENTRAL REEXAMINATION UNIT**

*In re: Eldridge et alia*  
Reexamination Proceeding  
Control No. 95/000,583  
Request Deposited: November 1, 2010  
For: U.S. Patent No. 6,825,422

:  
: **DECISION DISMISSING**  
: **PETITION UNDER**  
: **37 CFR 1.181**  
:

The *inter partes* reexamination proceeding is before the Director of the Central Reexamination Unit to address the patent owner petition, filed June 27, 2011 entitled "PETITION UNDER 37 C.F.R. §1.181 THAT ACTION CLOSING PROSECUTION WAS PREMATURE"

The patent owner petition is timely filed and considered pursuant to 37 CFR §1.181.

The patent owner petition is **dismissed** for the reasons set forth below.

Petitioner argues "the ACP included multiple new grounds of rejection that the Patent Owner has had no opportunity to address and were not necessitated by amendments in the March response".

A review of the record indicates:

1. The Office mailed a non-final rejection on January 7, 2011 rejecting original claims 1-7 and 9-22 and confirming the patentability of claim 8.
2. On March 7, 2011, patent owner responded. The response did not amend any of the original claims and added new claims 23-45.



Art Unit: 3992

3. On May 26, 2011, the Office mailed an Action Closing Prosecution (ACP), which repeated all rejections of original claims and included rejections to new claims 23-29 and 31-45. Claim 8 remained confirmed and new dependent claim 30 was found patentable (if rewritten in the independent form).

Petitioner's fact (6) is only partially correct as there is no rejection of claim 30. However, petitioner is correct as to the fact that "[t]he rejections in the first Office Action were repeated in the ACP".

Petitioner's position that "the ACP included multiple new grounds of rejection that... were not necessitated by amendments in the March response" is not well taken. The rejections of all original claims are repeated from the first Office Action in the present ACP. The rejections of new claims 23-29 and 31-45 were necessitated by amendment because new claims 23-29 and 31-45 were not yet of record when the first Office Action was issued.

In view of the above, the petition is dismissed.

### CONCLUSION

1. The petition is dismissed.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.
3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Irem Yücel  
Director, Central Reexamination Unit



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Ken Burraston/FormFactor KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			ART UNIT	PAPER NUMBER

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DLA PIPER LLP (US)

2000 UNIVERSITY AVENUE

EAST PALO ALTO, CA 94303-2248

Date:

**MAILED**

**JAN 24 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000583

PATENT NO. : 6825422

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**JAN 24 2012**

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(For Patent Owner) **CENTRAL REEXAMINATION UNIT**

DLA Piper LLP  
2000 University Avenue  
East Palo Alto, CA 94303-2248

(For Third Party Requester)

*In re Eldridge et al.*  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,583  
Filed: November 1, 2010  
For: U.S. Patent No. 6,825,422

:  
: **DECISION**  
: **DISMISSING PETITIONS**  
: **UNDER § 1.182 & 1.183**  
:

This is a decision on the following petitions:

- the October 28, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION,"
- the September 26, 2011 patent owner petition entitled "PATENT OWNER'S PETITION FOR EXTENSION OF TIME TO FILE APPEAL BRIEF PURSUANT TO 37 C.F.R. § 1.183."
- the November 1, 2011 petition under 37 C.F.R. § 1.183, requesting a waiver of the prohibition on requesting an extension of time to file an appellant's brief until after decisions are issued on the patent owner's pending § 1.182 and § 1.183 petitions.
- the January 9, 2012, third party requester's petition under 37 C.F.R. § 1.183 for waiver of the rule prohibiting entry of the concurrently submitted appellant's brief.

The petitions are before the Office of Patent Legal Administration.

The petitions under 37 C.F.R. §§ 1.182 and 1.183 are **dismissed**.

**PERTINENT BACKGROUND**

- On November 1, 2010, a request for *inter partes* reexamination of claims 1-22 of U.S. Patent 6,825,422 was filed by a third party requester. This proceeding was accorded control number 95/000,583 ("the '583 proceeding"). Reexamination was ordered on January 7, 2011, and a non-final Office action was issued on the same date, rejecting claims 1-7 and 9-22 over prior art under 35 U.S.C. §§ 102 and 103, and confirming the patentability of unamended patent claim 8.

- On March 7, 2011, patent owner filed no amendments to any original patent claims, but added new claims 23-45. Third party requester filed comments on April 5, 2011.
- On May 26, 2011, the Office mailed an action closing prosecution (“ACP”) in which original claim 8 and new claim 30 were held patentable, and claims 1-7 (original), 9-22 (original), 23-29 (new), and 31-45 (new) were rejected under prior art.
- On June 27, 2011, patent owner filed a proposed amendment to added claim 23, and a petition under 37 C.F.R. § 1.181 to find the May 26, 2011 ACP as issued prematurely.
- On July 8, 2011, the Office issued a decision dismissing the patent owner petition filed on June 27, 2011.
- On July 18, 2011, the patent owner filed a request for reconsideration of the July 8, 2011 Office decision.
- On July 15, 2011, third party requester filed comments.
- On August 10, 2011, patent owner filed a notice of related proceedings, bringing pending patent application 12/852,337 to the attention of the Office.
- On September 30, 2011, a Right of Appeal Notice (RAN) was issued by the Office, in which original claim 8 and new claim 30 were held patentable, and claims 1-7 (original), 9-22 (original), 23-29 (new), and 31-45 (new) were rejected under prior art. The proposed amendments filed on June 27, 2011 were denied entry as failing to reduce or simplify issues for appeal due to raising new issues through “incorporation of the limitations of claim 44 into independent claim 23.”
- On October 28, 2011, patent owner filed a Notice of appeal and the following petitions:
  - A petition entitled “PETITION UNDER 37 C.F.R. § 1.181 TO ENTER AMENDMENT AFTER ACTION CLOSING PROSECUTION.”
  - A petition entitled “PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION.”
  - A petition entitled “PETITION UNDER 37 CFR § 1.183,” requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief until after decisions are issued on the co-filed § 1.181 and § 1.182 petitions.
- On November 1, 2011, third party requester filed a notice of cross-appeal, and a petition under 37 CFR § 1.183, requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief until after decisions are issued on the patent owner’s pending § 1.182 and § 1.183 petitions.
- On January 3, 2012, patent owner filed an appellant’s brief.
- On January 9, 2012, third party requester filed an appellant’s brief, and a petition under 37 C.F.R. § 1.183 for waiver of the rule prohibiting entry of the concurrently submitted appellant’s brief.

## **PERTINENT STATUTES AND REGULATIONS**

### **35 U.S.C. § 314 provides, in pertinent part:**

(a) IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH. — Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

### **37 C.F.R. § 1.181(f) provides, in pertinent part:**

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

### **37 C.F.R. § 1.182 provides:**

All **situations not specifically provided** for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

### **37 C.F.R. § 1.183 provides:**

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

**37 C.F.R. § 41.66(a) provides:**

An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

**DECISION**The § 1.182 Petition

In March of 2005, the Office issued a Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."<sup>1</sup> Notice was provided therein that a patent owner could file a petition under 37 CFR § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 CFR § 1.182 petition, in appropriate circumstances. This petition will be referred to herein as "the § 1.182 petition."

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. This is critical in the reexamination setting, where 35 U.S.C. § 305 (for *ex parte* reexamination) and 35 U.S.C. § 314 (for *inter partes* reexamination) mandate that reexamination proceedings must be conducted "with special dispatch within the Office." Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate.

Furthermore, where relief is requested under § 1.182, any continuation of prosecution in a reexamination proceeding must be in accord with the statutory mandate of 35 U.S.C. § 314(c), stating that "all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office." Therefore, any Office decision which grants continuation of prosecution in a

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<sup>1</sup> 1292 Off. Gaz. Pat. Office 20, March 1, 2005.

reexamination proceeding must further its handling of the proceeding with special dispatch.

In this instance, patent owner petitions for reopening of prosecution to present claim amendments that purport to respond to new art rejections raised by the May 26, 2011 ACP, such that the amendments could not have been earlier anticipated, and that entry of such would advance prosecution.

Patent owner's June 27, 2011 response to the ACP included a submission directed towards the entry of a claim amendment as described in patent owner's instant petition. The examiner has refused entry of this amendment as raising new issues and not simplifying issues for appeal.

Patent owner's October 28, 2011 petition is alleged to simplify issues for appeal by overcoming rejections of the new claims based upon the Worsham and Sporck references, leaving only rejections based upon the Higgins reference for appeal. However, it is noted that the original claims for which the reexamination was ordered remain unamended, and thus, the issues pertaining to the patentability of the original claims would not be addressed by entry of the amendment. Further, patent owner has not addressed the potential for issues arising under 35 U.S.C. 112 to require attention should the amendment be entered into the proceeding. Such potential for additional issues must be weighed against any potential for reduction of issues due to an amendment. It is further noted that even were the amendment to be entered, each of the currently rejected and appealed claims would remain rejected and under appeal.

As such, entry of the amendment would, on the basis of the facts of record in the file, not clearly act to simplify or reduce entry of issues in the proceeding such that the issues in the proceeding would be better defined for appeal or issuance of a reexamination certificate. In view of the fact that the Board of Patent Appeals and Interferences (the Board) would still need to address each currently rejected claim in an appeal, even if the amendment were entered, there exists no reasoning sufficient to justify the Office sanctioning a delay of the reexamination proceeding such that the proceeding would not be handled with "special dispatch" per 35 U.S.C. § 314(c).

Therefore, as such reopening would not be consistent with the Office's requirement to handle reexamination proceedings with special dispatch, the patent owner petition under § 1.182 is **dismissed**. It is noted that examination of the subject matter related to that at issue in the instant proceeding continues in pending patent application 12/852,337, currently under a non-final action.

#### Patent Owner's October 28, 2011 Petition Under § 1.183

Patent owner's October 28, 2011 petition is filed under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules.

Patent owner petitioner filed the petition to request that the time for filing an appellant's Brief be extended until patent owner's petition under § 1.182 has been acted upon. Patent owner's petition under § 1.182 is being dismissed in the present decision. Furthermore, patent owner has filed an appellant's brief, causing the question of any waiver of the rules for extension of time to file an appellant's brief to become moot. Therefore, the instant patent owner petition under § 1.183 is **dismissed**.



### Third Party Requester's November 1, 2011 Petition Under § 1.183

Third party requester's November 1, 2011 petition is filed under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules.

Third party requester filed the petition to request that the time for filing an appellant's Brief be extended until patent owner's petition under § 1.182 has been acted upon, and in the case that patent owner's petition under § 1.183 is granted. At the time of this decision, the date upon which the third party's appellant's brief is due has passed without a filing of a brief by third party requester. As 37 C.F.R. § 1.181(f) clearly states, the mere filing of a petition does not stay any time period for filing a paper with the Office. Therefore, third party requester was aware that, absent receipt of an Office decision to the contrary, an appellant's brief needed to have been filed prior to the due date in order to be timely considered. Since patent owner's petitions under 37 C.F.R. §§ 1.182 and 1.183 would not have been granted as detailed above, third party requester's petition would not have been granted even if timely considered by the Office, and a timely filing of an appellant's brief would have been required. Third party requester presents no reasoned argument why an extraordinary situation exists such that waiver of the rules to permit an extension of time to file an appellant's brief is warranted under the facts of the November 1, 2011 petition. Therefore, that petition is **dismissed**.

### Third Party Requester's January 9, 2012 Petition Under § 1.183

Third party requester's January 9, 2012 petition is filed under § 1.183, which permits relief "[i]n an extraordinary situation, where justice requires" waiver of any requirement of the rules. The question of whether extraordinary circumstances exist such that justice requires waiver of a rule is necessarily specific to the facts and circumstances of the particular case. However, past practice and court precedent provide some guidance into this inquiry.

#### A. Past and Current Office Procedure:

Currently, the MPEP does not specifically address the circumstance in which a third party requester may seek entry of untimely papers, which are refused consideration under § 1.957(a). However, prior to the establishment of procedures for revival of a proceeding to enter an untimely paper submitted by the patent owner, the August 1983 5th edition of the MPEP provided guidance for seeking waiver of the rules to enter an untimely paper. In that edition, MPEP 2268 stated that "substantial property rights are involved in patents undergoing reexamination, the Office will consider, in appropriate circumstances, petitions to waive the rules pursuant to 37 CFR 1.183."<sup>2</sup> Decisions on such petitions applied the "extraordinary circumstances" test, and weighed such factors as the potential loss of appeal rights, acts of counsel to prudently ensure timely filing, and/or unawareness of or failure to properly interpret applicable due date regulations.<sup>3</sup> Such considerations have also been found appropriate in other

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<sup>2</sup> See MPEP 2268, 5th edition, August 1983.

<sup>3</sup> See, e.g., *In re Sivertz*, 227 USPQ 255 (Commr. Pat. July 23, 1985) (finding that counsel's apparent unawareness of the proper due date provisions did not show that justice required waiver of any time period set forth in USPTO regulations for appeal to the Federal Circuit); *In re Bachler*, 229 USPQ 553 (Commr. Pat. March 13, 1986) (stating that "the evidence does establish that counsel took detailed steps to ensure that timely filing took place, and these, coupled with the fact that the denial of the request to have the reply brief considered and of an opportunity for an oral hearing may prejudice the patent owner, established an extraordinary situation"); *In re Reck*, 227 USPQ 488 (Commr. Pat. August 28, 1985) (stating "[c]ounsel's apparent oversight . . . and unawareness with respect to [the appropriate timeliness regulations] does not make this an extraordinary situation for a grant of the relief sought").

situations, such as interference proceedings, in which an “extraordinary circumstances” test is applicable.<sup>4</sup>

Such petitions were noted to be appropriate where “rights may be lost by the failure to timely respond.”<sup>5</sup> Since Congress has given the *inter partes* reexamination third party requester the same rights of appeal as given to the patent owner, waiver of the rules to permit entry of untimely papers should be applied to both parties, in appropriate situations, in the absence of a right to revive the proceeding.

The Office has previously entertained petitions for relief similar to that sought in the instant petition. In *inter partes* reexamination 95/000,209, third party requester sought relief from an untimely filed appellant’s brief based solely upon a miscalculation of the due date for that brief. The decision on that petition was based on a determination of whether the facts and circumstances gave rise to an “extraordinary circumstance.” In that decision, such miscalculation, stemming from a confusion over the proper date of filing of patent owner’s appellant’s brief, was noted to be “unfortunately, something that is not a rare occurrence, and is hardly an unusual or extraordinary circumstance.”<sup>6</sup> In *inter partes* reexamination 95/000,463, third party requester also sought relief from an untimely filed appellant’s brief based upon a miscalculation of the due date for that brief due to an unforeseeable failure of the requester’s normally reliable docketing system.<sup>7</sup> While relief was first denied, petitioner later obtained relief by submitting evidence to support the existence of an extraordinary situation.<sup>8</sup> Thus, it is seen that the Office has treated petitions to enter an untimely filed appellant’s brief under the “extraordinary circumstances” standard through review of the circumstances associated with the late filing.

#### B. Prior Court Precedent:

The essence of the “extraordinary circumstances” requirement was expressed by the CCPA in *Myers v. Feigelman*, 455 F.2d 586, 172 USPQ 580 (CCPA 1972):

[T]he rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the purpose of the rules.<sup>9</sup>

Certain circumstances have been considered by the court as strong factors weighing against a finding of extraordinary circumstances. For example, numerous courts have found that lack of

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<sup>4</sup> See, e.g., *B and E Sales Co. v. Andrew Jergens Co.*, 7 U.S.P.Q.2d 1906 (Commr. Pat. April 27, 1988) (finding that “the mistake was the result of counsel’s failure to review the rule” where counsel placed the burden of rule interpretation on a non-attorney staff member, resulting in an improper interpretation of a rule, resulting in untimeliness of a filing).

<sup>5</sup> MPEP 2268, 5th edition, August 1983.

<sup>6</sup> “Decision Granting Petition,” November 18, 2008, *inter partes* reexamination 95/000,209, at 7-8.

<sup>7</sup> “Petition Under 37 C.F.R. § 1.183,” November 8, 2010, *inter partes* reexamination 95/000,463, at 2-3.

<sup>8</sup> “Decision Dismissing Petitions Under §§ 1.182 and 1.183,” November 23, 2010, “Renewed Petition Under 37 CFR § 1.183,” December 7, 2010, “Decision Dismissing Requests for Reconsideration,” February 3, 2011, “Second Renewed Petition Under 37 CFR § 1.183,” February 16, 2011, and “Decision Granting Petition Under 37 C.F.R. § 1.183,” February 28, 2011.

<sup>9</sup> See *Myers v. Feigelman*, 455 F.2d at 601, 172 USPQ at 584.

awareness of the provisions of a rule by an attorney is not a basis for waiver of that rule.<sup>10</sup> Additionally, permitting a requester to cure any such mere mistake through § 1.183 would place requester, contrary to the action of Congress, at an advantage to patent owner, which is by statute accorded such a right at a fee substantially greater than that for § 1.183.<sup>11</sup>

Certain other circumstances have been correlated by the courts with a finding of extraordinary circumstances. For example, where an unforeseeable intervening act in the submission of the document causes delay, such an act has been found to contribute to an “extraordinary” situation.<sup>12</sup> Where certain aspects of the Office’s behavior are implicated in a party’s untimely submission, courts are apt to find that such behavior contributes to an “extraordinary” situation.<sup>13</sup> Additionally, courts have stated a preference for mitigating “inevitable mistakes,”<sup>14</sup> and courts have been noted to be “loathe to extinguish a litigant’s claim based solely on the innocent mistakes of his lawyer,”<sup>15</sup>

In each situation, the court or deciding official weighs the entirety of the facts presented by the party seeking waiver to determine whether “extraordinary circumstances” which would justify rule waiver are found to exist. No one circumstance is solely determinative.

As a final point of information, even if relief were available under 37 C.F.R. § 1.137(a) (as pointed out, it is not available in this situation), MPEP 711.03(c), part II (C)(2) points out (emphasis added): **“Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute ‘unavoidable’ delay. See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm’r Pat. 130, 131 (1891). For example, as 37 C.F.R. §§ 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not ‘unavoidable’ when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.”**

<sup>10</sup> See, e.g., *Nugent v. Yellow Cab Co.*, 295 F.2d 794 (7th Cir. 1961) cert denied, 369 U.S. 828 (1962)(stating “counsel’s mistake in overlooking and not being aware of rule [is] not [a] basis for waiving [a] rule”); *In re Jones*, 542 F.2d 65, 68, 191 USPQ 249, 252 (CCPA 1976)(stating “attorneys appearing before Court are presumed to have knowledge of the provisions of the current rules”).

<sup>11</sup> At the time of this decision, a petition to revive an unintentionally abandoned proceeding is set at \$1,620; a petition to waive a rule under § 1.183 is set at \$400. See <http://www.uspto.gov/web/offices/ac/qs/ope/fee2009september15.htm>

<sup>12</sup> See *Howard Florey Institute v. Dudas*, 87 U.S.P.Q.2d 1913 (E.D.VA 2008) (finding an acute panic attack by a courier of the paper to be filed at the USPTO to be an “extraordinary” situation).

<sup>13</sup> See *Commonwealth of Australia v. Radio Corporation of America*, 399 F.2d 807, 810 (2nd Cir. 1968)(finding that “the lengthy deliberation of the Board of Patent Interferences upon the petition for reconsideration and appended motion was a major factor” with respect to 37 C.F.R. § 2.148).

<sup>14</sup> *Helfgott & Karas v. Dickenson*, 209 F.3d 1328, 1330 (Fed. Cir) (stating “[m]istakes are inevitable, much as all those involved try to minimize their possibility. Even if total elimination of mistakes is an illusory goal, their reasonable mitigation should not be. Sound judgment, flexibility, and the careful following of considered processes are critical to ensuring that small mistakes do not become large ones, and that mistakes of form do not overwhelm the correctness of substance. Unfortunately, in this case, at least some of these elements were lacking from both parties to this dispute, leaving it to us to ascertain error, and assign responsibility for it”).

<sup>15</sup> *Theodor Groz v. Quigg*, 10 U.S.P.Q.2d 1787 (reversing a refusal of the USPTO to find “unavoidable” a delay by patent owner in filing an appeal brief in a reexamination).

C. The Entirety of Facts Does Not Show Extraordinary Circumstances Such That Justice Requires Relief

Third party requester filed the petition to request that the time for filing an appellant's brief be extended such that the appellant's brief filed on January 9, 2012 is considered timely. Third party requester pleads for such relief on the ground that requester never received any decision on prior-filed petitions under 37 C.F.R. §§ 1.182 (filed by patent owner) and 1.183 (separately filed by patent owner and by requester).

At the time of this decision, the date upon which the third party's appellant's brief is due has passed without a filing of a brief by third party requester. As 37 C.F.R. § 1.181(f) clearly states, the mere filing of a petition does not stay any time period for filing a paper with the Office. Therefore, third party requester was aware that, absent receipt of an Office decision to the contrary, an appellant's brief needed to have been filed prior to the due date in order to be timely considered. The fact that no decision on the petitions was mailed prior to the due date for the appellant's brief is therefore not a justification for not filing a timely brief. Nor does lack of a decision on the petitions give rise to an extraordinary situation, since § 1.181(f) clearly contemplates the occurrence of an expiration of a time period while a petition is outstanding. In this regard, it is pointed out that patent owner faced the same situation that requester did, to the extent that a brief was due; yet, a decision on the 37 C.F.R. §§ 1.182 and 1.183 petitions had not been rendered. Patent owner chose to file its brief to address the case where the petitions would not be granted; requester chose to do nothing as the time for filing expired. Third party requester presents no reasoned argument why an extraordinary situation exists such that waiver of the rules to permit an extension of time to file an appellant's brief is required by justice under the facts of the January 9, 2012 petition. Therefore, that petition is dismissed.

CONCLUSION

1. The patent owner petitions under §§ 1.182 and 1.183, and the third party requester petitions under § 1.183 are dismissed.
2. A copy of this decision will be made of record in the reexamination file.
3. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7700.

/Michael Cygan/

Michael Cygan  
Legal Advisor  
Office of Patent Legal Administration

January 23, 2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,583	11/01/2010	6,825,422	P71C1-RX	1575
50905	7590	02/13/2012	EXAMINER	
Ken Burraston/FormFactor KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Date:

**MAILED**

**FEB 13 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000583

PATENT NO. : 6825422

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

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**FEB 13 2012**

**CENTRAL REEXAMINATION UNIT**

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*In re: Eldridge et al.* :  
*Inter Partes* Reexamination Proceeding : DECISION ON PETITION  
Control No.: 95/000,583 : UNDER 37 CFR § 1.181 -  
Deposited: November 1, 2010 : RECONSIDERATION  
For: U.S. Patent No.: 6,825,422 :

This is a decision on a paper filed by the patent owner on July 18, 2011 entitled "REQUEST FOR RECONSIDERATION OF THE DECISION DISMISSING PETITION UNDER 37 CFR 1.181" [hereinafter "the request"] and is a request to the Director to reconsider a previous petition decision, which dismissed a petition under 37 CFR § 1.181.

The request is before the Director of the Central Reexamination Unit.

The request is denied.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,825,422 issued on November 30, 2004.
- A request for *inter partes* reexamination was filed on September 1, 2010 and assigned control number 95/000,583.
- Reexamination was ordered and prosecution progressed until, on May 26, 2011, an Action Closing Prosecution ["ACP"] was issued.
- On June 27, 2011, patent owner filed a petition claiming that the ACP was premature and should be withdrawn for including new grounds of rejection.
- On July 8, 2011, the Office issued a decision dismissing the above petition.
- On July 18, 2011, patent owner filed the instant request for reconsideration of that decision.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### 37 CFR § 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination:

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

### MPEP § 2671 provides, in part:

Before an ACP is in order, a clear issue should be developed. When all claims are found patentable in the first action, the examiner will, at that point, issue an ACP, since the patent owner has nothing to respond to. Otherwise, it is intended that the second Office action in the reexamination proceeding will ordinarily be an ACP. The criteria for issuing an ACP is



analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application.

**MPEP § 706.07(a) provides, in part:**

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims . . . .

**DECISION**

The patent owner previously filed a petition arguing that the ACP was premature as including a new ground of rejection. The petition was dismissed in a decision mailed July 8, 2011. That decision stated, on page 2, that "The rejections of all original claims are repeated from the first Office Action in the present ACP. The rejections of new claims 23-29 and 31-45 were necessitated by amendment because new claims 23-29 and 31-45 were not yet of record when the first Office Action issued."

Patent owner argues in the request for reconsideration that there should not be a *per se* rule that rejections of new claims are necessitated by amendment, as this is contrary to the "spirit and intent" of the MPEP in liberally keeping prosecution open.<sup>1</sup> Petitioner argues that the rejection of claim 34 was not necessitated by amendment because similar claim 15 was not previously rejected in the same manner. Petitioner further argues it should have a full and fair opportunity to reply to the rejections including new art cited for the first time in the ACP.

Patent owner's arguments about a *per se* rule or the "spirit and intent" of the MPEP are essentially a red herring. The real issue here is whether the new ground was necessitated by amendment, as that is the key inquiry in determining whether a final action is appropriate when there is a new ground of rejection. This clear and longstanding Office policy is even codified in the regulations. See 37 CFR § 1.949. Whatever the "spirit and intent" of the MPEP might be, it must be balanced against this clear policy set forth in the regulations, as well as the statutory requirement for special dispatch and any other policies set forth in the MPEP. See 35 U.S.C. § 314(c); MPEP § 2671.01(VIII) ("In view of the requirement for "special dispatch" in *inter partes* reexamination proceedings (35 U.S.C. 314(c)), it is intended that the examiner be able to close prosecution at the earliest possible time."). As will be described, the new ground of rejection

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<sup>1</sup> Patent owner apparently does not dispute that a new ground of rejection may be considered final (and an ACP may issue) if necessitated by amendment, which is clear Office policy. See 37 CFR § 1.949; MPEP §§ 706.07(a) (action should be final unless it includes a new ground of rejection not necessitated by amendment); 2671.02 (criteria for issuing an ACP analogous to making a final rejection as set forth in § 706.07(a)).

was necessitated by amendment, therefore the examiner has clearly followed the letter of the rules and MPEP. The only question is whether some “spirit” of the MPEP that creates some requirement of the examiner has been violated. This is not the case.

Indeed, patent owner’s arguments as to the “spirit and intent” of the MPEP are not even strongly applicable to this case. Patent owner cites to MPEP §§ 2671.02 and 2673.01 as examples of this “spirit and intent.” Section 2671.01, to the extent that it sets forth any requirements of the examiner, requires complete and thorough actions. There is no argument that the examiner’s action was not thorough or complete. Section 2673.01, drawn to discretionary reopening after ACP, by name refers to a matter that is not required, but is discretionary. This section additionally refers to a different point in prosecution—amendments *after* ACP, rather than an examiner’s decision to *issue* an ACP—and refers to a different issue—permitting minor changes that would yield allowance of claims. Petitioner seems to claim that an unrequired discretionary matter, dealing with a different point in prosecution and involving a different issue, somehow sets forth non-discretionary requirements of the examiner in the instant case. This argument is unpersuasive. In any event, if there is an argument to be made about the “spirit” of the MPEP, at best the Manual sets forth a discretionary policy and there is no indication or even argument that the examiner has abused her discretion.

Turning back to the key issue, we must determine whether the new grounds of rejection were necessitated by patent owner’s amendment. Stated another way, we can ask: If not for the amendment, would the new rejection have been applied? Regardless of whether there is a *per se* rule, here it is clear that the new rejection was necessitated by the amendment. The original claims were rejected in an identical manner in the first Office action and the ACP. Any new rejection of the new claims would therefore not have been applied, if not for the amendment, because those claims only existed because of the amendment. It is clear that the only reason there were any new grounds here is because patent owner added new claims.

Patent owner argues that the rejection of new claim 34 was not necessitated by amendment. In the first rejection claim 1 was rejected as anticipated by Sporck; claim 15 depends from claim 1, and was not so rejected. New claim 34 is the same as claim 15, but instead depends on new claim 23. In the ACP claims 1, 23 and 34 were rejected as anticipated by Sporck. Patent owner argues that since claim 15 was not rejected previously, the rejection of new claim 34 was not necessitated by amendment.

Patent owner again gets away from the real issue—would the rejection have occurred if not for the amendment. Perhaps claim 15 could *also* have been rejected in the ACP; but this does not remove the fact that the new rejection would not have been presented if not for the addition of a new claim. If the examiner had also newly rejected claim 15 in the ACP, that would clearly have been a new ground not necessitated by amendment, but she did not. There is no requirement that

all rejections must be applied, or that *not* applying a potential rejection somehow turns a *different* rejection into one not necessitated by amendment.

Patent owner finally argues that it not get a full and fair opportunity to address the Worsham reference. This is unpersuasive because it was patent owner who created this situation by submitting new claims. It would appear that patent owner's argument would apply to any situation where a new claim is rejected with new art. Apparently patent owner asks for its own *per se* rule that if new art is applied to new claims it cannot yield an ACP. This is of course not consistent with the MPEP or longstanding Office policy as described herein. A patent owner should never be surprised if submitting new claims results in a new, final, rejection of those claims.

The previous petition decision was in accord with the statute, regulations and Office policy. The examiner's new grounds of rejection in the ACP were necessitated by amendment, therefore it was not improper for the examiner to close prosecution. The request for reconsideration is denied.

### CONCLUSION

1. The request for reconsideration is denied. The petition under 37 CFR § 1.181 filed June 27, 2011 remains dismissed.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,583	11/01/2010	6,825,422	P71C1-RX	1575
50905	7590	02/13/2012	EXAMINER	
Ken Burraston/FormFactor KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			ART UNIT	PAPER NUMBER

DATE MAILED: 02/13/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

DLA PIPER LLP (US)

2000 UNIVERSITY AVENUE

EAST PALO ALTO, CA 94303-2248

Date:

**MAILED**

**FEB 13 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000583

PATENT NO. : 6825422

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**FEB 13 2012**

**CENTRAL REEXAMINATION UNIT**

Ken Burraston/FormFactor : (For Patent Owner)  
KIRTON & MCCONKIE :  
P.O. BOX 45120 :  
SALT LAKE CITY, UT 84145 :

DLA PIPER LLP (US) : (For Third Party Requester)  
2000 UNIVERSITY AVENUE :  
EAST PALO ALTO, CA 94303 :

*In re: Eldridge et al.* :  
*Inter Partes* Reexamination Proceeding : DECISION ON PETITION  
Control No.: 95/000,583 : UNDER 37 CFR § 1.181  
Deposited: November 1, 2010 :  
For: U.S. Patent No.: 6,825,422 :

This is a decision on a petition filed by the patent owner on October 28, 2011 entitled "PETITION UNDER 37 CFR § 1.181 TO ENTER AMENDMENT AFTER ACTION CLOSING PROSECUTION" [hereinafter "the petition"] and is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to enter an amendment that was denied entry by the examiner.

The petition is before the Director of the Central Reexamination Unit.

The petition is denied.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,825,422 issued on November 30, 2004.
- A request for *inter partes* reexamination was filed on September 1, 2010 and assigned control number 95/000,583.
- Reexamination was ordered and prosecution progressed until, on May 26, 2011, an Action Closing Prosecution [“ACP”] was issued.
- On June 27, 2011, the patent owner filed a post-ACP amendment.
- On September 30, 2011, the examiner issued a Right of Appeal Notice that denied entry of the post-ACP amendment.
- On October 28, 2011, patent owner filed the instant petition.
- Various other petitions have been filed and decided since the issuance of the RAN, none of which are relevant to the instant decision.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### **37 CFR § 1.951 Options after Office action closing prosecution in *inter partes* reexamination (in part):**

- (a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted.

### **37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal (in part):**

- (b) After . . . an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

**MPEP § 2673(III) provides, in part:**

It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.

Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.

**DECISION**

The patent owner ["petitioner"] states that the post-ACP amendment should have been entered because it presents the claims in better form for consideration on appeal. Prior to the ACP, claim 23 was independent and claims 24-45 were each dependent on claim 23, directly or indirectly. In the post-ACP amendment petitioner proposed to amend claim 23 to include the limitations of claim 44. In the ACP, claim 23 was rejected in three different ways, but claim 44 was rejected in only one way; petitioner therefore argues that entry of the proposed amendment reduces to one the issues for appeal with regard to independent claim 23, does not raise new issues with respect



to independent claim 23, and does not increase the number of issues with regard to dependent claims 24-45. Petition pp. 3-5.

For her part, the examiner declined entry of the amendment, stating that it “does not simplify issues for appeal. Rather the proposed amendment raises new issues. Specifically, the proposed incorporation of the limitations of claim 44 into independent claim 23 results in a set of completely new claims that have not been previously considered in this proceeding.” RAN p. 4.

An amendment after ACP must comply with one of 37 CFR § 1.116(b)(1)-(3). Subsection (1) is clearly inapplicable as the amendment does more than cancel claims or respond to requirements. Subsection (3) is also inapplicable, as petitioner has not provided any argument, either in the petition or in the original post-ACP response, as to why the amendment was necessary and not earlier presented.<sup>1</sup> The requisite “showing” is therefore not present. In the petition it is argued that the amendment will reduce the issues for appeal and not add new issues. Such characteristics are not found in 37 CFR § 1.116(b), but they will be treated as arguments that the amendment presents the claims in better form for consideration on appeal

It is agreed that the amendment, at least superficially, would appear to remove certain rejections. For example, Sporck was said to anticipate old claim 23, but not claim 44; it would seem, by incorporating claim 44 into claim 23, that the rejection based on Sporck would be withdrawn. Thus, petitioner may be right that the proposal reduces, and does not add, issues as to claim 23. If petitioner would have made this change and at the same time cancelled the remaining new claims, the Director might accept that the amendment would present the claims in better form for appeal by materially reducing the issues. But this is not what occurred.

The Director agrees with the examiner’s reason for denying entry. Prior to the ACP, claim 23 was an independent claim, and claims 24-45 were dependent on claim 23, directly or indirectly. Claim 44 directly depended from claim 23. Patent owner’s proposed amendment has now produced new claims 23-43 and 45. While claim 23 is essentially the same as prior claim 44, the rest are different new claims that have not heretofore been examined. Even if this might ostensibly remove all but one of the rejections, as said by petitioner, this is not the only requirement in the regulations. The amendment must “present[] rejected claims in better form for consideration on appeal.” 37 CFR § 1.116(b)(2). Presenting new claims that have never been examined does not make such claims “better” for consideration on appeal. Indeed, they are in worse form for appeal, because the Board does not have the benefit of the examiner’s analysis of these claims.

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<sup>1</sup> To the extent that the “fundamental fairness” argument is an argument could be considered to reach this point, that argument will be addressed.

Petitioner might argue that the examiner can simply analyze these new claims now. Bearing in mind that prosecution has already been closed, it should also be recognized that the examiner's analysis of these new claims is not merely a trivial matter and should not be expected at this stage of prosecution. The examiner previously rejected claim 44 only once, as anticipated by Higgins. Specifically, the examiner rejected claims 23-25 and 35-44 as anticipated by Higgins. So now, any rejection of new claims 24-43 and 45 would appear to be based, at least in part, on Higgins. But what of new claims 26-29<sup>2</sup> and 31-34? They were not anticipated by Higgins; their features were instead said to be anticipated or obvious over Sporck, Worsham, and Khandros. The examiner would now have to determine whether Higgins may be combined with these other references under an obviousness analysis, and whether the combined teachings of the references render those claims unpatentable. Even the petitioner concedes that this is not merely a trivial issue, as it argues at Petition pp. 4-5 that such combinations would be flawed. The examiner would therefore need to undertake a new analysis of these claims, taking into account the patent owner's arguments as well as any third party comments. This is an entirely new analysis that has never been done before, and should not be undertaken for the first time after prosecution is closed.

The MPEP further provides guidance on this precise situation:

Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn . . . , the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate . . . the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.

MPEP § 2673(III).

Thus, the Director disagrees with the argument that the proposed amendment may be entered because it does not increase the number of issues as to claims 24-45. We do not simply count up all of the new issues and all of the removed issues, and if the net result is zero then we permit amendment. Section 1.116(b)(2) requires that the claims be in "better" form for appeal; removing some issues while raising other issues by providing new claims that have never been examined does not place the claims in "better form" considering that the amendment would require an entirely new examination of the claims after the ACP. Petitioner is reminded that an ACP is an "action closing prosecution," and it cannot expect a full, new examination of the amended claims after the close of prosecution. This is not what is permitted or even contemplated by § 1.116.

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<sup>2</sup> Claim 30 was deemed patentable in the ACP and would presumably remain patentable after such amendment.

The fairness argument is likewise flawed. Petitioner complains that it has not had an opportunity to respond to the newly cited art Worsham, first presented in the ACP, violating the “spirit of the philosophy” that the Office should permit patent owner a full opportunity to address all grounds of rejection. Petition pp. 5-6. But the “spirit and philosophy” presumes that a patent owner works toward a resolution of the issues, not that it continues to create new issues in every response by first filing new claims, creating new issues, and then amending those new claims to create additional new claims and even more new issues. It is longstanding Office policy that new grounds of rejection may be applied in a final rejection when such rejection is necessitated by amendment, and “[t]he criteria for issuing an ACP is analogous to that . . . for making a rejection final in an application.” MPEP § 2671.02

This is not “precisely the type of circumstance contemplated by” MPEP § 2673.02 as argued by petitioner. Section 2673.02 states that the petition deciding official “should be mindful that the patent owner . . . may not be able to proceed effectively if the amendment submitted after the ACP is not entered.” Again, it is petitioner who has created new issues that require new examination, effectively creating this problem for itself. And it is not clear how petitioner cannot “proceed effectively” without entry of its amendment, as petitioner has not explained why this is the case. The amendment does not clearly lead to patentable claims, therefore the claims as amended would still need to be examined as described above, and then any such rejections addressed by the Board. Perhaps petitioner cannot proceed in the exact way that it wants to proceed, but this does not mean it cannot proceed effectively.

Additionally, there currently exists co-pending grandchild application 12/852,337. As claims 23-43 and 45 are new claims, patent owner would lose nothing<sup>3</sup> by prosecuting those claims in a continuation application, if it is so concerned with the ability to file requests for continuing examination, continuing applications, or the like. This would seem to be an effective way of proceeding, if petitioner is so concerned with these precise claims.

Petitioner finally states that the petition “asks for nothing more than that opportunity [to overcome the Worsham reference.]” Petitioner is incorrect, because, as discussed above, it could have overcome Worsham in ways that do not create entirely new claims that have never been examined. Petitioner is additionally asking for continued prosecution of new claims after prosecution has already been closed.

The examiner appropriately applied Office policies and procedures in determining that the amendment after ACP should not be entered. The amendment raises different issues than those present in the claims previously, therefore it does more than simply present the claims in better

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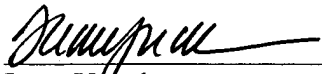
<sup>3</sup> Due to intervening rights. See 35 U.S.C. § 316(b); MPEP § 2693.

form for appeal. It was additionally not unfair for the examiner to deny entry of the amendment for the reasons described above.

The petition is denied.

### CONCLUSION

1. The petition under 37 CFR § 1.181 for entry of the post-ACP amendment filed June 27, 2011 is denied.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yücel  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,583	11/01/2010	6,825,422	P7IC1-RX	1575
50905	7590	02/17/2012	EXAMINER	
Ken Burraston/FormFactor KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

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Date:

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**FEB 17 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000583  
PATENT NO. : 6825422  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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: (For Patent Owner)

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**FEB 17 2012**

**CENTRAL REEXAMINATION UNIT**

DLA PIPER LLP (US)  
2000 UNIVERSITY AVENUE  
EAST PALO ALTO, CA 94303

: (For Third Party Requester)

*In re: Eldridge et al.*

*Inter Partes* Reexamination Proceeding

Control No.: 95/000,583

Deposited: November 1, 2010

For: U.S. Patent No.: 6,825,422

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DECISION ON PETITION  
UNDER 37 CFR § 1.181 –  
RECONSIDERATION

This is a decision on a paper filed by the patent owner on July 18, 2011 entitled "REQUEST FOR RECONSIDERATION OF THE DECISION DISMISSING PETITION UNDER 37 CFR 1.181" [hereinafter "the request"] and is a request to the Director to reconsider a previous petition decision, which dismissed a petition under 37 CFR § 1.181.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit.

The request is denied.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,825,422 issued on November 30, 2004.
- A request for *inter partes* reexamination was filed on September 1, 2010 and assigned control number 95/000,583.
- Reexamination was ordered and prosecution progressed until, on May 26, 2011, an Action Closing Prosecution ["ACP"] was issued.
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### MPEP § 2671 provides, in part:

Before an ACP is in order, a clear issue should be developed. When all claims are found patentable in the first action, the examiner will, at that point, issue an ACP, since the patent owner has nothing to respond to. Otherwise, it is intended that the second Office action in the reexamination proceeding will ordinarily be an ACP. The criteria for issuing an ACP is



analogous to that set forth in MPEP § 706.07(a) for making a rejection final in an application.

**MPEP § 706.07(a) provides, in part:**

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims . . . .

**DECISION**

The patent owner previously filed a petition arguing that the ACP was premature as including a new ground of rejection. The petition was dismissed in a decision mailed July 8, 2011. That decision stated, on page 2, that "The rejections of all original claims are repeated from the first Office Action in the present ACP. The rejections of new claims 23-29 and 31-45 were necessitated by amendment because new claims 23-29 and 31-45 were not yet of record when the first Office Action issued."

Patent owner argues in the request for reconsideration that there should not be a *per se* rule that rejections of new claims are necessitated by amendment, as this is contrary to the "spirit and intent" of the MPEP in liberally keeping prosecution open.<sup>1</sup> Petitioner argues that the rejection of claim 34 was not necessitated by amendment because similar claim 15 was not previously rejected in the same manner. Petitioner further argues it should have a full and fair opportunity to reply to the rejections including new art cited for the first time in the ACP.

Patent owner's arguments about a *per se* rule or the "spirit and intent" of the MPEP are essentially a red herring. The real issue here is whether the new ground was necessitated by amendment, as that is the key inquiry in determining whether a final action is appropriate when there is a new ground of rejection. This clear and longstanding Office policy is even codified in the regulations. *See* 37 CFR § 1.949. Whatever the "spirit and intent" of the MPEP might be, it must be balanced against this clear policy set forth in the regulations, as well as the statutory requirement for special dispatch and any other policies set forth in the MPEP. *See* 35 U.S.C. § 314(c); MPEP § 2671.01(VIII) ("In view of the requirement for "special dispatch" in *inter partes* reexamination proceedings (35 U.S.C. 314(c)), it is intended that the examiner be able to close prosecution at the earliest possible time."). As will be described, the new ground of rejection

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<sup>1</sup> Patent owner apparently does not dispute that a new ground of rejection may be considered final (and an ACP may issue) if necessitated by amendment, which is clear Office policy. *See* 37 CFR § 1.949; MPEP §§ 706.07(a) (action should be final unless it includes a new ground of rejection not necessitated by amendment); 2671.02 (criteria for issuing an ACP analogous to making a final rejection as set forth in § 706.07(a)).

was necessitated by amendment, therefore the examiner has clearly followed the letter of the rules and MPEP. The only question is whether some “spirit” of the MPEP that creates some requirement of the examiner has been violated. This is not the case.

Indeed, patent owner’s arguments as to the “spirit and intent” of the MPEP are not even strongly applicable to this case. Patent owner cites to MPEP §§ 2671.02 and 2673.01 as examples of this “spirit and intent.” Section 2671.01, to the extent that it sets forth any requirements of the examiner, requires complete and thorough actions. There is no argument that the examiner’s action was not thorough or complete. Section 2673.01, drawn to discretionary reopening after ACP, by name refers to a matter that is not required, but is discretionary. This section additionally refers to a different point in prosecution—amendments *after* ACP, rather than an examiner’s decision to *issue* an ACP—and refers to a different issue—permitting minor changes that would yield allowance of claims. Petitioner seems to claim that an unrequired discretionary matter, dealing with a different point in prosecution and involving a different issue, somehow sets forth non-discretionary requirements of the examiner in the instant case. This argument is unpersuasive. In any event, if there is an argument to be made about the “spirit” of the MPEP, at best the Manual sets forth a discretionary policy and there is no indication or even argument that the examiner has abused her discretion.

Turning back to the key issue, we must determine whether the new grounds of rejection were necessitated by patent owner’s amendment. Stated another way, we can ask: If not for the amendment, would the new rejection have been applied? Regardless of whether there is a *per se* rule, here it is clear that the new rejection was necessitated by the amendment. The original claims were rejected in an identical manner in the first Office action and the ACP. Any new rejection of the new claims would therefore not have been applied, if not for the amendment, because those claims only existed because of the amendment. It is clear that the only reason there were any new grounds here is because patent owner added new claims.

Patent owner argues that the rejection of new claim 34 was not necessitated by amendment. In the first rejection claim 1 was rejected as anticipated by Sporck; claim 15 depends from claim 1, and was not so rejected. New claim 34 is the same as claim 15, but instead depends on new claim 23. In the ACP claims 1, 23 and 34 were rejected as anticipated by Sporck. Patent owner argues that since claim 15 was not rejected previously, the rejection of new claim 34 was not necessitated by amendment.

Patent owner again gets away from the real issue—would the rejection have occurred if not for the amendment. Perhaps claim 15 could *also* have been rejected in the ACP; but this does not remove the fact that the new rejection would not have been presented if not for the addition of a new claim. If the examiner had also newly rejected claim 15 in the ACP, that would clearly have been a new ground not necessitated by amendment, but she did not. There is no requirement that


all rejections must be applied, or that *not* applying a potential rejection somehow turns a *different* rejection into one not necessitated by amendment.

Patent owner finally argues that it not get a full and fair opportunity to address the Worsham reference. This is unpersuasive because it was patent owner who created this situation by submitting new claims. It would appear that patent owner's argument would apply to any situation where a new claim is rejected with new art. Apparently patent owner asks for its own *per se* rule that if new art is applied to new claims it cannot yield an ACP. This is of course not consistent with the MPEP or longstanding Office policy as described herein. A patent owner should never be surprised if submitting new claims results in a new, final, rejection of those claims.

The previous petition decision was in accord with the statute, regulations and Office policy. The examiner's new grounds of rejection in the ACP were necessitated by amendment, therefore it was not improper for the examiner to close prosecution. The request for reconsideration is denied.

### CONCLUSION

1. The request for reconsideration is denied. The petition under 37 CFR § 1.181 filed June 27, 2011 remains dismissed.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Robert J. Oberleitner,  
Assistant Deputy Commissioner for Patent Operations and  
Acting Director, Central Reexamination Unit



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,583	11/01/2010	6,825,422	P71C1-RX	1575
50905	7590	02/17/2012	EXAMINER	
Ken Burraston/FormFactor KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
DLA PIPER LLP (US)  
2000 UNIVERSITY AVENUE  
EAST PALO ALTO, CA 94303-2248

Date: **MAILED**

**FEB 17 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000583  
PATENT NO. : 6825422  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

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Ken Burraston/FormFactor  
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P.O. BOX 45120  
SALT LAKE CITY, UT 84145

: (For Patent Owner)  
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**MAILED**

**FEB 17 2012**

**CENTRAL REEXAMINATION UNIT**

DLA PIPER LLP (US)  
2000 UNIVERSITY AVENUE  
EAST PALO ALTO, CA 94303

: (For Third Party Requester)  
:  
:  
:

*In re: Eldridge et al.*

*Inter Partes* Reexamination Proceeding

Control No.: 95/000,583

Deposited: November 1, 2010

For: U.S. Patent No.: 6,825,422

:  
:  
: DECISION ON PETITION  
: UNDER 37 CFR § 1.181  
:  
:

This is a decision on a petition filed by the patent owner on October 28, 2011 entitled "PETITION UNDER 37 CFR § 1.181 TO ENTER AMENDMENT AFTER ACTION CLOSING PROSECUTION" [hereinafter "the petition"] and is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to enter an amendment that was denied entry by the examiner.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit.

The petition is denied.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,825,422 issued on November 30, 2004.
- A request for *inter partes* reexamination was filed on September 1, 2010 and assigned control number 95/000,583.
- Reexamination was ordered and prosecution progressed until, on May 26, 2011, an Action Closing Prosecution ["ACP"] was issued.
- On June 27, 2011, the patent owner filed a post-ACP amendment.
- On September 30, 2011, the examiner issued a Right of Appeal Notice that denied entry of the post-ACP amendment.
- On October 28, 2011, patent owner filed the instant petition.
- Various other petitions have been filed and decided since the issuance of the RAN, none of which are relevant to the instant decision.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### **37 CFR § 1.951 Options after Office action closing prosecution in *inter partes* reexamination (in part):**

- (a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted.

### **37 CFR § 1.116 Amendments and affidavits or other evidence after final action and prior to appeal (in part):**

- (b) After . . . an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

**MPEP § 2673(III) provides, in part:**

It should be kept in mind that a patent owner cannot, as a matter of right, amend claims rejected in the ACP, add new claims after an ACP, nor reinstate previously canceled claims. A showing under 37 CFR 1.116(b) is required and will be evaluated by the examiner for all proposed amendments after the ACP, except where an amendment merely cancels claims, adopts examiner's suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.

Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn or any additional claim indicated as patentable, the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate new grounds for patentability for any claim newly found patentable and/or the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.

**DECISION**

The patent owner ["petitioner"] states that the post-ACP amendment should have been entered because it presents the claims in better form for consideration on appeal. Prior to the ACP, claim 23 was independent and claims 24-45 were each dependent on claim 23, directly or indirectly. In the post-ACP amendment petitioner proposed to amend claim 23 to include the limitations of claim 44. In the ACP, claim 23 was rejected in three different ways, but claim 44 was rejected in only one way; petitioner therefore argues that entry of the proposed amendment reduces to one the issues for appeal with regard to independent claim 23, does not raise new issues with respect



to independent claim 23, and does not increase the number of issues with regard to dependent claims 24-45. Petition pp. 3-5.

For her part, the examiner declined entry of the amendment, stating that it “does not simplify issues for appeal. Rather the proposed amendment raises new issues. Specifically, the proposed incorporation of the limitations of claim 44 into independent claim 23 results in a set of completely new claims that have not been previously considered in this proceeding.” RAN p. 4.

An amendment after ACP must comply with one of 37 CFR § 1.116(b)(1)-(3). Subsection (1) is clearly inapplicable as the amendment does more than cancel claims or respond to requirements. Subsection (3) is also inapplicable, as petitioner has not provided any argument, either in the petition or in the original post-ACP response, as to why the amendment was necessary and not earlier presented.<sup>1</sup> The requisite “showing” is therefore not present. In the petition it is argued that the amendment will reduce the issues for appeal and not add new issues. Such characteristics are not found in 37 CFR § 1.116(b), but they will be treated as arguments that the amendment presents the claims in better form for consideration on appeal

It is agreed that the amendment, at least superficially, would appear to remove certain rejections. For example, Sporck was said to anticipate old claim 23, but not claim 44; it would seem, by incorporating claim 44 into claim 23, that the rejection based on Sporck would be withdrawn. Thus, petitioner may be right that the proposal reduces, and does not add, issues as to claim 23. If petitioner would have made this change and at the same time cancelled the remaining new claims, the Director might accept that the amendment would present the claims in better form for appeal by materially reducing the issues. But this is not what occurred.

The Director agrees with the examiner’s reason for denying entry. Prior to the ACP, claim 23 was an independent claim, and claims 24-45 were dependent on claim 23, directly or indirectly. Claim 44 directly depended from claim 23. Patent owner’s proposed amendment has now produced new claims 23-43 and 45. While claim 23 is essentially the same as prior claim 44, the rest are different new claims that have not heretofore been examined. Even if this might ostensibly remove all but one of the rejections, as said by petitioner, this is not the only requirement in the regulations. The amendment must “present[] rejected claims in better form for consideration on appeal.” 37 CFR § 1.116(b)(2). Presenting new claims that have never been examined does not make such claims “better” for consideration on appeal. Indeed, they are in worse form for appeal, because the Board does not have the benefit of the examiner’s analysis of these claims.

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<sup>1</sup> To the extent that the “fundamental fairness” argument is an argument could be considered to reach this point, that argument will be addressed.

Petitioner might argue that the examiner can simply analyze these new claims now. Bearing in mind that prosecution has already been closed, it should also be recognized that the examiner's analysis of these new claims is not merely a trivial matter and should not be expected at this stage of prosecution. The examiner previously rejected claim 44 only once, as anticipated by Higgins. Specifically, the examiner rejected claims 23-25 and 35-44 as anticipated by Higgins. So now, any rejection of new claims 24-43 and 45 would appear to be based, at least in part, on Higgins. But what of new claims 26-29<sup>2</sup> and 31-34? They were not anticipated by Higgins; their features were instead said to be anticipated or obvious over Sporck, Worsham, and Khandros. The examiner would now have to determine whether Higgins may be combined with these other references under an obviousness analysis, and whether the combined teachings of the references render those claims unpatentable. Even the petitioner concedes that this is not merely a trivial issue, as it argues at Petition pp. 4-5 that such combinations would be flawed. The examiner would therefore need to undertake a new analysis of these claims, taking into account the patent owner's arguments as well as any third party comments. This is an entirely new analysis that has never been done before, and should not be undertaken for the first time after prosecution is closed.

The MPEP further provides guidance on this precise situation:

Where the entry of the proposed amendment (after the ACP) would result in any ground of rejection being withdrawn . . . , the proposed amendment generally raises new issues requiring more than cursory review by the examiner. The examiner would need to indicate . . . the reason why the rejection was withdrawn and would also need to deal with any third party requester's comments on the proposed amendment (made pursuant to 37 CFR 1.951(b) in response to owner's proposed amendment). Thus, the examiner is not required to enter the proposed amendment.

MPEP § 2673(III).

Thus, the Director disagrees with the argument that the proposed amendment may be entered because it does not increase the number of issues as to claims 24-45. We do not simply count up all of the new issues and all of the removed issues, and if the net result is zero then we permit amendment. Section 1.116(b)(2) requires that the claims be in "better" form for appeal; removing some issues while raising other issues by providing new claims that have never been examined does not place the claims in "better form" considering that the amendment would require an entirely new examination of the claims after the ACP. Petitioner is reminded that an ACP is an "action closing prosecution," and it cannot expect a full, new examination of the amended claims after the close of prosecution. This is not what is permitted or even contemplated by § 1.116.

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<sup>2</sup> Claim 30 was deemed patentable in the ACP and would presumably remain patentable after such amendment.

The fairness argument is likewise flawed. Petitioner complains that it has not had an opportunity to respond to the newly cited art Worsham, first presented in the ACP, violating the “spirit of the philosophy” that the Office should permit patent owner a full opportunity to address all grounds of rejection. Petition pp. 5-6. But the “spirit and philosophy” presumes that a patent owner works toward a resolution of the issues, not that it continues to create new issues in every response by first filing new claims, creating new issues, and then amending those new claims to create additional new claims and even more new issues. It is longstanding Office policy that new grounds of rejection may be applied in a final rejection when such rejection is necessitated by amendment, and “[t]he criteria for issuing an ACP is analogous to that . . . for making a rejection final in an application.” MPEP § 2671.02

This is not “precisely the type of circumstance contemplated by” MPEP § 2673.02 as argued by petitioner. Section 2673.02 states that the petition deciding official “should be mindful that the patent owner . . . may not be able to proceed effectively if the amendment submitted after the ACP is not entered.” Again, it is petitioner who has created new issues that require new examination, effectively creating this problem for itself. And it is not clear how petitioner cannot “proceed effectively” without entry of its amendment, as petitioner has not explained why this is the case. The amendment does not clearly lead to patentable claims, therefore the claims as amended would still need to be examined as described above, and then any such rejections addressed by the Board. Perhaps petitioner cannot proceed in the exact way that it wants to proceed, but this does not mean it cannot proceed effectively.

Additionally, there currently exists co-pending grandchild application 12/852,337. As claims 23-43 and 45 are new claims, patent owner would lose nothing<sup>3</sup> by prosecuting those claims in a continuation application, if it is so concerned with the ability to file requests for continuing examination, continuing applications, or the like. This would seem to be an effective way of proceeding, if petitioner is so concerned with these precise claims.

Petitioner finally states that the petition “asks for nothing more than that opportunity [to overcome the Worsham reference.]” Petitioner is incorrect, because, as discussed above, it could have overcome Worsham in ways that do not create entirely new claims that have never been examined. Petitioner is additionally asking for continued prosecution of new claims after prosecution has already been closed.

The examiner appropriately applied Office policies and procedures in determining that the amendment after ACP should not be entered. The amendment raises different issues than those present in the claims previously, therefore it does more than simply present the claims in better

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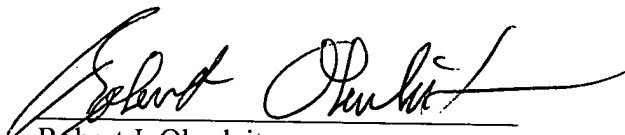
<sup>3</sup> Due to intervening rights. See 35 U.S.C. § 316(b); MPEP § 2693.

form for appeal. It was additionally not unfair for the examiner to deny entry of the amendment for the reasons described above.

The petition is denied.

### CONCLUSION

1. The petition under 37 CFR § 1.181 for entry of the post-ACP amendment filed June 27, 2011 is denied.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

A handwritten signature in black ink, appearing to read 'Robert J. Oberleitner', written over a horizontal line.

Robert J. Oberleitner,  
Assistant Deputy Commissioner for Patent Operations and  
Acting Director, Central Reexamination Unit



## REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,397,431 (the '431 patent) issued to Carles Puente Baliarda *et al.* on April 10, 2007.
2. The 95/001,482 *inter partes* proceeding.  
On November 11, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/001,482 (the '1482 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest.

Reexamination was ordered on December 13, 2010.

3. The 95/000,586 *inter partes* proceeding.  
On November 12, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 22, 27, 29, and 31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/000,586 (the '586 *inter partes* proceeding), and a filing date of December 13, 2010, the date at which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest.

Reexamination was ordered on February 4, 2011.

4. The 95/001,497 *inter partes* proceeding.  
On December 3, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/001,497 (the '1497 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest.

Reexamination was ordered on January 20, 2011.

## DECISION

### I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, the '1482, '586, and '1497 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent have been mailed in both the '1482 and '1497 reexamination proceedings, and an order granting reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 22, 27, 29, and 31 of the '431 patent was mailed in the '586 reexamination proceeding, and a decision under 37 C.F.R. § 1.989(a) is timely. The '1482, '586, and '1497 reexamination proceedings are at the same stage, in which no Office action on the merits has been issued.

The general policy of the Office is that multiple reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1482, '586, and '1497 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1482, '586, and '1497 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

## II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

The claims are identical in all proceedings. The patent owner is required to continue to maintain the same claims (and specification) in all files throughout the merged proceeding.

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

The present decision merges an inter partes reexamination proceeding with two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

### B. *Inter partes* Third Party Requester Participation:

#### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's

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<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

## 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '586 *inter partes* third party requester does not propose any rejections of claims 21, 24-26, and 30 in the request for reexamination, the '586 requester has no appeal rights as to those claims as they appear in the '431 patent.

## C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third



party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 C.F.R. § 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 C.F.R. § 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "*Inter Partes* Reexam"  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via

markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 C.F.R. § 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

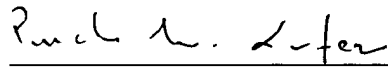
The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 C.F.R. § 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 C.F.R. § 41.67(c)(1)(vi))

Inter partes Reexamination Control No. 95/001,482,  
inter partes Reexamination Control No.95/001,497, and  
inter partes Reexamination Control No. 95/000,586.

-7-

### CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,482, *inter partes* Reexamination Control No.95/001,487, and *inter partes* Reexamination Control No. 95/000,586 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.



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Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

May 3, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,586 + 95/001,482 + 95/001,497	12/13/2010	7397431	3008.006REX1	5626
26111	7590	10/28/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
*Inter Partes* Reexamination**

REEXAMINATION CONTROL NUMBER 95/000,586, 95/001482, & 95/001497

PATENT NUMBER 7397413.

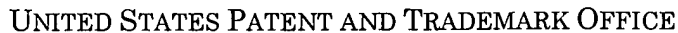
TECHNOLOGY CENTER 3999.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.



Sterne, Kessler, Goldstein & Fox P.L.L.C.  
1100 New York Ave., N.W.  
Washington, DC 20005

(For Patent Owner)

**CENTRAL REEXAMINATION UNIT**

Novak Druce & Quigg, LLP  
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(For '1482 *Inter Partes* Requester)

**Baker Botts L.L.P.**  
Patent Department  
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(For '1497 *Inter Partes* Requester)

**Morrison & Foerster LLP**  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040

(For '586 *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,482  
Filed: November 11, 2010  
For: U.S. Patent No. 7,397,431

**Inter Partes Reexamination Proceeding**  
Control No. 95/001,497  
Filed: December 3, 2010  
For: U.S. Patent No. 7,397,431

**: DECISION**  
**: GRANTING**  
**: PETITIONS**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,586  
Filed: December 13, 2010  
For: U.S. Patent No. 7,397,431

This is a decision on the following petitions:

1. Patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on August 15, 2011.
2. The '1482 requester paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)[sic]," filed on September 14, 2011.

Both petitions are before the Office of Patent Legal Administration for consideration.

Both petitions under 37 CFR 1.183 are granted for the reasons set forth herein.

### BACKGROUND

1. On July 8, 2008, United States Patent No. 7,397,431 (the '431 patent) issued to Baliarda et al.
2. On November 11, 2010, a first request for *inter partes* reexamination of the '431 patent was filed by a third party requester (the '1482 requester), which request was assigned Reexamination Control No. 95/001,483 (the '1482 proceeding).
3. On December 3, 2010, a second request for *inter partes* reexamination of the '431 patent, assigned Reexamination Control No. 95/000,586 (the '0586 proceeding), was initially deposited by a third party requester (the '586 requester), and a corrected request was filed on December 13, 2010.
4. Also on December 3, 2010, a third request for *inter partes* reexamination of the '431 patent was filed by a third party requester (the '1497 requester), which request was assigned Reexamination Control No. 95/001,500 (the '1497 proceeding).
5. On December 13, 2010, the Office ordered reexamination in the '1482 proceeding.
6. On January 20, 2011, the Office ordered reexamination in the '1497 proceeding.
7. On February 4, 2011, the Office ordered reexamination in the '586 proceeding.
8. On May 4, 2011, the Office issued a decision merging, *sua sponte*, the '1482, '1497 and '586 proceedings ("the merged proceeding").
9. On May 13, 2011, the Office issued a non-final action in the merged proceeding.
10. On August 15, 2011, the patent owner filed a response in the merged proceeding, concurrently with the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).
11. On September 14, 2011, the '1482 requester filed comments, concurrently with the instant petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)[sic]" ('1482 requester petition under 37 CFR 1.183).

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Petitions Under 37 CFR 1.183

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide



a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count

#### A. Patent Owner Petition Under 37 CFR 1.183

On August 15, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its August 15, 2011 response submission. In support of its request for waiver of the rule, patent owner “asserts that justice would be served by granting waiver of the 50-page limit, because the full length of the Response is needed to fully and adequately respond to the Office Action.”<sup>1</sup> Further, patent owner asserts:

This reexamination proceeding represents the merger of three *Inter Partes* reexaminations. Thus, the Office Action is based on the combination of three *Inter Partes* reexamination requests and grants. Specifically, the Office Action includes 22 separate grounds of rejection over 13 separate references. . . . While the pending Office action constitutes only 16 pages, it incorporates by reference over 850 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination. It would be unjust to hold the Patent Owner to only 50 pages to respond to what is essentially three Office Actions, particularly given the size and complexity of the three *Inter Partes* reexamination requests upon which they are based.”<sup>2</sup>

In addition to stating that the response satisfies the formatting requirements for a grantable petition under 37 CFR 1.183, patent owner asserts that it has “made a good faith effort to comply with the 50-page limit, making efforts to economize, avoid extraneous material and information already of record, and present arguments efficiently . . . . Despite these efforts, the argument portion of the Response exceeds the 50-page limit.”<sup>3</sup>

Patent owner’s August 15, 2011 response submission includes: (1) a 175-page remarks section; (2) a 10-page declaration entitled “Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132”; (3) a 15-page declaration entitled “Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 Relating to Fractal and Multilevel Antennas”; (4) a 9-page declaration entitled “Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera, and Jordi Soler Under 37 C.F.R. § 1.132”; (5) a 9-page declaration entitled “Declaration of Ruben Bonet Under 37 C.F.R. § 1.132”; (6) a 41-page declaration entitled “Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132” (The “Mittra Declaration”); and (7) a 20-page declaration entitled “Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132 Relating to Single Band, Resonant and Multilevel Antennas”. In view of the guidance set forth herein, portions of the 41-page “Mittra Declaration” are deemed to include an extension of arguments of counsel. Thus, the Mittra declaration is subject to the 50-

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<sup>1</sup> See patent owner petition at page 2.

<sup>2</sup> See *id.* at pages 2-3.

<sup>3</sup> See *id.*

page length requirement, in addition to 175-page remarks section<sup>4</sup> such that patent owner's August 15, 2011 response submission exceeds the regulatory page limit by up to 166 pages.

Based on the individual facts and circumstances of this case such as, for example, the size of the May 13, 2011 Office action, including the incorporation by reference of pages from multiple requests for reexamination in the merged proceeding,<sup>5</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's response submission exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's August 15, 2011 response submission to exceed the regulatory page limit by up to 166 pages. This waiver makes patent owner's August 15, 2011 response submission page-length compliant.

#### **B. The '1482 Requester's Petition Under 37 CFR 1.183**

On September 14, 2011, the '1482 requester filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its September 14, 2011 comments submission. The '1482 requester asserts that the September 14, 2011 comments submission includes "99 pages of double spaced 12 pt font arguments and a 20-page declaration from Dr. Balanis under 37 C.F.R. § 1.132."<sup>6</sup> The '1482 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 99 pages as Dr. Balanis' declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue".<sup>7</sup>

In support of its request for waiver of the rule, the '1482 requester asserts:

Samsung has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit. The additional pages requested in

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<sup>4</sup> The cover page is excluded from the page count, as is the listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count.

<sup>5</sup> See May 13, 2011 Office action which, on its face, spans only 16 pages in length but relies heavily on incorporation by reference of more than 850 pages from multiple requests for *inter partes* reexamination in the merged proceeding.

<sup>6</sup> Third party requester petition under 37 CFR 1.183 at page 1.

<sup>7</sup> *Id.* at page 3. The '1482 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1482 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

this petition are necessary to provide a reply the all of the issues raised by the Patent Owner's 279-page response.

Importantly, this waiver would not go beyond the 1:1 ratio proscribed [sic] for Patent Owner and Requester responses to Office Actions recited in 37 C.F.R. § 1.943(b). In fact, the Requester is asking for significantly fewer total pages than the Patent Owner has submitted (279 total pages for the Patent Owner while Requester is only asking for a total of 99 pages). Therefore in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all the arguments raised by the Patent Owner.<sup>8</sup>

The '1482 requester's September 14, 2011 comments submission includes: (1) a 99-page remarks section; (2) an 11-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" captioned for this merged proceeding (the merged proceeding Balanis declaration); (3) an 8-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" captioned for *inter partes* proceeding 95/001390 (the '1390 proceeding Balanis declaration); and (4) additional reference documents. In view of the guidance set forth herein, portions of the 11-page Balanis declaration for the merged proceeding and the 8-page Balanis declaration for the '1390 proceeding are deemed to include an extension of arguments of counsel. Thus, the 19 pages of the Balanis declarations are subject to the 50-page length requirement, in addition to 99-page remarks section<sup>9</sup> such that the '1482 requester's September 14, 2011 comments submission exceeds the regulatory page limit by up to 68 pages.

Based on the specific facts set forth in the '1482 requester's petition under 37 CFR 1.183, the '1482 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages), and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1482 requester's September 14, 2011 comments submission exceeds 50 pages. Accordingly, '1482 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting '1482 requester's comments submission to exceed the page limit by up to 68 pages. This waiver makes the '1482 requester's September 14, 2011 comments submission page-length compliant.

### III. Time Period for Submission of the '1497 and '586 Requesters' Comments

The '1497 and '586 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's August 15, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

<sup>8</sup> *Id.* at page 2. It is noted, however, as set forth in section I(A) above, patent owner's August 15, 2011 response submission has been determined to include up to 216 pages that count toward the regulatory page limit.

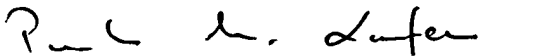
<sup>9</sup> The cover page is excluded from the page count, as is the table of contents pages.

- 1) is one-and-a-half or double-spaced;<sup>10</sup>
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

*See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.* Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

### CONCLUSION

1. Patent owner's August 15, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 166 pages. This waiver makes patent owner's August 15, 2011 response submission page-length compliant.
2. The '1482 requester's September 14, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '1482 requester's comments submission to exceed the regulatory page limit by up to 68 pages. This waiver makes '1482 requester's September 14, 2011 comments submission page-length compliant.
3. The '1497 and '586 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's August 15, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

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<sup>10</sup> Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,586 + 95/001,482 + 95/001,497	12/13/2010	7397431	3008.006REX1	5626
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-12-11

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San Diego, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000586 + 95/001482 + 95/001497  
PATENT NO. : 7397431  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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*Inter Partes* Reexamination Proceeding  
Control No. 95/000,586  
Filed: December 13, 2010  
For: U.S. Patent No.: 7,397,431

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,497  
Filed: December 03, 2010  
For: U.S. Patent No. 7,397,431

*Inter Partes* Reexamination Proceeding  
Control No: 95/001,482  
Filed: November 11, 2010  
For: U.S. Patent No. 7,397,431

**DECISION GRANTING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND  
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,497, filed on September 16, 2011, is granted.

*Inter partes* reexamination proceeding control number 95/001,497 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,497, 95/000,586 and 95/001,482.

*Inter partes* reexamination proceeding 95/001,497, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue** in the manner set forth in this decision.<sup>1</sup>

### DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,497 (the '1497 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,397,431 (the '431 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1497 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

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<sup>1</sup> This petition does not address the petition under 37 CFR 1.182 to terminate the '586 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.



§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28”. The “above listed claims” of one of the patents in suit, the ‘431 patent, which is the patent under reexamination in the ‘1497 proceeding, are listed in the consent judgment as claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31, which are identical to the claims that were requested to be reexamined by HTC in the ‘1497 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that “[a]ll of Fractus’ claims against HTC are dismissed with prejudice. All of HTC’s defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the ‘431 patent] are dismissed with prejudice”; and that “[t]he parties expressly waive their rights to appeal”. Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court’s decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that “[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the ‘1497 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit”. Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner’s September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

*Inter partes* reexamination proceeding control no. 95/001,497 (the ‘1497 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,497, 95/000,586 and 95/001,482.

*Inter partes* reexamination proceeding control no. 95/001,497 (the ‘1497 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue**.<sup>2</sup> Any rejection proposed by HTC (the requester of the ‘1497 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner “adopts” a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner’s determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner’s determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

<sup>2</sup> As pointed out above, this decision does not address the September 30, 2011 petition to terminate the ‘586 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.<sup>3</sup> As noted in the May 4, 2011 decision entitled “Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings” (the May 4, 2011 merger decision), because the requester of the ‘586 proceeding did not propose any rejections of claims 21, 24-26, and 30 in its request for reexamination, the requester of the ‘586 proceeding has no appeal rights as to those claims as they appear in the ‘431 patent.

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,586 and 95/001,482, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,586 and 95/001,482 will otherwise remain, in general, as outlined by the May 4, 2011 merger decision.

The ‘1497 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM “Application Number Information” screen and the “Contents” screen will be printed, the printed copy will be annotated by adding the comment “PROCEEDING CONCLUDED,” and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

### CONCLUSION

- Patent owner’s September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,497 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,497 (the ‘1497 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,497, 95/000,586 and 95/001,482.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue** in the manner set forth in this decision.
- The prosecution of the ‘1497 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The ‘1497 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the ‘1497 proceeding, as set forth in this decision.

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<sup>3</sup> A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester’s comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner’s amendment, if requester’s comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



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Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

Kenpet9



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,586	12/13/2010	7397431	3008.006REX1	5626
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,482	11/11/2010	7,397,431	3008.006REX0	6101
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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Date: **MAILED**  
**DEC 12 2011**  
**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001482  
PATENT NO. : 7397431  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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12531 High Bluff Dr., Suite 100

San Diego, CA 92130-2040

Date: **MAILED**

**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000586

PATENT NO. : 7397431

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1482 Requester)

**MAILED**

**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,586  
Filed: December 13, 2010  
For: U.S. Patent No.: 7,397,431

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,482  
Filed: November 11, 2010  
For: U.S. Patent No. 7,397,431

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND PETITION  
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:<sup>1</sup>

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,497, was granted. *Inter partes* reexamination proceeding 95/001,497 was severed from the merger of *inter partes* reexamination proceedings 95/001,497, 95/000,586 and 95/001,482, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,586 and 95/001,482.



## SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,586, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

## DECISION

### *The September 30, 2011 Petition to Terminate*

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,586 (the '586 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,397,431 (the '431 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '586 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '431 patent's claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27 and 29-31, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL” (emphasis in original),<sup>2</sup> The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.<sup>3</sup>

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to claims 1, 4, 5, 7, 8, 12, 13, 14, 17, 22, 27, 29 and 31 of the ‘431 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘586 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘586 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are

<sup>2</sup> The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

<sup>3</sup> If this is not the case, the patent owner is required to so inform the Office.

based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

### ***The September 30, 2011 Petition to Expunge***

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘586 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the ‘586 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.


The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

## CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,586 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

  
\_\_\_\_\_  
Brian E. Hanlon  
Director  
Office of Patent Legal Administration



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95/000,586	12/13/2010	7397431	3008.006REX1	5626
26111	7590	02/27/2012	EXAMINER	
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DATE MAILED: 02/27/2012

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San Diego, CA 92130-2040

Date:

MAR 10

FEB 27 2008

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000586 + 95001482  
PATENT NO. : 7397431  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FEB 27 2012

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
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Washington, D.C. 20005

(For Patent Owner)

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San Diego, CA 92130-2040

(For *Inter Partes* '586 Requester)

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1482 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,586  
Filed: December 13, 2010  
For: U.S. Patent No.: 7,397,431

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,482  
Filed: November 11, 2010  
For: U.S. Patent No. 7,397,431

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).<sup>1</sup>

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,482 (the '1482 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1482 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,497. *Inter partes* reexamination proceeding 95/001,497 was severed from the merger of *inter partes* reexamination proceedings 95/001,497, 95/000,586 and 95/001,482, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,586 and 95/001,482.



## SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,586 is **dismissed**.

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,586 (the '586 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,397,431 (the '431 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '586 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.<sup>2</sup> The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '586 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '586 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

### CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,586 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day

---

<sup>2</sup> For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/

Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration



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DALLAS, TX 75201

(For the '599 requester)

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130

(For the '587 requester)

*In re Puente Baliarda et al.*  
*Inter Partes* Reexamination  
Control No. 95/001,461  
Filed: October 1, 2010  
For: U.S. Patent No. 7,312,762

*In re Puente Baliarda et al.*  
*Inter Partes* Reexamination  
Control No. 95/000,599  
Filed: December 3, 2010  
For: U.S. Patent No. 7,312,762

*In re Puente Baliarda et al.*  
*Inter Partes* Reexamination  
Control No. 95/000,587  
Filed: December 15, 2010  
For: U.S. Patent No. 7,312,762

DECISION,  
SUA SPONTE,  
TO MERGE  
REEXAMINATION  
PROCEEDINGS

MAILED

JUN 01 2011

CENTRAL REEXAMINATION

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

## REVIEW OF FACTS

1. On December 25, 2007, the Office issued U.S. Patent No. 7,312,762 (the '762 patent) to Carles Puente Baliarda *et al.* with 21 claims.
2. On October 1, 2010, a request for *inter partes* reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent, was filed by a third party requester and assigned control No. 95/001,461 ("the '1461 proceeding"). The request identified Samsung Electronics Co., Ltd. (hereinafter "the '1461 requester") as the real party in interest.
3. On November 12, 2010, a second request for *inter partes* reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent, assigned control No. 95/000,587 ("the '587 proceeding"), was filed by a third party requester. The request identified Kyocera Communications, Inc. ("the '587 requester") as the real party in interest.
4. On November 19, 2010, *inter partes* reexamination of the '762 patent was granted-in-part in the '1461 proceeding. Reexamination was granted for claims 12, 14-15, and 17 of the '762 patent, and was denied for claims 1, 7-8, 11, and 21 of the '762 patent. An Office action was not concurrently issued. The order stated that an Office action would issue in due course.
5. On December 3, 2010, a third request for *inter partes* reexamination of claims 1, 8, 11 and 21 of the '762 patent, assigned control No. 95/000,599 ("the '599 proceeding"), was filed by a third party requester. The request identified HTC Corp. and HTC America, Inc. ("the '599 requester") as the real party in interest.
6. On December 20, 2010, the '1461 requester petitioned for supervisory review of the November 19, 2010 Order with regard to the denial of reexamination for claims 1, 7-8, 11 and 21 of the '762 patent in the '1461 proceeding. The petition requested that reexamination of claims 1, 7-8, 11 and 21 be ordered in the '1461 proceeding.
7. On January 21, 2011, the Office issued a decision granting the December 20, 2010 '1461 requester petition and ordering reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent in the '1461 proceeding.
8. On February 10, 2011, *inter partes* reexamination was ordered on claims 1, 8, 11, and 21 of the '762 patent in the '599 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
9. On February 11, 2011, *inter partes* reexamination was ordered on claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent in the '587 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

10. To date, no Office action has issued in any of the three *inter partes* reexamination proceedings ordered for the '762 patent.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination is ordered in the three above-captioned proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/001,461, 95/000,599 and 95/000,587 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

### III. CONDUCT OF MERGED PROCEEDING

#### A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

#### B. *Inter partes* Third Party Requester Participation:

##### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the

---

<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

statutory time period of 30 days from date of service of patent owner's response.

## 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of *rejection* can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '599 *inter partes* third party requester did not propose any rejections of claims 7, 12, 14-15, and 17 in their request for reexamination, the '599 requester has no appeal rights as to those claims as they appear in the '762 patent.

### C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to:           Attn: Mail Stop "*Inter Partes* Reexam"

Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900  
Central Reexamination Unit

by Hand to: Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

by EFS: Registered users may submit papers via the  
electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim. Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged



multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:


Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/001,461, 95/000,599 and 95/000,587 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

May 31, 2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,587	12/15/2010	7312762	3008.004REX1	3841

26111 7590 07/07/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/07/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER, LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date:

**MAILED**

**JUL 07 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000587

PATENT NO. : 7312762

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>Decision on Petition for Extension of Time in Reexamination</b>	Control No.: 95/000,587 & 95/000,599 & 95/001,461
--	--

1. THIS IS A DECISION ON THE PETITION FILED 05 July 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action dated 07 June 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

A. ☒ Petition fee per 37 CFR §1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☐ Petition includes authorization to charge a credit card account.

iii. ☐ Other: \_\_\_\_\_.

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).

B. ☒ Other/comment: see attached

C. ☐ Dismissed because:

i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).

ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☐ Other/comment: \_\_\_\_\_.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[Signature]	(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the large number of related reexamination proceedings prosecuted at the same time as the instant proceedings as well as the length and complexity of the Office action. It is agreed that patent owner needs to be given opportunity to fully explore all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management with respect to workload resulting from related proceedings. Resource management takes into consideration the time required to respond to other Office actions.

While the additional workload from other proceedings is noted, it is the length and complexity of the office action that weighs most heavily in consideration of whether the patent owner has met the burden of providing "sufficient cause" for supporting the granting of an extension of time.

MPEP 2665 states, "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added.)

On balance, the petition for extension of time supports "sufficient cause" to grant a one (1) month extension of time.

The petition for extension of time is hereby granted-in-part



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,587 + 95/000,599 + 95/001,461	12/15/2010	7312762	3008.004REX1	3841
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-12-11

MORRISON & FOERSTER, LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000587 + 95/000599 + 95/001461  
PATENT NO. : 7312762  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox, P.L.L.C. (For Patent Owner)  
1100 New York Avenue, N.W.  
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(For *Inter Partes* '587 Requester)

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Dallas, TX 75201-2980

(For *Inter Partes* '599 Requester)

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1461 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,587  
Filed: December 15, 2010  
For: U.S. Patent No.: 7,312,762

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,599  
Filed: December 03, 2010  
For: U.S. Patent No. 7,312,762

*Inter Partes* Reexamination Proceeding  
Control No: 95/001,461  
Filed: October 01, 2010  
For: U.S. Patent No. 7,312,762

**DECISION GRANTING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND  
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,599, filed on September 16, 2011, is **granted**.



*Inter partes* reexamination proceeding control number 95/000,599 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/000,599, 95/000,587 and 95/001,461.

*Inter partes* reexamination proceeding 95/000,599, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue** in the manner set forth in this decision.<sup>1</sup>

### DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,599 (the '599 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,312,762 (the '762 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '599 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

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<sup>1</sup> This petition does not address the petition under 37 CFR 1.182 to terminate the '587 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '762 patent, which is the patent under reexamination in the '599 proceeding, are listed in the consent judgment as claims 1, 7, 8, 11, 12, 14, 15, 17, and 21, which include all of the claims that were determined to be subject to reexamination in the '599 proceeding (i.e., claims 1, 8, 11 and 21), and all of which are under reexamination in the merged proceeding.<sup>2</sup> The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '762 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '599 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

*Inter partes* reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,599, 95/000,587 and 95/001,461.

*Inter partes* reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue**.<sup>3</sup> Any rejection proposed by HTC (the requester of the '599 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or

<sup>2</sup> Claims 1, 8, 11, 12 and 21 were requested by HTC to be reexamined in the '599 proceeding. The Office determined, however, that no SNQ was raised by the request as to claim 12. For this reason, the claims that are subject to reexamination in the '599 proceeding are claims 1, 8, 11, and 21.

<sup>3</sup> As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '587 proceeding which is presently pending. This petition will be addressed by a separate decision.

otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.<sup>4</sup>

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,587 and 95/001,461, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,587 and 95/001,461 will otherwise remain, in general, as outlined by the decision, mailed on June 01, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '599 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

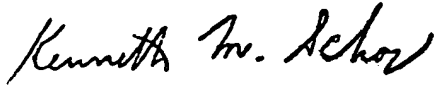
### CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,599 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,599, 95/000,587 and 95/001,461.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue** in the manner set forth in this decision.
- The prosecution of the '599 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '599 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '599 proceeding, as set forth in this decision.

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<sup>4</sup> A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



---

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

Kenpet9



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,587	12/15/2010	7312762	3008.004REX1	3841
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,461	10/01/2010	7,312,762	3008.004REX0	1170
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
NOVAK DRUCE & QUIGG, LLP  
1000 LOUISIANA STREET  
53rd FLOOR  
HOUSTON, TX 77002

**MAILED**

Date: DEC 12 2011

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001461  
PATENT NO. : 7312762  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

MORRISON & FOERSTER, LLP

**MAILED**

12531 HIGH BLUFF DRIVE

**DEC 12 2011**

SUITE 100

SAN DIEGO, CA 92130-2040

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000587

PATENT NO. : 7312762

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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1100 New York Avenue, N.W.  
Washington, D.C. 20005

(For Patent Owner)

**MAILED**

Morrison & Foerster, LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, CA 92130-2040

(For *Inter Partes* '587 Requester) DEC 12 2011

**CENTRAL REEXAMINATION UNIT**

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1461 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,587  
Filed: December 15, 2010  
For: U.S. Patent No.: 7,312,762

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,461  
Filed: October 01, 2010  
For: U.S. Patent No. 7,312,762

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND PETITION  
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:<sup>1</sup>

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,599, was granted. *Inter partes* reexamination proceeding 95/000,599 was severed from the merger of *inter partes* reexamination proceedings 95/000,599, 95/000,587 and 95/001,461, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,587 and 95/001,461.

## SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,587, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

## DECISION

### *The September 30, 2011 Petition to Terminate*

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,587 (the '587 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,312,762 (the '762 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '587 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '762 patent's claims 1, 7, 8, 11, 12, 14, 15, 17 and 21, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL” (emphasis in original).<sup>2</sup> The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.<sup>3</sup>

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the ‘762 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘587 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘587 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are

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<sup>2</sup> The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

<sup>3</sup> If this is not the case, the patent owner is required to so inform the Office.

based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

### ***The September 30, 2011 Petition to Expunge***

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘587 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the ‘587 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.

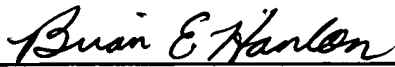
The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

## CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,587 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script, reading "Brian E. Hanlon", written in dark ink.

---

Brian E. Hanlon  
Director  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,587	12/15/2010	7312762	3008.004REX1	3841
26111	7590	02/08/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/08/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER, LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date: **MAILED**

**FEB 08 2012**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000587

PATENT NO. : 7312762

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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(For Patent Owner)

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(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA AVE.  
53<sup>RD</sup> FLOOR  
HOUSTON, TX 77002

(For '1461 Requester)

MAILED

FEB 08 2012

CENTRAL REEXAMINATION UNIT

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130

(For the '587 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,461  
Filed: October 1, 2010  
For: U.S. Patent No. 7,312,762

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**DECISION GRANTING  
PETITION UNDER  
37 CFR 1.183**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,587  
Filed: November 12, 2010  
For: U.S. Patent No. 7,312,762

This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on September 7, 2011 in reexamination proceeding control nos. 95/000,587, 95/000,599 and 95/001,461.

The patent owner petition is before the Office of Patent Legal Administration.

The patent owner petition under 37 CFR 1.183 is **granted**, for the reasons set forth herein.

**BACKGROUND**

1. On December 25, 2007, United States Patent No. 7,312,762 (the '762 patent) issued to Puente Ballarda *et al.*

2. Subsequently, three requests for *inter partes* reexamination of the '762 patent were filed, which requests were assigned Reexamination Control Nos. 95/001,461, 95/000,587, and 95/000,599, and for each of which reexamination was instituted by the Office.
3. On June 1, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1461 proceeding with the '587 and '599 proceedings (the merged proceeding).
4. June 7, 2011, the Office issued a non-final Office action in the merged proceeding.
5. On September 7, 2011, the patent owner timely filed a response submission in the merged proceeding, concurrently with the instant petition under 37 CFR 1.183.<sup>1</sup>
6. On December 12, 2011, the Office issued a "DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER," terminating the 95/000,599 proceeding and severing the 95/000,599 proceeding from the merged proceeding.<sup>2</sup>

## DECISION

### I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give

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<sup>1</sup> On July 7, 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the June 7, 2011 Office Action.

<sup>2</sup> The merged proceeding continues as to the '1461 and '587 proceedings.

rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of September 7, 2011

On September 7, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission.<sup>3</sup> Patent owner asserts that the argument portion of the September 7, 2011 response submission is 81 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.<sup>4</sup> Patent owner states that it concurrently filed a "132 Declaration" with the response submission but asserts that the declaration is "drawn to fact, not argument, and thus does not count towards the 50-page limit."<sup>5</sup> Nonetheless, patent owner also requests waiver of the 50-page limit "as to those portions of the

<sup>3</sup> Because the '599 proceeding has been terminated, this decision does not address the instant petition with respect to the '599 proceeding.

<sup>4</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>5</sup> *Id.* at page 4 (identifying a copy of the declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 (17 pages)).

132 Declaration that the PTO holds count towards the 50 page limit.”<sup>6</sup> Patent owner asserts that both the response and the declaration satisfy formatting guidelines for waiver of the regulatory page limit.<sup>7</sup>

In support of its request for waiver of the rule, patent owner asserts that the declaration filed with the September 7, 2011 response submission does not include argument or opinions that would be counted towards the 50-page limit.<sup>8</sup> Additionally, patent owner asserts that “the full length of the Response is needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 18 pages, it incorporates by reference almost 400 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”<sup>9</sup> Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>10</sup>

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),<sup>11</sup> and the individual facts and circumstances of this case (such as the length of the June 7, 2011 Office action),<sup>12</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s September 7, 2011 response submission. This waiver makes patent owner’s September 7, 2011 response submission page-length compliant.

### ADDITIONAL DISCUSSION

The 95/001,461 third party requester and the 95/000,587 third party requester have 30 days from the date of this decision, granting patent owner’s September 7, 2011 petition under 37 CFR 1.183 and entering patent owner’s September 7, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides (emphasis added):

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<sup>6</sup> Id. at page 2.

<sup>7</sup> Id. at pages 2 and 6 (stating that the response and declaration satisfy “the following requirements: (1) double spaced; (2) non-script type font; (3) font size no smaller than 12-point; (4) conforms to the margin requirements of 37 C.F.R. § 1.52(a)(1)(ii); and (5) sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.”).

<sup>8</sup> Id. at pages 4-5.

<sup>9</sup> Id. at page 2-3.

<sup>10</sup> Id. at page 3.

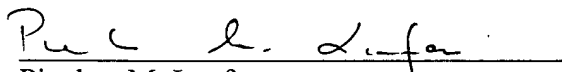
<sup>11</sup> Pages 12-94 of the remarks portion of patent owner’s September 7, 2011 response submission count toward the page limit (the cover page and table of contents pages are excluded from the page count, as is the 5-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the patent owner’s September 7, 2011 response submission exceeds the 50-page limit by at least 33 pages, without including any portions of the 17-page declaration that also count toward the page limit.

<sup>12</sup> On its face, the substantive portion of the June 7, 2011 Office action spans only approximately 14 pages, but in setting forth the rejections that have been adopted, it incorporates by reference over 180 pages from the ‘587, ‘599 and ‘1461 requests for *inter partes* reexamination.

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

### CONCLUSION

1. Patent owner's September 7, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's September 7, 2011 response submission. This waiver makes patent owner's September 7, 2011 response submission page-length compliant.
2. The 95/001,461 third party requester and the 95/000,587 third party requester each has 30 days from the mailing date of this decision, granting patent owner's September 7, 2011 petition under 37 CFR 1.183 and entering patent owner's September 7, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,587	12/15/2010	7312762	3008.004REX1	3841
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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SUITE 100

SAN DIEGO, CA 92130-2040

Date:

**MAILED**

**FEB 27 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000587 + 95001461

PATENT NO. : 7312762

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
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(For Patent Owner)

MAILED

FEB 27 2012

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(For *Inter Partes* '1461 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,587  
Filed: December 15, 2010  
For: U.S. Patent No.: 7,312,762

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,461  
Filed: October 01, 2010  
For: U.S. Patent No. 7,312,762

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).<sup>1</sup>

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,461 (the '1461 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1461 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,599. *Inter partes* reexamination proceeding 95/000,599 was severed from the merger of *inter partes* reexamination proceedings 95/000,599, 95/000,587 and 95/001,461, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,587 and 95/001,461.



## SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,587 is **dismissed**.

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,587 (the '587 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,312,762 (the '762 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '587 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with

the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). As discussed in the December 12, 2011 decision dismissing patent owner’s September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.<sup>2</sup> The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court’s consent judgment to the Office and to disclose the court’s consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the ‘587 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner’s arguments, and requester’s opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the ‘587 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner’s response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

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<sup>2</sup> For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

### CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,587 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/  
Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628
26111	7590	05/11/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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United States Patents and Trademark Office  
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
MORRISSON & FOESTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2050

Date: **MAILED**  
**MAY 11 2011**  
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000588  
PATENT NO. : 7394432  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>Decision on Petition for Extension of Time in Reexamination</b>	Control No.: 95/000,588 & 95/001,483 & <del>95/001,500</del>
--	---

**MAILED** AK

1. THIS IS A DECISION ON THE PETITION FILED 04 May 2011. MAY 11 2011

2. THIS DECISION IS ISSUED PURSUANT TO: CENTRAL REEXAMINATION UNIT

A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.  
 The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS  
 Patent owner requests that the period for responding to the Office action dated 07 April 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) month.

A. ☒ Petition fee per 37 CFR §1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☐ Petition includes authorization to charge a credit card account.

iii. ☐ Other: \_\_\_\_\_.

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).

B. ☒ Other/comment: see attached

C. ☐ Dismissed because:

i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).

ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☐ Other/comment: \_\_\_\_\_.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/  
 [Signature]

SPE, AU 3992 Central Reexamination Unit  
 (Title)

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the length and complexity of the Office action and speed at which Office action was prepared. The petitioner also noted other proceedings for which reexamination was granted. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time. Additionally, the speed at which the Office action was prepared is required to meet the requirements of "special dispatch." All of that said, the length and complexity of the Office action does warrant consideration.

MPEP 2665 states, "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added).

On balance the petition for extension of time supports "sufficient cause" to grant a one (1) month extension of time.

The petition for extension of time is hereby granted-in-part



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628
26111	7590	03/17/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

Please find below and/or attached an Office communication concerning this application or proceeding.





UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450  
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
MORRISSON & FOESTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2050

Date:  
**MAILED**

**MAR 17 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000588  
PATENT NO. : 7394432  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128
26111	7590	03/17/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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United States Patents and Trademark Office  
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
NOVAK DRUCE & QUIGG, LLP  
(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

Date:

MAILED

MAR 17 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001483  
PATENT NO. : 7394432  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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United States Patent and Trademark Office  
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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,500	12/03/2010	7394432	3008.007REX2	7084
26111	7590	03/17/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD., SUITE 1500

AUSTIN, TX 78701-4039

Date:

**MAILED**

**MAR 17 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001500

PATENT NO. : 7394432

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAR 17 2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

(For Patent Owner)

NOVAK DRUCE & QUIGG, LLP  
(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For first *Inter Partes* Requester)

MORRISON & FOERSTER LLP  
1253 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

(For second *Inter Partes* Requester)

BAKER BOTTS L.L.P.  
PATENT DEPARTMENT  
98 SAN JACINTO BLVD., SUITE 1500  
AUSTIN, TX 78701-4039

(For third *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,483  
Filed: November 11, 2010  
For: U.S. Patent No. 7,394,432

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,588  
Filed: December 13, 2010  
For: U.S. Patent No. 7,394,432

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,500  
Filed: December 3, 2010  
For: U.S. Patent No. 7,394,432

DECISION,  
*SUA SPONTE*,  
TO MERGE  
REEXAMINATION  
PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

## REVIEW OF RELEVANT FACTS

1. On July 1, 2008, the Office issued U.S. Patent No. 7,394,432 (the '432 patent) to Carlos Puente Baliarda *et al.* with 6 claims.
2. On November 11, 2010, a first request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/001,483 ("the '1483 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1483 requester").
3. On November 12, 2010, a second request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/000,588 ("the '588 proceeding"), was initially deposited by a third party requester real party in interest Kyocera Communications, Inc. ("the '588 requester"), and a corrected request was filed on December 13, 2010.
4. On December 3, 2010, a third request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/001,500 ("the '1500 proceeding"), was filed by a third party requester on behalf of real party in interest HTC Corp. and HTC America, Inc. ("the '1500 requester").
5. On December 14, 2010, *inter partes* reexamination was ordered on claims 1-3 and 6 of the '432 patent in the '1483 proceeding.
6. On January 20, 2011, two orders for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent were issued, for the '588 and '1500 proceedings, respectively.
7. To date, no Office action has issued in any of the three *inter partes* reexamination proceedings ordered for the '432 patent.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination is ordered in the three above-captioned proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/000,588, 95/001,483 and 95/001,500 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

## II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

### B. *Inter partes* Third Party Requester Participation:

#### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

#### 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

---

<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.



Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900  
Central Reexamination Unit

by Hand to: Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

by EFS: Registered users may submit papers via the  
electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

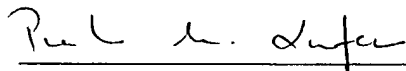
#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each

rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,588, 95/001,483 and 95/001,500 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



---

Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

March 17, 2011

## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Sterne, Kessler, Goldstein & Fox P.L.L.C.  
1100 New York Ave., N.W.  
Washington, DC 20005

(For Patent Owner)

Novak Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana St., 53<sup>rd</sup> Floor  
Houston, TX 77002

(For '1483 *Inter Partes* Requester)

Baker Botts L.L.P.  
Patent Department  
98 San Jacinto Blvd., Suite 1500  
Austin, TX 78701-4039

(For '1500 *Inter Partes* Requester)

Morrison & Foerster LLP  
12531 High Bluff Drive, Suite 100  
San Diego, California 92130-2040

(For '0588 *Inter Partes* Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,483  
Filed: November 11, 2010  
For: U.S. Patent No. 7,394,432

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,500  
Filed: December 3, 2010  
For: U.S. Patent No. 7,394,432

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,588  
Filed: December 13, 2010  
For: U.S. Patent No. 7,394,432

**MAILED**

SEP 20 2011

**CENTRAL REEXAMINATION UNIT**

: DECISION  
: GRANTING  
: PETITIONS

This is a decision on the following petitions:

1. Patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on July 7, 2011.
2. The '1483 requester paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on August 8, 2011.

Both petitions are before the Office of Patent Legal Administration for consideration.

Both petitions under 37 CFR 1.183 are granted for the reasons set forth herein.

## BACKGROUND

1. On July 1, 2008, United States Patent No. 7,394,432 (the '432 patent) issued to Baliarda et al.
2. On November 11, 2010, a first request for *inter partes* reexamination of the '432 patent was filed by a third party requester (the '1483 requester), which request was assigned Reexamination Control No. 95/001,483 (the '1483 proceeding).
3. On November 12, 2010, a second request for *inter partes* reexamination of the '432 patent, assigned Reexamination Control No. 95/000,588 (the '0588 proceeding), was initially deposited by a third party requester (the '0588 requester), and a corrected request was filed on December 13, 2010.
4. On December 3, 2010, a third request for *inter partes* reexamination of the '432 patent was filed by a third party requester (the '1500 requester), which request was assigned Reexamination Control No. 95/001,500 (the '1500 proceeding).
5. On December 14, 2010, the Office ordered reexamination in the '1483 proceeding.
6. On January 20, 2011, the Office ordered reexamination in the '0588 and '1500 proceedings.
7. On March 17, 2011, the Office issued a decision merging, *sua sponte*, the '1483, '1500 and '0588 proceedings (the merged proceeding).
8. On April 7, 2011, the Office issued a non-final action in the merged proceeding.
9. On July 7, 2011, the patent owner filed a response in the merged proceeding, concurrently with the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).<sup>1</sup>
10. On August 8, 2011, the '1483 requester filed comments, concurrently with the instant petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" ('1483 requestor petition under 37 CFR 1.183).

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<sup>1</sup> On May 11, 2011, the Office mailed a decision granting patent owner's May 4, 2011 request for extension of time, extending the time period for patent owner's response by 1 month to July 7, 2011.

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Petitions Under 37 CFR 1.183

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide

a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count

#### A. Patent Owner Petition Under 37 CFR 1.183

On July 7, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its July 7, 2011 response submission. In support of its request for waiver of the rule, patent owner "asserts that justice would be served by granting waiver of the 50-page limit, because the full length of the Response is needed to fully and adequately respond to the Office Action."<sup>2</sup> Further, patent owner asserts:

This reexamination proceeding represents the merger of three *Inter Partes* reexaminations. Thus, the Office Action is based on the combination of three *Inter Partes* reexamination requests and grants. Specifically, the Office Action includes 20 separate grounds of rejection over 13 separate references. . . . While the pending Office action constitutes only 13 pages, it incorporates by reference over 500 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination. It would be unjust to hold the Patent Owner to only 50 pages to respond to what is essentially three Office Actions, particularly given the size and complexity of the three *Inter Partes* reexamination requests upon which they are based."<sup>3</sup>

In addition to stating that the response satisfies the formatting requirements for a grantable petition under 37 CFR 1.183, patent owner asserts that it has "made a good faith effort to comply with the 50-page limit, making efforts to economize, avoid extraneous material and information already of record, and present arguments efficiently . . . . Despite these efforts, the argument portion of the Response exceeds the 50-page limit."<sup>4</sup>

Patent owner's July 7, 2011 response submission includes: (1) a remarks portion, (2) an 11-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132", (3) a 15-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 Relating to Fractal and Multilevel Antennas", (4) a 9-page declaration entitled "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera, and Jordi Soler Under 37 C.F.R. § 1.132", (5) a 9-page declaration entitled "Declaration of Ruben Bonet Under 37 C.F.R. § 1.132", and (6) a 36-page declaration entitled "Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132" (the Mittra declaration). In view of the guidance set forth herein, portions of the 36-page Mittra declaration are deemed to include an extension of arguments of counsel. Thus, the Mittra declaration is subject to the 50-page length requirement, in addition to 96 pages of the remarks portion<sup>5</sup> such

<sup>2</sup> See patent owner petition at page 2.

<sup>3</sup> See *id.* at pages 2-3.

<sup>4</sup> See *id.*

<sup>5</sup> The cover page is excluded from the page count, as is the listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count.

that patent owner's July 7, 2011 response submission exceeds the regulatory page limit by up to 82 pages.

Based on the individual facts and circumstances of this case such as, for example, the size of the April 7, 2011 Office action, including the incorporation by reference of pages from multiple requests for reexamination in the merged proceeding,<sup>6</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's response submission exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 7, 2011 response submission to exceed the regulatory page limit by up to 82 pages. This waiver makes patent owner's July 7, 2011 response submission page-length compliant.

#### **B. The '1483 Requester's Petition Under 37 CFR 1.183**

On August 8, 2011, the '1483 requester filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its August 8, 2011 comments submission. The '1483 requester asserts that the August 8, 2011 comments submission includes "70 pages of double spaced 12 pt font arguments and a 11 page declaration from Dr. Balanis under 37 C.F.R. § 1.132."<sup>7</sup> The '1483 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 70 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue" such that no waiver would be needed.<sup>8</sup>

In support of its request for waiver of the rule, the '1483 requester asserts:

Samsung has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit. The additional pages requested in this petition are necessary to provide a reply the all of the issues raised by the Patent Owner's 176 page response.

Importantly, this waiver would not go beyond the 1:1 ratio proscribed [sic] for Patent Owner and Requester responses to Office Actions recited in 37 C.F.R. §

<sup>6</sup> See April 7, 2011 Office action which, on its face, spans only 11 pages in length but relies heavily on incorporation by reference of more than 500 pages from multiple requests for *inter partes* reexamination in the merged proceeding.

<sup>7</sup> Third party requester petition under 37 CFR 1.183 at page 1.

<sup>8</sup> *Id.* at page 4. The '1483 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1483 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.



1.943(b). In fact, the Requester is asking for significantly fewer total pages than the Patent Owner has submitted (176 total pages for the Patent Owner while Requester is only asking for a total of 81 pages). Therefore in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all the arguments raised by the Patent Owner.<sup>9</sup>

The '1483 requester's August 8, 2011 comments submission includes: (1) a remarks portion and (2) an 11-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" (the Balanis declaration), and (3) additional reference materials. In view of the guidance set forth herein, portions of the 11-page Balanis declaration are deemed to include an extension of arguments of counsel. Thus, the 11-page Balanis declaration is subject to the 50-page length requirement, in addition to 70 pages of the remarks portion<sup>10</sup> such that the '1483 requester's August 8, 2011 comments submission exceeds the regulatory page limit by up to 31 pages.

Based on the specific facts set forth in the '1483 requester's petition under 37 CFR 1.183, the '1483 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages), and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1483 requester's August 8, 2011 comments submission exceeds 50 pages. Accordingly, '1483 requestor's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting '1483 requester's comments submission to exceed the page limit by 31 pages. This waiver makes the '1483 requester's August 8, 2011 comments submission page-length compliant.

### III. Time Period for Submission of the '1500 and '0588 Requesters' Comments

The '1500 and '0588 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 7, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

- 1) is one-and-a-half or double-spaced;<sup>11</sup>
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and

<sup>9</sup> *Id.* at page 2. It is noted, however, as set forth in section I(A) above, patent owner's July 7, 2011 response submission has been determined to include up to 132 pages that count toward the regulatory page limit.

<sup>10</sup> The cover page is excluded from the page count, as is the table of contents pages.

<sup>11</sup> Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

*See, generally,* 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

### CONCLUSION

1. Patent owner's July 7, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 82 pages. This waiver makes patent owner's July 7, 2011 response submission page-length compliant.
2. The '1483 requester's August 8, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '1483 requester's comments submission to exceed the regulatory page limit by up to 31 pages. This waiver makes '1483 requester's August 8, 2011 comments submission page-length compliant.
3. The '1500 and '0588 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 7, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

09-19-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588 <del>95/001,483</del> 95/001,500	12/13/2010	7394432	3008.007REX1	3628
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-12-11

MORRISSON & FOESTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2050

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000588 + 95/601483 + 95/001500  
PATENT NO. : 7394432  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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DEC 12 2011

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**CENTRAL REEXAMINATION UNIT**

Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
1100 New York Avenue, N.W.  
Washington, D.C. 20005

(For Patent Owner)

Morrison & Foerster, LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, CA 92130-2040

(For *Inter Partes* '588 Requester)

Baker Botts, LLP  
2001 Ross Avenue  
Suite 600  
Dallas, TX 75201-2980

(For *Inter Partes* '1500 Requester)

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1483 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,588  
Filed: December 13, 2010  
For: U.S. Patent No.: 7,394,432

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,500  
Filed: December 03, 2010  
For: U.S. Patent No. 7,394,432

*Inter Partes* Reexamination Proceeding  
Control No: 95/001,483  
Filed: November 11, 2010  
For: U.S. Patent No. 7,394,432

**DECISION GRANTING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND  
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,500, filed on September 16, 2011, is **granted**.

*Inter partes* reexamination proceeding control number 95/001,500 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,500, 95/001,483 and 95/000,588.

*Inter partes* reexamination proceeding 95/001,500, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue** in the manner set forth in this decision.<sup>1</sup>

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,500 (the ‘1500 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,394,432 (the ‘432 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that “. . . HTC [the defendant/requester of the ‘1500 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit” and that “[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

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<sup>1</sup> This petition does not address the petition under 37 CFR 1.182 to terminate the ‘588 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28”. The “above listed claims” of one of the patents in suit, the ‘432 patent, which is the patent under reexamination in the ‘1500 proceeding, are listed in the consent judgment as claims 1-3 and 6, which are identical to the claims that were requested to be reexamined by HTC in the ‘1500 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that “[a]ll of Fractus’ claims against HTC are dismissed with prejudice. All of HTC’s defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the ‘432 patent] are dismissed with prejudice”, and that “[t]he parties expressly waive their rights to appeal”. Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court’s decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that “[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the ‘1500 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit”. Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner’s September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

*Inter partes* reexamination proceeding control no. 95/001,500 (the ‘1500 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,500 , 95/001,483 and 95/000,588.

*Inter partes* reexamination proceeding control no. 95/001,500 (the ‘1500 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue**.<sup>2</sup> Any rejection proposed by HTC (the requester of the ‘1500 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner “adopts” a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner’s determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner’s determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

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<sup>2</sup> As pointed out above, this decision does not address the September 30, 2011 petition to terminate the ‘588 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.<sup>3</sup>

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/001,483 and 95/000,588, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/001,483 and 95/000,588 will otherwise remain, in general, as outlined by the decision, mailed on March 17, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '1500 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

### CONCLUSION

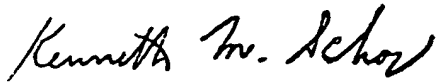
- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,500 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,500 (the '1500 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,500, 95/001,483 and 95/000,588.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue** in the manner set forth in this decision.
- The prosecution of the '1500 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1500 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1500 proceeding, as set forth in this decision.

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<sup>3</sup> A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.



- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



---

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

Kenpet9



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628

26111 7590 12/12/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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SAN DIEGO, CA 92130-2050

**MAILED**  
Date:  
**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000588  
PATENT NO. : 7394432  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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HOUSTON, TX 77002

Date: **MAILED**

**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001483  
PATENT NO. : 7394432  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
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(For *Inter Partes* '588 Requester)

**MAILED**

**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1483 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,588  
Filed: December 13, 2010  
For: U.S. Patent No.: 7,394,432

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,483  
Filed: November 11, 2010  
For: U.S. Patent No. 7,394,432

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND PETITION  
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:<sup>1</sup>

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,500, was granted. *Inter partes* reexamination proceeding 95/001,500 was severed from the merger of *inter partes* reexamination proceedings 95/001,500, 95/000,588 and 95/001,483, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,588 and 95/001,483.

## SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,588, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

## DECISION

### *The September 30, 2011 Petition to Terminate*

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,588 (the '588 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,394,432 (the '432 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '588 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '432 patent's claims 1, 2, 3 and 6, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL” (emphasis in original).<sup>2</sup> The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.<sup>3</sup>

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the ‘432 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘588 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘588 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are

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<sup>2</sup> The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

<sup>3</sup> If this is not the case, the patent owner is required to so inform the Office.



based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

#### ***The September 30, 2011 Petition to Expunge***

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘588 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the ‘588 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.


The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

## CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,588 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script, reading "Brian E. Hanlon", positioned above a horizontal line.

Brian E. Hanlon  
Director  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000588 + 95001483

PATENT NO. : 7394432

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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4/6/12

FEB 27 2012

CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* '1483 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,588  
Filed: December 13, 2010  
For: U.S. Patent No.: 7,394,432

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,483  
Filed: November 11, 2010  
For: U.S. Patent No. 7,394,432

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).<sup>1</sup>

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,483 (the '1483 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1483 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,500. *Inter partes* reexamination proceeding 95/001,500 was severed from the merger of *inter partes* reexamination proceedings 95/001,500, 95/000,588 and 95/001,483, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,588 and 95/001,483.

## SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,588 is **dismissed**.

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,588 (the '588 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,394,432 (the '432 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '588 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.<sup>2</sup> The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '588 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '588 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

### CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,588 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day

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<sup>2</sup> For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.



period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/

Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628
26111	7590	03/05/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

MORRISON & FOESTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2050

MAILED

MAR 05 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000588 + 95001403

PATENT NO. : 7394432

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Robert Greene Sterne : (For Patent Owner)  
STERNE, KESSLER, GOLDSTEIN :  
& FOX P.L.L.C. :  
1100 NEW YORK AVE., NW :  
WASHINGTON, DC 20005 :

MORRISON & FOERSTER, LLP : (For '588 Third Party  
12531 HIGH BLUFF DRIVE : Requester)  
SUITE 100 :  
SAN DIEGO, CA 92130 :

NOVAK DRUCE & QUIGG, LLP : (For '1483 Third Party  
(NDQ REEXAMINATION GROUP) : Requester)  
1000 LOUISIANA STREET :  
53<sup>RD</sup> FLOOR :  
HOUSTON, TX 77002 :

*In re: Puente Baliarda et al.* :  
*Inter Partes* Reexamination Proceeding : DECISION ON PETITION  
Control No.: 95/000,588 : UNDER 37 CFR § 1.181  
Deposited: December 13, 2010 :  
For: U.S. Patent No.: 7,394,432 :

*In re: Puente Baliarda et al.* :  
*Inter Partes* Reexamination Proceeding :  
Control No.: 95/001,483 :  
Deposited: November 11, 2010 :  
For: U.S. Patent No.: 7,394,432 :

This is a decision on a petition filed by the patent owner on January 4, 2012 entitled "Petition Under 37 C.F.R. § 1.181 for Reopening of Prosecution" [hereinafter "petition"] and is a request that the Action-Closing Prosecution be withdrawn and that the Office issue a new non-final action.

The petition is before the Director of the Central Reexamination Unit. Also before the Director is the opposition filed February 3, 2012.

The petition is granted.

MAILED  
MAY 05 2012  
CENTRAL REEXAMINATION UNIT

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,394,432 issued on July 1, 2008.
- Three requests for *inter partes* reexamination were filed and assigned control numbers 95/000,588, 95/001,483 and 95/001,500.
- Reexamination was ordered in each proceeding and the three were merged in a decision mailed March 17, 2011.
- Prosecution progressed until an Action Closing Prosecution was mailed November 4, 2011.
- On December 12, 2011, the Office issued a decision terminating 95/001,500 and severing it from the merged proceeding. 95/000,588 and 95/001,483 remain merged.
- On January 4, 2012, the patent owner filed the instant petition with a response to the ACP.
- On February 3, 2012, the third party filed an opposition to the petition.

## STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

### **37 C.F.R. § 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination**

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

## DECISION

Patent owner claims that the Action Closing Prosecution was improper because it included new grounds of rejection that were not necessitated by amendment. In the first Office action mailed April 7, 2011, the examiner rejected claim 1 as anticipated by Serizawa, but did not reject claims 2, 3 and 6 under that ground. The patent owner, in response, did not amend the claims. In the ACP, the examiner again rejected claim 1 as anticipated by Serizawa, but additionally rejected claims 2, 3 and 6 under that ground. This rejection of claims 2, 3 and 6 as anticipated by Serizawa was a new ground of rejection that was not necessitated by amendment. Accordingly, the action should not have been an ACP and the petition is granted. The ACP is withdrawn and replaced as discussed further herein.

### *Relief Granted*

A new ACP is issued concurrently with this decision, removing the rejection of claims 2, 3 and 6 as anticipated by Serizawa.

Patent owner urges that the ACP should be replaced with a non-final Office action, or that the ACP be reissued and patent owner's previous response should be expunged from the record. The third party in the opposition argued that, if the new rejections were withdrawn, the Office may issue a Right of Appeal Notice. The Director disagrees with both parties.

Patent owner's argument that a new non-final action issue was apparently premised on the examiner maintaining the new rejections. As those rejections are not maintained, the argument is unpersuasive. The prior action otherwise contained no defect that would prevent an ACP, therefore there is no reason to issue a new non-final action.

The argument that the prior response be expunged is not persuasive. The Director is mindful that a patent owner may not wish to have a detailed prosecution history for tactical litigation purposes, but frankly this is incidental to the examination process and is not the Office's concern. Rejections are applied during prosecution and later withdrawn for various reasons. Rarely, if ever, does the Office fully expunge from the record an Office action and a patent owner's/applicant's response, and there is no reason for the Office to depart from this longstanding practice in this case. This is particularly so where the patent owner points merely to some hypothetical, as yet unrealized, prejudice and not any actual prejudice that occurred. The Office trusts that the courts can manage any such potential prejudice should the issue become important in litigation. In any event, the use of prosecution history during litigation has the general purpose of informing the proper meaning of the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc). It is not used as some sort of "gotcha" moment intended to trick the patent owner or catch it in a trap. A patent owner's discussion of a

reference or the invention remains relevant prosecution history, even if a rejection later is withdrawn (or, even if it never should have been applied in the first place).

While it is not expunged from the record, the amendment to the claims filed January 4, 2012 is not currently entered. Given that the concurrently issued ACP will be different than the previous ACP, patent owner may wish to respond in a different way. Patent owner should have a clean slate to change its claim amendments, if it desires, in response to the new action. Accordingly, claims 1-3 remain in this proceeding for the purpose of the new ACP.

Moving on to the third party requester's arguments, the third party is incorrect that a RAN is appropriate. A RAN is not permissible until after an ACP. 37 CFR § 1.953(a). As the ACP has been withdrawn, the proceeding is not ripe for a RAN. Furthermore, while the withdrawal of this one rejection might seem relatively minor, it could potentially change the manner in which patent owner chooses to respond to the action. As described herein an ACP is appropriate, and patent owner should have the opportunity to respond under the post-ACP constraints, rather than under the post-RAN constraints, which are much more limiting. See 37 CFR § 1.116(b)-(f)

Accordingly, the petition is granted. The ACP issued November 4, 2011 is withdrawn, and a new ACP is issued concurrently with this decision.

### CONCLUSION

1. The petition filed January 4, 2012 is granted. The Action Closing Prosecution of November 4, 2011 is withdrawn.
2. A new ACP is issued concurrently.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel  
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628
26111	7590	03/23/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 03/23/2012

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Date:

MORRISSON & FOESTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2050

**MAILED**

**MAR 23 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000588 + 95001483

PATENT NO. : 7394432

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**CENTRAL REEXAMINATION UNIT**

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

(For Patent Owner)

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE, SUITE 100  
SAN DIEGO, CA 92130-2040

(For *Inter Partes* '588 Requester)

NOVAK, DRUCE & QUIGG, LLP  
(NDQ REEXMINATION GROUP)  
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For *Inter Partes* '1483 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,588  
Filed: December 13, 2010  
For: U.S. Patent No. 7,394,432

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: **DECISION**  
: **DISMISSING**  
: **PETITION**  
: **UNDER 37 CFR 1.183**  
: **AS MOOT**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,483  
Filed: November 11, 2010  
For: U.S. Patent No. 7,394,432

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This is a decision on patent owner's January 4, 2012 petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO ACTION CLOSING PROSECUTION IN REEXAMINATION" (the petition under 37 CFR 1.183), requesting waiver of the regulatory page limit for its concurrently-filed "Patent Owner's Response to the Action Closing Prosecution of November 4, 2011." The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

In light of the decision issued by the Central Reexamination Unit (CRU) on March 5, 2012, granting patent owner's January 4, 2012 petition under 37 CFR 1.181 and withdrawing the Action Closing Prosecution issued on November 4, 2011, the instant petition under 37 CFR 1.183 is dismissed as moot. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.

Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

03-21-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,589	11/16/2010	7015868	3008.001REX1	9707
26111	7590	05/23/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 05/23/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date:

**MAILED**

**MAY 23 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000589

PATENT NO. : 7015868

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox P.L.L.C.  
1100 New York Avenue, N.W.  
Washington, DC 20005

(For Patent Owner)

MAILED

MAY 23 2011

Baker Botts, LLP  
Patent Department  
98 San Jacinto Blvd.  
Suite 1500  
San Antonio, TX 78701-4039

(For 95/001,498 Requester) CENTRAL REEXAMINATION

Morrison & Foerster LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, CA 92130

(For 95/000,589 Requester)

Novak Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
53<sup>rd</sup> Floor  
Houston, TX 77002

(For 95/001,390 Requester)

In re Carles Puente Baliarde et al.  
*Inter Partes* Reexamination Proceeding  
Control No.: 95/001,498  
Filed: December 3, 2010  
For: U.S. Patent No. 7,015,868

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In re Carles Puente Baliarde et al.  
*Inter Partes* Reexamination Proceeding  
Control No.: 95/000,589  
Filed: November 16, 2010  
For: U.S. Patent No. 7,015,868

: **DECISION, *SUA SPONTE*,**  
: **TO MERGE**  
: **REEXAMINATION**  
: **PROCEEDINGS**

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In re Carles Puente Baliarde et al.  
*Inter Partes* Reexamination Proceeding  
Control No.: 95/001,390  
Filed: July 2, 2010  
For: US. Patent No. 7,015,868

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

## BACKGROUND

1. U.S. Patent No. 7,015,868 ("the '868 patent") issued to Carles Puente Baliarde et al. on March 21, 2006, with 37 claims.
2. A request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent was filed on July 2, 2010, by a third party requester, and was assigned control number 95/001,390 ("the '1390 *inter partes* proceeding"). The real party in interest is Samsung Electronics Co. Ltd.
3. On August 12, 2010, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent in the '1390 *inter partes* proceeding based on the examiner's determination that the July 2, 2010 request raised a substantial new question of patentability affecting these claims. The order was followed by a non-final rejection action mailed on August 19, 2010.
4. A second request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent was filed on November 16, 2010, by a third party requester, and was assigned control number 95/000,589 ("the '589 *inter partes* proceeding"). The real party in interest is Kyocera Communications, Inc.
5. A third request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent was filed on December 3, 2010, by a third party requester, and was assigned control number 95/001,498 ("the '1498 *inter partes* proceeding"). The real party in interest is HTC Corporation and HTC America, Inc.
6. On January 13, 2011, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent in the '589 *inter partes* proceeding based on the examiner's determination that the November 16, 2010 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '589 proceeding.
7. On January 25, 2011, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent in the '1498 *inter partes* proceeding based on the examiner's determination that the December 3, 2010 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '1498 proceeding.
8. On April 11, 2011, patent owner submitted a response to the August 19, 2010 non-final rejection action in the '1390 *inter partes* proceeding.<sup>1</sup> The April 11, 2011 patent owner response did not include any amendment to the specification or claims.

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<sup>1</sup> Patent owner's April 11, 2011 response in the '1390 *inter partes* proceeding was a corrected response filed in response to a March 25, 2011 Notice Re Defective Paper In Inter Partes Reexamination. The March 25, 2011 Notice stated that patent owner's original November 19, 2010 response to the August 19, 2010 non-final rejection action was defective.

9. On May 2, 2011, the '1390 requester filed comments to patent owner's April 11, 2011 response.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,390, 95/000,589 and 95/001,498 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Presently, the claims (and specification) are identical in all three files. Patent owner is required to continue to maintain the same claims (and specification) in all three files *throughout the merged proceeding*.

### III. CONDUCT OF MERGED PROCEEDING

#### A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

#### B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in triplicate**, each bearing a

signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"  
Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900  
Central Reexamination Unit

by Hand to: Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

by EFS: Registered users may submit papers via the  
electronic filing system EFS-Web, at:

<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### C. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### D. Fees:



Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest. The third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest, and each rejection made and later withdrawn by the examiner that the third party requester intends to contest. No new ground of rejection (including one proposed by another requester, but not the appellant requester) can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that each individual requester can challenge in the appellant brief.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,390, *inter partes* Reexamination No. 95/000,589 and *inter partes* Reexamination Control No. 95/001,498 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. The examiner will issue an Office action for the merged proceeding in due course.
3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.

/Kenneth M. Schor/

Kenneth M. Schor  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,589	11/16/2010	7015868	3008.001REX1	9707
26111	7590	06/20/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/20/2011

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,589	11/16/2010	7,015,868	079957.0104

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130

EXAMINER

MENEFEE, JAMES

ART UNIT	PAPER
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3992

DATE MAILED:

06/20/11

## **INTER PARTES REEXAMINATION COMMUNICATION**

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.



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This is also a decision on the third party requester petition paper entitled “THIRD PARTY REQUESTER’S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A),” filed on May 2, 2011, in reexamination proceeding control no. 95/001,390.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The patent owner petition under 37 CFR 1.183 is **dismissed as unnecessary** and the third party requester petition under 37 CFR 1.183 is **granted** to the extent set forth below.

## BACKGROUND

1. On March 21, 2006, U.S. patent number 7,015,868 (the ‘868 patent) issued to Baliarde *et al.*
2. On July 2, 2010, a third party requester filed a request for *inter partes* reexamination of the ‘868 patent, which request was assigned Reexamination Control No. 95/001,390 (the ‘1390 proceeding).
3. On August 12, 2010, the Office issued an order granting *inter partes* reexamination in the ‘1390 proceeding and, on August 19, 2010, the Office issued a non-final Office action.
4. On November 19, 2010, patent owner filed a response to the August 19, 2010 Office action.<sup>1</sup>
5. On March 7, 2011, third party requester filed corrected comments after the August 19, 2010 Office action and patent owner’s November 19, 2010 response.<sup>2</sup>
6. On March 25, 2011, the Office mailed a “NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION” (the notice of defective paper), finding patent owner’s November 19, 2010 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 11, 2011, patent owner filed the instant “PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION” (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the August 19, 2010 Office action (patent owner corrected response submission).
8. On May 2, 2011, third party requester filed the instant “THIRD PARTY REQUESTER’S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)” (requester petition under 37 CFR 1.183), concurrently with requester’s comments after the

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<sup>1</sup> On October 7, 2010, the Office mailed a decision granting patent owner’s September 27, 2010 petition for a one-month extension of time.

<sup>2</sup> On February 24, 2011, the Office mailed a decision granting patent owner’s January 31, 2011 petition under 37 CFR 1.181 and expunging the ‘1390 requester’s December 20, 2010 comments submission and giving the ‘1390 requester 15 days from the mailing date of that decision to file corrected comments.

August 19, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

9. On May 23, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1390 proceeding with *inter partes* reexamination proceeding control no. 95/001,498 (the '1498 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,589 (the '589 proceeding).

## DECISION

### I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a

response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1390 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 39 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).<sup>3</sup> Patent owner states that "a number of Rule 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."<sup>4</sup> Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."<sup>5</sup>

<sup>3</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>4</sup> *Id.* (stating that the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 (10 pages)," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132 (9 pages)," the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)," and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (19 pages)" are filed herewith, and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

<sup>5</sup> *Id.*



In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.<sup>6</sup> Additionally, patent owner asserts that “the full length of the Corrected Response and the Rule 132 declarations are needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 7 pages, it incorporates by reference over 150 pages of argument and detailed claim charts set forth by the third party requester in its request for reexamination.”<sup>7</sup> Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>8</sup> As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 as “Exhibit 1” a redlined document comparing patent owner’s November 19, 2010 original response submission to patent owner’s April 11, 2011 corrected response submission. The “Exhibit 1” document has been expunged from the record of the ‘1390 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

In this instance, patent owner’s April 11, 2011 corrected response submission is page-length compliant as the total number of pages that count toward the regulatory page limit does not exceed 50 pages.<sup>9</sup> Thus, no waiver of 37 CFR 1.943(b) is required for entry of patent owner’s April 11, 2011 corrected response submission. Accordingly, patent owner’s request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

#### **IV. Third party requester petition of May 2, 2011**

On May 2, 2011, the ‘1390 requester filed, in the ‘1390 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The ‘1390 requester asserts that the May 2, 2011 comments submission includes “50 pages of double spaced 12 pt font arguments and an 8 page declaration from Dr.

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<sup>6</sup> Id. at pages 2-4.

<sup>7</sup> Id. at page 5.

<sup>8</sup> Id. at pages 5-6.

<sup>9</sup> 38 pages of the remarks portion of patent owner’s April 11, 2011 corrected response submission count toward the page limit (the cover page and certificate of service page are excluded from the page count, as is the 6-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, portions of the 19-page “Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132” that are subject to the regulatory page limit count do not cause the total number of pages of patent owner’s April 11, 2011 corrected response submission to exceed the 50-page limit (e.g., excluded from the page count are portions related to declarant’s qualifications, technical background information, technical explanations of terms of art used by a reference, etc.). It is noted that the pages of the “Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132,” the “Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132,” and the “Declaration of Rubén Bonet Under 37 C.F.R. § 1.132” do not count toward the regulatory page limit. Additionally, in this instance, the pages of the copies of the court documents that were filed as “Exhibit 2” and “Exhibit 7B” also do not count toward the regulatory page limit.

Balanis under 37 C.F.R. § 1.132.”<sup>10</sup> The ‘1390 requester asserts, however, that “[i]f the Office agrees with [patent owner’s] interpretation of MPEP § 2667(I)(A)(2), then Samsung’s Comments are only 50 pages as Dr. Balanis’s declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue.”<sup>11</sup>

In support of its request for waiver of the rule, the ‘1390 requester asserts that “[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner’s 114 page response.”<sup>12</sup> The ‘1390 requester asserts that it “has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit” and “is asking for significantly fewer total pages than [sic] the Patent Owner has submitted,” *i.e.*, requester “is only asking for a total of 58 pages.”<sup>13</sup> The ‘1390 requester also asserts that “in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner.”<sup>14</sup>

Based on the specific facts set forth in the ‘1390 requester’s petition under 37 CFR 1.183, the ‘1390 requester’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),<sup>15</sup> and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the ‘1390 requester’s May 2, 2011 comments submission exceeds 50 pages. Accordingly, the ‘1390 requester’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the ‘1390 requester’s May 2, 2011 comments submission. This waiver makes the ‘1390 requester’s May 2, 2011 comments submission page-length compliant.

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<sup>10</sup> Third party requester petition under 37 CFR 1.183 at page 1.

<sup>11</sup> *Id.* at page 4. The ‘1390 requester is cautioned that statements submitted in opposition to patent owner’s petition under 37 CFR 1.183 are improper and may result in the requester’s petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on pages 3-4 of the third party requester petition under 37 CFR 1.183, the ‘1390 requester presents arguments against patent owner’s position set forth in patent owner’s petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner’s response to an Office action on the merits. Patent owner’s petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner’s corrected response submission, however, is not a “response” to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner’s petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper “closed” and “not public” in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

<sup>12</sup> *Id.* at page 2.

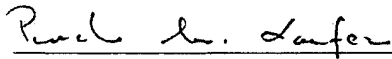
<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

<sup>15</sup> 50 pages of the remarks portion of the ‘1390 requester’s May 2, 2011 comments submission count toward the page limit. Further, based on the guidance set forth in section II above, to the extent portions of the 8-page “Declaration of Dr. Constantine A. Balanis” are subject to the regulatory page limit count, the total number of pages of the May 2, 2011 comments submission exceeds the 50-page limit. In this instance, the pages of the copies of the court documents that were filed as exhibits to the May 2, 2011 comments submission do not count toward the regulatory page limit.

### CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **dismissed as unnecessary**.
2. The '1390 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1390 requester's May 2, 2011 comments submission. This waiver makes the '1390 requester's May 2, 2011 comments submission page-length compliant.
3. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

06-17-2011



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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26111	7590	11/18/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
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95/001,498	12/03/2010	7015868	3008.001REX2	7027
26111	7590	11/18/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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**MAILED**

**NOV 18 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000589  
PATENT NO. : 7015868  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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HOUSTON, TX 77002

Date:

**MAILED**

**NOV 18 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001390  
PATENT NO. : 7015868  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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Date:

**MAILED**

**NOV 18 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001498

PATENT NO. : 7015868

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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98 SAN JACINTO BLVD., SUITE 1500  
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(For 95/001,498 Third Party Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,589  
Filed: November 16, 2010  
For: U.S. Patent No. 7,015,868

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,390  
Filed: July 2, 2010  
For: U.S. Patent No. 7,015,868

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,498  
Filed: December 3, 2010  
For: U.S. Patent No. 7,015,868

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**NOV 18 2011**

**CENTRAL REEXAMINATION UNIT**

**DECISION  
ON PETITION  
UNDER 37 CFR 1.183**

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 3, 2011 in reexamination proceeding control nos. 95/000,589, 95/001,390, and 95/001,498.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **granted** to the extent set forth below.

## RELEVANT BACKGROUND

1. On March 21, 2006, U.S. patent number 7,015,868 (the '868 patent) issued to Puente Baliarda *et al.*
2. Subsequently, three requests for *inter partes* reexamination of the '208 patent, which requests were assigned Reexamination Control Nos. 95/001,390, 95/000,589, and 95/001,498, were instituted by the Office.
3. On May 23, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1390 proceeding with the '589 and '1498 proceedings (the merged proceeding).
4. On July 1, 2011, the Office issued a non-final Office Action in the merged proceeding.
5. On October 3, 2011, patent owner filed a response to the July 1, 2011 Office action in the merged proceeding, concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).<sup>1</sup>

## DECISION

### I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

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<sup>1</sup> On August 5, 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the July 1, 2011 Office action.

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of October 3, 2011

On October 3, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission. Patent owner asserts that the argument portion of the October 3, 2011 response submission is 121 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.<sup>2</sup> Patent owner states that it concurrently filed “a number of 132 declarations” but asserts that the declarations “include only facts and thus does not count towards the 50-page limit.”<sup>3</sup> Nonetheless, patent owner also requests waiver of the 50-page limit for “those portions of the 132 Declarations that the PTO holds count towards the 50 page limit....”<sup>4</sup>

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 3, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.<sup>5</sup> Additionally, patent owner asserts that “the full length of the Response is needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 44 pages, it incorporates by reference almost 550 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”<sup>6</sup> Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>7</sup>

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),<sup>8</sup> and the individual facts and circumstances of this case (such as the length of the July 1, 2011 Office action),<sup>9</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

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<sup>2</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>3</sup> Id. at page 4 (identifying two declaration(s) of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages and 15 pages), a declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera and Jordi Soler under 37 C.F.R. § 1.132 (9 pages), a declaration of Aurora Andujar under 37 C.F.R. § 1.132 (13 pages), a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (13 pages), and two declaration(s) of Dr. Raj Mittra under 37 C.F.R. § 1.132 (each 20 pages)).

<sup>4</sup> Id. at page 2.

<sup>5</sup> Id. at pages 4-7.

<sup>6</sup> Id. at page 2-3.

<sup>7</sup> Id. at page 3.

<sup>8</sup> 122 pages of the remarks portion of patent owner’s October 3, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 6-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Additionally, at least portions of the 20-page declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 are deemed to be an extension of the arguments of counsel and count toward the page limit. Thus, up to 142 pages of the patent owner’s October 3, 2011 response submission count toward the 50-page limit.

<sup>9</sup> On its face, the substantive portion of the July 1, 2011 Office action spans only approximately 44 pages, but it incorporates by reference numerous pages from the ‘1390, ‘1498 and ‘589 requests for *inter partes* reexamination and comments submissions.

Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the July 1, 2011 Office action exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 92 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.

### ADDITIONAL DISCUSSION

The 95/001,390 third party requester, 95/001,498 third party requester and the 95/000,589 third party requester have 30 days from the date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

### CONCLUSION

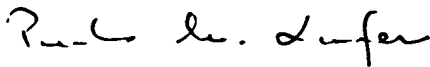
1. Patent owner's October 3, 2011 petition under 37 CFR 1.183 is granted and the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 92 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.
2. The 95/001,390 third party requester, 95/001,498 third party requester and the 95/000,589 third party requester each has 30 days from the mailing date of this decision, granting patent

Reexamination Control No. 95/000,589  
Reexamination Control No. 95/001,390  
Reexamination Control No. 95/001,498

-6-

owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.

3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



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Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

11-17-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,589 - 95/001,390 95/001,498	11/16/2010	7015868	3008.001REX1	9707
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.





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SAN DIEGO, CA 92130-2040

Date: 12-12-11

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000589 + 95/001390 + 95/001498  
PATENT NO. : 7015868  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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**CENTRAL REEXAMINATION UNIT**

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(For Patent Owner)

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(For *Inter Partes* '1498 Requester)

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1390 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,589  
Filed: November 16, 2010  
For: U.S. Patent No.: 7,015,868

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,498  
Filed: December 03, 2010  
For: U.S. Patent No. 7,015,868

*Inter Partes* Reexamination Proceeding  
Control No: 95/001,390  
Filed: July 02, 2010  
For: U.S. Patent No. 7,015,868

**DECISION GRANTING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND  
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,498, filed on September 16, 2011, is **granted**.

*Inter partes* reexamination proceeding control number 95/001,498 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,498, 95/000,589 and 95/001,390.

*Inter partes* reexamination proceeding 95/001,498, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue** in the manner set forth in this decision.<sup>1</sup>

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,498 (the '1498 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,015,868 (the '868 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that “. . . HTC [the defendant/requester of the '1498 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit” and that “[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

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<sup>1</sup> This petition does not address the petition under 37 CFR 1.182 to terminate the '589 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28”. The “above listed claims” of one of the patents in suit, the ‘868 patent, which is the patent under reexamination in the ‘1498 proceeding, are listed in the consent judgment as claims 1, 3, 6, 12, 14, 23, 26, and 32-35, which are identical to the claims that were requested to be reexamined by HTC in the ‘1498 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that “[a]ll of Fractus’ claims against HTC are dismissed with prejudice. All of HTC’s defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the ‘868 patent] are dismissed with prejudice”, and that “[t]he parties expressly waive their rights to appeal”. Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court’s decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that “[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the ‘1498 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit”. Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner’s September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

*Inter partes* reexamination proceeding control no. 95/001,498 (the ‘1498 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,498 , 95/000,589 and 95/001,390.

*Inter partes* reexamination proceeding control no. 95/001,498 (the ‘1498 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue**.<sup>2</sup> Any rejection proposed by HTC (the requester of the ‘1498 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner “adopts” a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner’s determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner’s determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

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<sup>2</sup> As pointed out above, this decision does not address the September 30, 2011 petition to terminate the ‘589 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.<sup>3</sup>

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,589 and 95/001,390, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,589 and 95/001,390 will otherwise remain, in general, as outlined by the decision, mailed on May 23, 2011, entitled “Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings”.

The ‘1498 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM “Application Number Information” screen and the “Contents” screen will be printed, the printed copy will be annotated by adding the comment “PROCEEDING CONCLUDED,” and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.


### CONCLUSION

- Patent owner’s September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,498 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,498 (the ‘1498 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,498, 95/000,589 and 95/001,390.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue** in the manner set forth in this decision.
- The prosecution of the ‘1498 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The ‘1498 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the ‘1498 proceeding, as set forth in this decision.

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<sup>3</sup> A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester’s comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner’s amendment, if requester’s comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



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Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

Kenpet9



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,589	11/16/2010	7015868	3008.001REX1	9707
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	3008.001REX0	8872
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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Date:

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**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000589  
PATENT NO. : 7015868  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

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HOUSTON, TX 77002

**MAILED**

**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001390

PATENT NO. : 7015868

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
1100 New York Avenue, N.W.  
Washington, D.C. 20005

(For Patent Owner)

**MAILED**

**DEC 12 2011**

Morrison & Foerster, LLP  
12531 High Bluff Drive  
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San Diego, CA 92130-2040

(For *Inter Partes* '589 Requester)

**CENTRAL REEXAMINATION UNIT**

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1390 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,589  
Filed: November 16, 2010  
For: U.S. Patent No.: 7,015,868

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,390  
Filed: July 02, 2010  
For: U.S. Patent No. 7,015,868

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND PETITION  
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:<sup>1</sup>

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,498, was granted. *Inter partes* reexamination proceeding 95/001,498 was severed from the merger of *inter partes* reexamination proceedings 95/001,498, 95/000,589 and 95/001,390, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,589 and 95/001,390.

## SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,589, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

## DECISION

### *The September 30, 2011 Petition to Terminate*

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,589 (the '589 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,015,868 (the '868 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '589 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '868 patent's claims 1, 3, 6, 12, 14, 23, 26, 32-35, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL” (emphasis in original).<sup>2</sup> The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.<sup>3</sup>

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the ‘868 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘589 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘589 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are

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<sup>2</sup> The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

<sup>3</sup> If this is not the case, the patent owner is required to so inform the Office.

based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

### ***The September 30, 2011 Petition to Expunge***

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “ . . . entered a Final Consent Judgment against Kyocera [the requester of the ‘589 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the ‘589 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.


The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

## CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,589 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script, reading "Brian E. Hanlon", is positioned above a horizontal line.

Brian E. Hanlon

Director

Office of Patent Legal Administration





# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,589	11/16/2010	7015868	3008.001REX1	9707
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

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12531 HIGH BLUFF DRIVE  
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SAN DIEGO, CA 92130-2040

MAILED

FEB 27 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000589 + 95001390  
PATENT NO. : 7015868  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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FEB 27 2012

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Houston, TX 77002

(For *Inter Partes* '1390 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,589  
Filed: November 16, 2010  
For: U.S. Patent No.: 7,015,868

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,390  
Filed: July 02, 2010  
For: U.S. Patent No. 7,015,868

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).<sup>1</sup>

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,390 (the '1390 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1390 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,498. *Inter partes* reexamination proceeding 95/001,498 was severed from the merger of *inter partes* reexamination proceedings 95/001,498, 95/000,591 and 95/001,389, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,591 and 95/001,389.

## SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,589 is dismissed.

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,589 (the '589 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,015,868 (the '868 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '589 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.<sup>2</sup> The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '589 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '589 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

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<sup>2</sup> For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

### CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,589 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/  
Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,590-95/004462	12/16/2010	7411556	3008.005REX1	9362
26111	7590	05/05/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2011

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**Transmittal of Communication to Third Party Requester  
*Inter Partes* Reexamination**

REEXAMINATION CONTROL NUMBER 95/000,590 → 95/001 462

PATENT NUMBER 7411556.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

**All correspondence** relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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Novak, Druce, & Quigg LLP (For *Inter Partes* '1462 Requester)  
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*Inter Partes* Reexamination Proceeding  
Control No. 95/000,590  
Filed: December 16, 2010  
For: U.S. Patent No. 7,411,556

:  
:  
:  
: **DECISION, *SUA SPONTE*,**  
: **MERGING**  
: ***INTER PARTES***  
: **PROCEEDINGS**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,462  
Filed: October 1, 2010  
For: U.S. Patent No. 7,411,556

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 C.F.R. § 1.989 at this time.

## REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,411,556 (the '556 patent) issued to Alfonso Sanz *et al.* on August 12, 2008.
2. The 95/001,462 *inter partes* proceeding.  
On October 1, 2010, a request for *inter partes* reexamination of claims 36-41 and 43 of the '556 patent was filed by third party requester; the request was assigned control number 95/001,462 (the '1462 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest.  
Reexamination was ordered on November 29, 2010.
3. The 95/000,590 *inter partes* proceeding.  
On November 22, 2010, a request for *inter partes* reexamination of claims 36-41 and 43 of the '556 patent was deposited by third party requester; the request was assigned control number 95/000,590 (the '590 *inter partes* proceeding), and a filing date of December 16, 2010, the date at which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest.  
Reexamination was ordered on February 18, 2011.

## DECISION

### I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '1462 and the '590 reexamination proceedings are currently pending. Orders granting reexamination of claims 36-41 and 43 of the '556 patent have been mailed in both the '1462 and '590 reexamination proceedings, and a decision under 37 C.F.R. § 1.989(a) is timely. Both proceedings are at the same stage, in which no Office action on the merits has been issued.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the '1462 and '590 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the

'1462 and '590 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

## II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

### B. *Inter partes* Third Party Requester Participation:

#### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>1</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

#### 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim

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<sup>1</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

#### C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 C.F.R. § 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 C.F.R. § 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "Inter Partes Reexam"  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, including papers filed *via* facsimile transmission, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 C.F.R. § 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

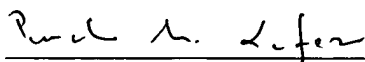
Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 C.F.R. § 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 C.F.R. § 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,462 and *inter partes* Reexamination Control No. 95/000,590 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

May 3, 2011



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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,590	12/16/2010	7411556	3008.005REX1	9362
26111	7590	06/14/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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United States Patent and Trademark Office  
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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462	10/01/2010	7,411,556	3008.005REX0	1228
26111	7590	06/14/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date:

**MAILED**

**JUN 14 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000590

PATENT NO. : 7411556

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension  
of Time in Reexamination**

Control No.: 95/000,590 & 95/001,462

1. THIS IS A DECISION ON THE PETITION FILED 06 June 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action dated 06 May 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
  - ii. ☐ Petition includes authorization to charge a credit card account.
  - iii. ☐ Other: \_\_\_\_\_.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- B. ☒ Other/comment: see attached
- C. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
  - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
  - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
  - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
  - v. ☐ The petition is moot.
  - vi. ☐ Other/comment: \_\_\_\_\_.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/

[Signature]

SPE, AU 3992 Central Reexamination Unit

(Title)

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the length and complexity of the Office action and speed at which Office action was prepared. The petitioner also noted other proceedings for which reexamination was granted. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time. Additionally, the speed at which the Office action was prepared is required to meet the requirements of "special dispatch." All of that said, the length and complexity of the Office action does warrant consideration.

MPEP 2665 states, "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added).

On balance the petition for extension of time supports "sufficient cause" to grant a one (1) month extension of time.

The petition for extension of time is hereby granted-in-part



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95/000,590	12/16/2010	7411556	3008.005REX1	9362
26111	7590	10/27/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462	10/01/2010	7,411,556	3008.005REX0	1228
26111	7590	10/27/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
ART UNIT			PAPER NUMBER	

DATE MAILED: 10/27/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
NOVAK DRUCE & QUIGG LLP  
1000 LOUISIANA STREET  
53rd FLOOR  
HOUSTON, TX 77002

**MAILED**

Date: OCT 27 2011

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001462  
PATENT NO. : 7411556  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date: **MAILED**

**OCT 27 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000590

PATENT NO. : 7411556

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX, PLLC  
1100 NEW YORK AVENUE  
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(For Patent Owner)

MORRISON & FOERSTER, LLP  
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SUITE 100  
SAN DIEGO, CA 92130

(For '590 *Inter Partes* Requester)

NOVAK, DRUCE & QUIGG, LLP  
(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET, 53<sup>RD</sup> FLOOR  
HOUSTON, TX 77002

(For '1462 *Inter Partes* Requester)

**MAILED**

OCT 27 2011

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,590  
Filed: December 16, 2010  
For: U.S. Patent No. 7,411,556

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:  
:  
: **DECISION**  
: **GRANTING**  
: **PETITIONS**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,462  
Filed: October 1, 2010  
For: U.S. Patent No. 7,411,556

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This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on August 8, 2011. This is also a decision on third party requester's petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 CFR § 1.943(A)," filed on September 7, 2011.

Both the patent owner petition and the third party requester petition are before the Office of Patent Legal Administration.

The patent owner and the third party requester petitions are granted, for the reasons set forth herein.



## BACKGROUND

1. On August 12, 2008, U.S. Patent No. 7,411,556 (the '556 patent) issued to Sanz *et al.*
2. On October 1, 2010, a first request for *inter partes* reexamination of the '556 patent, assigned control number 95/001,462 ("the '1462 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1462 requester").
3. On November 16, 2010, a second request for *inter partes* reexamination of the '556 patent, assigned control number 95/000,590 ("the '590 proceeding"), was filed by a third party requester on behalf of real party in interest Kyocera Communications, Inc. ("the '590 requester"). On December 16, 2010, a corrected request for *inter partes* reexamination was filed in the '590 proceeding.
4. On November 29, 2010, *inter partes* reexamination was ordered in the '1462 proceeding.
5. On February 18, 2011, *inter partes* reexamination was ordered in the '590 proceeding.
6. On May 5, 2011, a decision, *sua sponte*, merging the '1462 and '590 *inter partes* reexamination proceedings was mailed by the Office ("the merged proceeding").
7. On May 6, 2011, a non-final rejection was mailed by the Office in the merged proceeding.
8. On August 8, 2011, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" ("patent owner petition under 37 CFR 1.183"), concurrently with a patent owner response to the May 6, 2011 Office action.<sup>1</sup>
9. On September 7, 2011, the '1462 requester filed the instant petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 CFR § 1.943(A)" ("the '1462 requester petition under 37 CFR 1.183"), concurrently with the '1462 requester's comments after the patent owner's August 8, 2011 response submission and the May 6, 2011 Office action.

## DECISION

### I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be

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<sup>1</sup> On June 14, 2011, the Office mailed a decision granting, in-part, patent owner's June 6, 2011 "Petition for Extension of Time to File Response to First Office Action Pursuant to 37 CFR 1.956 in Merged Proceedings" and extending the time period for patent owner's response to the May 6, 2011 Office action by one month.

suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## II. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited** to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Additionally, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response or third party requester comments submission that:

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response or a third party requester comments submission.

#### **A. Patent Owner Petition Under 37 CFR 1.183**

Patent owner's August 8, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the May 6, 2011 Office action, has been fully considered. In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner's August 8, 2011 response submission.<sup>2</sup> In particular, patent owner states that "[t]he argument portion of the Response filed herewith is 104 pages. Also filed herewith is a 132 Declaration that totals 23 pages."<sup>3</sup> Patent owner also asserts that "the declaration is drawn to fact, not argument, and thus does not count towards the 50-page limit. However, if the PTO should disagree, then Patent Owner hereby requests waiver of the 50-page limit for the 132 declaration...."<sup>4</sup>

In support of waiver of 37 CFR 1.943(b), patent owner states that "the full length of the Response is needed to fully and adequately respond to the Office Action" because "the Office Action is based on the combination of two *Inter Partes* reexamination requests and grants and additional rejections asserted by the Examiner."<sup>5</sup> Patent owner asserts that "[s]pecifically, the Office Action includes 18 separate grounds of rejection over 8 separate references and five new rejections under Office Notice alleged by the Examiner" and that "[w]hile the pending Office action constitutes only 17 pages, it incorporates by reference almost 400 pages of argument and detailed claim charts...."<sup>6</sup> Patent owner also states that it "has made a good faith effort to comply with the 50 page-limit, making efforts to economize, avoid extraneous material and information already of record, and present arguments efficiently" and that "Patent Owner has avoided duplication of argument, referring back to sections containing applicable arguments (where such is possible without diluting the argument), rather than reproducing those arguments in multiple portions of the Response."<sup>7</sup>

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<sup>2</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>3</sup> Id. at page 2.

<sup>4</sup> Id. at page 4.

<sup>5</sup> Id. at page 2.

<sup>6</sup> Id. at pages 2-3.

<sup>7</sup> Id. at page 3.

In this instance, patent owner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a response that is in excess of 50 pages. Based on the guidance set forth above, the remarks portion of the August 8, 2011 response includes up to 105 pages (pages 20-124) that count toward the regulatory page limit, and the declaration under 37 CFR 1.132 by Dr. Raj Mittra includes up to 20 pages (pages 3-22) that count toward the regulatory page limit.

Based on patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case such as, for example, the size of the May 6, 2011 Office action, including the number of rejections and incorporation by reference of pages from the requests for *inter partes* reexamination in the '1462 and '590 proceedings,<sup>8</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's August 8, 2011 response submission exceeds the regulatory page limit by up to 75 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the May 6, 2011 Office action to exceed the page limit by up to 75 pages. This waiver makes patent owner's August 8, 2011 response submission page-length compliant.

#### **B. The '1462 Requester Petition Under 37 CFR 1.183**

The '1462 requester's September 7, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered. In the instant petition under 37 CFR 1.183, the '1462 requester requests that the page limit requirement of 37 CFR 1.943(b) be waived for requester's September 7, 2011 comments submission to permit requester to submit comments including 63 pages of arguments and a 9-page declaration under 37 CFR 1.132 of Dr. Balanis.<sup>9</sup> The '1462 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 63 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue."<sup>10</sup> In particular, the '1462 requester states that "Samsung has attempted to respond in as

<sup>8</sup> See May 6, 2011 Office action at pages 4-11.

<sup>9</sup> The '1462 requester petition under 37 CFR 1.183 at page 1.

<sup>10</sup> Id. at page 3. The '1462 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on pages 2-3, the '1462 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's corrected response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not

little a number of pages as possible but was unable to do so within the 50 page limit.”<sup>11</sup> Requester also asserts that “[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner’s 104 page response and 23 page declaration.”<sup>12</sup>

In support of waiver of 37 CFR 1.943(b), the ‘1462 requester asserts “[t]his waiver would not go beyond the 1:1 ratio proscribed [sic] for Patent Owner and Requester responses to Office Actions” and that “the Requester is asking for significantly fewer total pages that [sic] the Patent Owner has submitted....”<sup>13</sup> The ‘1462 requester further asserts that “in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all the arguments raised by the Patent Owner.”<sup>14</sup>

In this instance, the ‘1462 requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a comments submission that is in excess of 50 pages. Based on the guidance set forth above, the remarks portion of the September 7, 2011 comments submission includes up to 63 pages (pages 1-63) that count toward the regulatory page limit, and the declaration under 37 CFR 1.132 by Dr. Constantine A. Balanis includes up to 7 pages (pages 3-9) that count toward the regulatory page limit.

Based on the ‘1462 requester’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit and submitting the resulting comments submission which is in excess of 50 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent the ‘1462 requester’s September 7, 2011 comments submission exceeds the regulatory page limit by up to 20 pages. Accordingly, the ‘1462 requester petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the ‘1462 requester’s September 7, 2011 comments submission to exceed the regulatory page limit by up to 20 pages. This waiver makes the ‘1462 requester’s September 7, 2011 comments submission page-length compliant.

## CONCLUSION

1. Patent owner’s August 8, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s August 8, 2011 response submission to exceed the regulatory page limit by up to 75 pages. This waiver makes patent owner’s August 8, 2011 response submission page-length compliant.
2. The ‘1462 requester’s September 7, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the ‘1462 requester’s

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be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

<sup>11</sup> Id. at page 2.

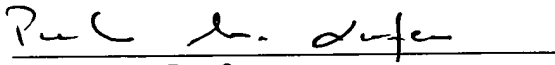
<sup>12</sup> Id.

<sup>13</sup> Id.

<sup>14</sup> Id.

September 7, 2011 comments submission to exceed the regulatory page limit by up to 20 pages. This waiver makes the '1462 requester's September 7, 2011 comments submission page-length compliant.

3. The '590 requester has 30 days from the mailing date of this decision, making patent owner's August 8, 2011 response submission page-length compliant, to file written comments pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.

  
Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

10-26-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,590	12/16/2010	7411556	3008.005REX1	9362
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462	10/01/2010	7,411,556	3008.005REX0	1228
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.





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**MAILED**

**DEC 12 2011**

Date:

**CENTRAL REEXAMINATION UNIT**

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000590

PATENT NO. : 7411556

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Alexandria, VA 22313-1450  
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53rd FLOOR  
HOUSTON, TX 77002

Date:

**MAILED**

**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001462  
PATENT NO. : 7411556  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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United States Patent and Trademark Office

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Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
1100 New York Avenue, N.W.  
Washington, D.C. 20005

(For Patent Owner)

**MAILED**

Morrison & Foerster, LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, CA 92130-2040

(For *Inter Partes* '590 Requester)

DEC 12 2011

**CENTRAL REEXAMINATION UNIT**

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1462 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,590  
Filed: December 16, 2010  
For: U.S. Patent No.: 7,411,556

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,462  
Filed: October 01, 2010  
For: U.S. Patent No. 7,411,556

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND PETITION  
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,590, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is dismissed.

## DECISION

### *The September 30, 2011 Petition to Terminate*

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,590 (the '590 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,411,566 (the '556 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '590 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '556 patent's claims 23, 26, 28-30, 32-41, and 43, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent Judgment has been filed herewith UNDER SEAL" (emphasis in original).<sup>1</sup> The Office presumes

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<sup>1</sup> The September 30, 2011 petition to expunge is accompanied by a paper entitled "Transmittal Letter to Accompany Information Submitted under MPEP § 724.02", and a cover sheet containing a list of items, including an item referred to as "Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02". The Office's image

that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner's September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as "attached" to patent owner's September 30, 2011 petition to terminate.<sup>2</sup>

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment "constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the currently pending claims] of the '556 patent". The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument".

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the '590 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the '590 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to "provide an administrative record showing the evidence on which the findings are based." *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court's later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to "consideration of the

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file wrapper system, IFW, also includes a record of an "artifact sheet" that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

<sup>2</sup> If this is not the case, the patent owner is required to so inform the Office.

decision of the agency . . . and of the evidence on which it was based"); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) ("[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court."). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA's standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court's later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO's decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

### ***The September 30, 2011 Petition to Expunge***

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled "Transmittal Letter to Accompany Information Submitted under MPEP § 724.02", and a cover sheet containing a list of items, including an item referred to as "Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02". The Office's image file wrapper system, IFW, also includes a record of an "artifact sheet" that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), "... entered a Final Consent Judgment against Kyocera [the requester of the '590 *inter partes* reexamination proceeding]", and that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in original). The patent owner states that the consent judgment "is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]". The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '590 proceeding, has consented to a waiver of any protective order by the court, if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing

the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

## CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,590 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script that reads "Brian E. Hanlon". The signature is written in black ink and is positioned above a horizontal line.

Brian E. Hanlon

Director

Office of Patent Legal Administration





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,590	12/16/2010	7411556	3008.005REX1	9362
26111	7590	01/05/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 01/05/2012

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MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

Date: **MAILED**  
**JAN 05 2012**  
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000590  
PATENT NO. : 7411556  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension  
of Time in Reexamination**

Control No.: 95/000,590 + 95/001,462

**MAILED**

**JAN 05 2012**

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 12/23/2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 12/14/2011, which sets a one (1) month period for filing a response thereto, be extended by one (1) month.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
- ii. ☒ Petition includes authorization to charge a credit card account.
- iii. ☐ Other: \_\_\_\_\_.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☐ Granted-in-part for \_\_\_\_\_, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☐ Other/comment: \_\_\_\_\_.
- B. ☒ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v. ☐ The petition is moot.
- vi. ☒ Other/comment: See Attached.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 or Sudhanshu C. Pathak at 571-272-5509 in the Central Reexamination Unit.

/Sudhanshu C. Pathak/  
[Signature]

SPRS, CRU 3992  
(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the **second** request for extension of time in this proceeding. The petition speaks to the considerations of the length and the complexity of the Office Action, specifically the excessive number of rejections; this is noted and is not persuasive. It is Patent owner who must exercise diligence in responding to the Office action. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Office action in an *inter partes* reexamination proceedings. The requirement for reasonably diligent behavior by patent owner includes resource management. Furthermore, Pursuant to MPEP § 2265 (in-part) "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. **Second or subsequent requests** for extensions of time, or requests for more than one month, will be granted only in extraordinary circumstances involved; e.g., death or incapacitation of the patent owner". Therefore, the Request for the extension of time is **denied**.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,590	12/16/2010	7411556	3008.005REX1	9362
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT      PAPER NUMBER	

DATE MAILED: 02/27/2012

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SUITE 100  
SAN DIEGO, CA 92130-2040

Date: **MAILED**

**FEB 27 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000590 + 95001462  
PATENT NO. : 7411556  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FEB 27 2012

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
1100 New York Avenue, N.W.  
Washington, D.C. 20005

(For Patent Owner)

Morrison & Foerster, LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, CA 92130-2040

(For *Inter Partes* '590 Requester)

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1462 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,590  
Filed: December 16, 2010  
For: U.S. Patent No.: 7,411,556

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,462  
Filed: October 01, 2010  
For: U.S. Patent No. 7,411,556

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,462 (the '1462 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1462 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,590 is **dismissed**.

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,590 (the ‘590 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,411,556 (the ‘556 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the ‘590 *inter partes* reexamination proceeding. A copy of the court’s September 22, 2011 consent judgment, designated as “Exhibit A”, is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”. However, the copy of the court’s September 22, 2011 consent judgment, which is attached to the present petition as “Exhibit A”, contains, in the caption, the phrase “Order FILED UNDER SEAL”, and is further stamped with the term “SEALED” above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled “Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02”, that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). As discussed in the December 12, 2011 decision dismissing patent owner’s September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester



Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.<sup>1</sup> The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '590 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '590 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

### CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,590 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

---

<sup>1</sup> For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/  
Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	06/01/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,501	12/03/2010	7,123,208	079957.0105	7104
26111	7590	06/01/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	06/01/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET  
FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

Date:

**MAILED**

**JUL 01 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD. SUITE 1500

AUSTIN, TX 78701-4078

Date:

MAILED

JUL 07 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001501

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

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Date:

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

**MAILED**  
**JUL 01 2011**  
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591  
PATENT NO. : 7123208  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON DC 20005

(For patent owner)

NOVAK, DRUCE & QUIGG, LLP  
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1000 LOUISIANA STREET, 53RD FLOOR  
HOUSTON, TX 77002

(For the '1389 requester)

BAKER BOTTS, LLP  
PATENT DEPARTMENT  
98 SAN JACINTO BLVD., SUITE 1500  
AUSTIN, TX 78701

(For the '1501 requester)

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130

(For the '591 requester)

*In re Puente Baliarda et al.*  
*Inter Partes* Reexamination  
Control No. 95/001,389  
Filed: July 1, 2010  
For: U.S. Patent No. 7,123,208

*In re Puente Baliarda et al.*  
*Inter Partes* Reexamination  
Control No. 95/001,501  
Filed: December 3, 2010  
For: U.S. Patent No. 7,123,208

*In re Puente Baliarda et al.*  
*Inter Partes* Reexamination  
Control No. 95/000,591  
Filed: December 14, 2010  
For: U.S. Patent No. 7,123,208

MAILED

JUL 01 2011

CENTRAL REEXAMINATION UNIT

DECISION,  
SUA SPONTE,  
TO MERGE  
REEXAMINATION  
PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

## REVIEW OF FACTS

1. On October 17, 2006 the Office issued U.S. Patent No. 7,123,208 (the '208 patent) to Carles Puente Baliarda *et al.* with 117 claims.
2. On July 1, 2010, a request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/001,389 ("the '1389 proceeding"). The request identified Samsung Electronics Co., Ltd. (hereinafter "the '1389 requester") as the real party in interest.
3. On August 12, 2010, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent in the '1389 proceeding. An Office action rejecting all claims subject to reexamination accompanied the order.
4. On November 12, 2010, patent owner timely filed a response to the August 12, 2010 Office action in the '1389 proceeding.<sup>1</sup>
5. On December 3, 2010, a second request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/001,501 ("the '1501 proceeding"). The request identified HTC Corp. and HTC America, Inc. (hereinafter "the '1501 requester") as the real party in interest.
6. On December 13, 2010, third party requester timely filed responsive comments in accordance with 37 CFR 1.947 in the '1389 proceeding.
7. On December 14, 2010, a third request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 21, 24-26, 28-29, 33, 37, 40, 43-45, 48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/000,591 ("the '591 proceeding"). The request identified Kyocera Communications, Inc. (hereinafter "the '591 requester") as the real party in interest.
8. On January 25, 2011, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent in the '1501 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
9. On January 31, 2011, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 21, 24-26, 28-29, 33, 40, 43-45, 48, 54, 57-59 and 61 of the '208 patent in the

---

<sup>1</sup> The Office granted patent owner's request for a one month extension of time to file a response.

'591 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

10. To date, an Office action has issued in the '1389 *inter partes* reexamination proceeding and no Office action has issued in the '591 and '1501 *inter partes* reexamination proceedings for the '208 patent.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination is ordered in the three above-captioned proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/001,389, 95/001,501 and 95/000,591 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

### II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

### III. CONDUCT OF MERGED PROCEEDING

#### A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

#### B. *Inter partes* Third Party Requester Participation:

##### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>2</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a

---

<sup>2</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

## 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '591 *inter partes* third party requester did not propose any rejections of claims 18, 37, and 46-47 in their request for reexamination, the '591 requester has no appeal rights as to those claims as they appear in the '208 patent.

## C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

- by Mail to:       Attn: Mail Stop "*Inter Partes* Reexam"  
                      Central Reexamination Unit  
                      Commissioner for Patents  
                      P.O. Box 1450  
                      Alexandria, VA 22313-1450
- by FAX to:       (571) 273-9900  
                      Central Reexamination Unit
- by Hand to:       Customer Service Window  
                      Attn: Central Reexamination Unit  
                      Randolph Building, Lobby Level  
                      401 Dulany Street  
                      Alexandria, VA 22314
- by EFS:           Registered users may submit papers via the  
                      electronic filing system EFS-Web, at:

<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

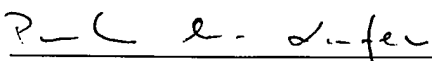
Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/001,389, 95/001,501 and 95/000,591 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



# UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

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Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,501	12/03/2010	7,123,208	3008.008REX2	7104
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

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United States Patents and Trademark Office  
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Alexandria, VA 22313-1450  
www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)  
1000 LOUSIANA STREET  
FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

Date:

MAILED

11/12/01

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389  
PATENT NO. : 7123208  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patents and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD. SUITE 1500

AUSTIN, TX 78701-4078

MAILED

Date:

5/12/01

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001501

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

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P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date:

MAILED

JUN 2 12 00

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP  
(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET,  
FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For 95/001,389 Third Party Requester)

MAILED

JUN 21 2011

CENTRAL REEXAMINATION

BAKER BOTTS LLP  
PATENT DEPARTMENT  
98 SAN JACINTO BLVD., SUITE 1500  
AUSTIN, TX 78701-4078

(For 95/001,501 Third Party Requester)

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

(For 95/000,591 Third Party Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,389  
Filed: July 1, 2010  
For: U.S. Patent No. 7,123,208

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,501  
Filed: December 3, 2010  
For: U.S. Patent No. 7,123,208

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,591  
Filed: December 14, 2010  
For: U.S. Patent No. 7,123,208

DECISION  
ON PETITION  
UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,389.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **dismissed as unnecessary** for the reasons set forth below.

## BACKGROUND

1. On October 17, 2006, U.S. patent number 7,123,208 (the '208 patent) issued to Baliarda *et al.*
2. On July 1, 2010, a third party requester filed a request for *inter partes* reexamination of the '208 patent, which request was assigned Reexamination Control No. 95/001,389 (the '1389 proceeding).
3. On August 12, 2010, the Office issued an order granting *inter partes* reexamination in the '1389 proceeding. Concurrently with the order, the Office issued a non-final Office action.
4. On November 12, 2010, patent owner filed a response to the August 12, 2010 Office action.<sup>1</sup>
5. On March 7, 2011, third party requester filed corrected comments after the August 12, 2010 Office action and patent owner's November 12, 2010 response.<sup>2</sup>
6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's November 12, 2010 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the August 12, 2010 Office action (patent owner corrected response submission).
8. On April 29, 2011, third party requester filed comments after the August 12, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).
9. On June 1, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1389 proceeding with *inter partes* reexamination proceeding

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<sup>1</sup> On September 29, 2010, the Office mailed a decision granting patent owner's September 27, 2010 petition for a one-month extension of time.

<sup>2</sup> On February 24, 2011, the Office mailed a decision granting patent owner's January 31, 2011 petition under 37 CFR 1.181 and expunging the '1389 requester's December 13, 2010 comments submission and giving the '1389 requester 15 days from the mailing date of that decision to file corrected comments.

control no. 95/001,501 (the '1501 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,591 (the '591 proceeding).

## DECISION

### I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1389 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 22 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).<sup>3</sup> Patent owner states that "a number of 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."<sup>4</sup> Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."<sup>5</sup>

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.<sup>6</sup> Additionally, patent owner asserts that "the full length of the Corrected Response and the 132 declarations are needed to fully and adequately

<sup>3</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>4</sup> *Id.* (stating that the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 (10 pages)," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132 (9 pages)," the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)," and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (9 pages)" are filed herewith, and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

<sup>5</sup> *Id.*

<sup>6</sup> *Id.* at pages 2-4.

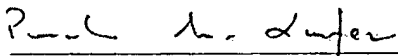


respond to the Office Action,” and that although the Office action “constitutes only 7 pages, it incorporates by reference over 170 pages of argument and detailed claim charts set forth by the third party requester in its request for reexamination.”<sup>7</sup> Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>8</sup> As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 a redlined document comparing patent owner’s November 12, 2010 original response submission to patent owner’s April 11, 2011 corrected response submission. This redlined document has been expunged from the record of the ‘1389 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

In this instance, patent owner’s April 11, 2011 corrected response submission is page-length compliant as the total number of pages that count toward the regulatory page limit does not exceed 50 pages.<sup>9</sup> Thus, no waiver of 37 CFR 1.943(b) is required for entry of patent owner’s April 11, 2011 corrected response submission. Accordingly, patent owner’s request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

#### CONCLUSION

1. Patent owner’s April 11, 2011 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.
2. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.

  
Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

06-17-2011

<sup>7</sup> Id. at page 5.

<sup>8</sup> Id.

<sup>9</sup> 21 pages of the remarks portion of patent owner’s April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 24-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, the portions of the 9-page “Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132” that are subject to the regulatory page limit count do not cause the total number of pages of patent owner’s April 11, 2011 corrected response submission to exceed the 50-page limit. It is noted that the pages of the “Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132,” the “Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132,” and the “Declaration of Rubén Bonet Under 37 C.F.R. § 1.132” do not count toward the regulatory page limit. Additionally, in this instance, the pages of the copies of the court documents that were filed as “Exhibit 5B” and “Exhibit 6” also do not count toward the regulatory page limit.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,501	12/03/2010	7,123,208	3008.008REX2	7104
26111	7590	08/03/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 08/03/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
BAKER BOTTS L.L.P.  
PATENT DEPARTMENT  
98 SAN JACINTO BLVD. SUITE 1500  
AUSTIN, TX 78701-4078

Date:

**MAILED**  
**AUG 03 2011**  
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001501  
PATENT NO. : 7123208  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

**Decision on Petition for Extension  
of Time in Reexamination**

Control No.: 95/001,389 & 95/001,501  
& 95/001,591

1. THIS IS A DECISION ON THE PETITION FILED 28 July 2011.
2. THIS DECISION IS ISSUED PURSUANT TO:
  - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
  - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.  
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS  
Patent owner requests that the period for responding to the Office action dated 01 July 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.
  - A. ☒ Petition fee per 37 CFR §1.17(g):
    - i. ☐ Petition includes authorization to debit a deposit account.
    - ii. ☐ Petition includes authorization to charge a credit card account.
    - iii. ☐ Other: \_\_\_\_\_.
  - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
  - C. ☒ Petition was timely filed.
  - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
  - A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
  - B. ☒ Other/comment: see attached
  - C. ☐ Dismissed because:
    - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
    - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
    - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
    - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
    - v. ☐ The petition is moot.
    - vi. ☐ Other/comment: see attachment.
5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/  
[Signature]

SPE, AU 3992 Central Reexamination Unit  
(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of many other proceedings as well as the overall length of the reexaminations if added together before council, concurrent with preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is Patent owner who must exercise diligence in responding to the Office action. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Office action in an *inter partes* reexamination proceeding. It is Patent owner who must exercise diligence in responding to Office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management insofar as expecting a complete Office action on the merits.

It is further noted that the petition raises questions about the need for declatory evidence pursuant to 37 CFR § 1.132. The time needed to gather such evidence does support sufficient cause for a one (1) month extension of time.

The requirement for reasonably diligent behavior by the patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time.

Per MPEP § 2665 (in-part)

"First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added)

On balance there is "sufficient cause" to grant-in-part the petition for extension of time for a period of one (1) month.

The petition for extension of time is hereby granted-in-part.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	09/28/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.				
1100 NEW YORK AVENUE, N.W.				
WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2011

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12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

**MAILED**  
Date:

**SEP 28 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591  
PATENT NO. : 7123208  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension  
of Time in Reexamination**

Control No.: 95/001,501; 95/001,389; 95/000,591

1. THIS IS A DECISION ON THE PETITION FILED September 23, 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on July 1, 2011, which sets a 2-month period for filing a response thereto, be extended by another 2 months. A first request for a two month extension being granted in part (for one month) on August 3, 2011.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
- ii. ☐ Petition includes authorization to charge a credit card account.
- iii. ☒ Other: electronically submitted.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☐ Granted-in-part for \_\_\_\_\_, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☐ Other/comment: \_\_\_\_\_
- B. ☒ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v. ☐ The petition is moot.
- vi. ☒ Other/comment: A pending petition to terminate 1 of the 3 merged proceedings does not constitute extraordinary circumstances as to why patent owner needs additional time.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.



[Signature]

ERIC S. KEASEL  
CRU SPE-AU 3992

(Title)





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591 + 95/001,389 + 95/001,501	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	11/18/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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SAN DIEGO, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591 + 95/001389 + 95/001501  
PATENT NO. : 7123208  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
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(For Patent Owner)

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12531 HIGH BLUFF DRIVE, SUITE 100  
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(For 95/000,591 Third Party Requester)

NOVAK, DRUCE & QUIGG, LLP  
(NDQ REEXMINATION GROUP)  
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For 95/001,389 Third Party Requester)

BAKER BOTTS LLP  
PATENT DEPARTMENT  
98 SAN JACINTO BLVD, SUITE 1500  
AUSTIN, TX 78701-4039

(For 95/001,501 Third Party Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,591  
Filed: December 14, 2010  
For: U.S. Patent No. 7,123,208

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,389  
Filed: July 1, 2010  
For: U.S. Patent No. 7,123,208

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,501  
Filed: December 3, 2010  
For: U.S. Patent No. 7,123,208

**DECISION  
ON PETITION  
UNDER 37 CFR 1.183**

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 3, 2011 in reexamination proceeding control nos. 95/000,591, 95/001,389 and 95/001,501.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **granted** to the extent set forth below.

## RELEVANT BACKGROUND

1. On October 17, 2006, U.S. patent number 7,123,208 (the '208 patent) issued to Puente Baliarda *et al.*
2. Subsequently, three requests for *inter partes* reexamination of the '208 patent, which requests were assigned Reexamination Control Nos. 95/001,389, 95/001,501, and 95/000,591, were instituted by the Office.
3. On June 1, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1389 proceeding with the '1501 and '591 proceedings (the merged proceeding).
4. On July 1, 2011, the Office issued a non-final Office Action in the merged proceeding.
5. On October 3, 2011, patent owner filed a response to the July 1, 2011 Office action in the merged proceeding, concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).<sup>1</sup>

## DECISION

### I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

---

<sup>1</sup> On August 3 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the July 1, 2011 Office Action.

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

## II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of October 3, 2011

On October 3, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission. Patent owner asserts that the argument portion of the October 3, 2011 response submission is 123 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.<sup>2</sup> Patent owner states that it concurrently filed “a number of 132 declarations” but asserts that the declarations “include only facts and thus does not count towards the 50-page limit.”<sup>3</sup> Nonetheless, patent owner also requests waiver of the 50-page limit for “those portions of the 132 Declarations that the PTO holds count towards the 50 page limit...”<sup>4</sup>

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 3, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.<sup>5</sup> Additionally, patent owner asserts that “the full length of the Response is needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 35 pages, it incorporates by reference almost 800 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”<sup>6</sup> Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>7</sup>

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),<sup>8</sup> and the individual facts and circumstances of this case (such as the length of the July 1, 2011 Office action),<sup>9</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent

<sup>2</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>3</sup> Id. at page 4 (identifying two declaration(s) of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages and 15 pages), a declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera and Jordi Soler under 37 C.F.R. § 1.132 (9 pages), a declaration of Aurora Andujar under 37 C.F.R. § 1.132 (13 pages), and two declaration(s) of Dr. Raj Mittra under 37 C.F.R. § 1.132 (each 20 pages)).

<sup>4</sup> Id. at page 2.

<sup>5</sup> Id. at pages 4-7.

<sup>6</sup> Id. at page 2-3.

<sup>7</sup> Id. at page 3.

<sup>8</sup> 123 pages of the remarks portion of patent owner’s October 3, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 23-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Additionally, at least portions of the 20-page declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 are deemed to be an extension of the arguments of counsel and count toward the page limit. Thus, up to 143 pages of the patent owner’s October 3, 2011 response submission count toward the 50-page limit.

<sup>9</sup> On its face, the substantive portion of the July 1, 2011 Office action spans only approximately 35 pages, but it incorporates by reference numerous pages from the ‘1389, ‘1501 and ‘591 requests for *inter partes* reexamination and comments submissions.

owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 93 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.

### ADDITIONAL DISCUSSION

The 95/001,389 third party requester, 95/001,501 third party requester and the 95/000,591 third party requester have 30 days from the date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

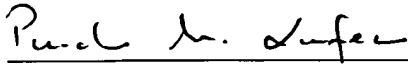
### CONCLUSION

1. Patent owner's October 3, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 93 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.
2. The 95/001,389 third party requester, 95/001,501 third party requester and the 95/000,591 third party requester each has 30 days from the mailing date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.

Reexamination Control No. 95/000,591  
Reexamination Control No. 95/001,389  
Reexamination Control No. 95/001,501

-6-

3. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



---

Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

11-17-2011





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591 + 95/001,389 + 95/001,501	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-12-11

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591 + 95/001389 + 95/001501  
PATENT NO. : 7123208  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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DEC 12 2011

**CENTRAL REEXAMINATION UNIT**

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
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Washington, D.C. 20005

(For Patent Owner)

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San Diego, CA 92130-2040

(For *Inter Partes* '591 Requester)

Baker Botts, LLP  
2001 Ross Avenue  
Suite 600  
Dallas, TX 75201-2980

(For *Inter Partes* '1501 Requester)

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1389 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,591  
Filed: December 14, 2010  
For: U.S. Patent No.: 7,123,208

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,501  
Filed: December 03, 2010  
For: U.S. Patent No. 7,123,208

*Inter Partes* Reexamination Proceeding  
Control No: 95/001,389  
Filed: July 01, 2010  
For: U.S. Patent No. 7,123,208

**DECISION GRANTING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND  
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,501, filed on September 16, 2011, is granted.

*Inter partes* reexamination proceeding control number 95/001,501 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,501, 95/000,591 and 95/001,389.

*Inter partes* reexamination proceeding 95/001,501, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue** in the manner set forth in this decision.<sup>1</sup>

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,501 (the ‘1501 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,123,208 (the ‘208 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that “. . . HTC [the defendant/requester of the ‘1501 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit” and that “[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

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<sup>1</sup> This petition does not address the petition under 37 CFR 1.182 to terminate the ‘591 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision, which will issue in due course.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28”. The “above listed claims” of one of the patents in suit, the ‘208 patent, which is the patent under reexamination in the ‘1501 proceeding, are listed in the consent judgment as claims 1, 5, 7, 10-12, 14, 15, 18, 21, 24-26, 28, 29, 33, 37, 40, 43-48, 54, 57-59 and 61, which are identical to the claims that were requested to be reexamined by HTC in the ‘1501 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that “[a]ll of Fractus’ claims against HTC are dismissed with prejudice. All of HTC’s defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the ‘208 patent] are dismissed with prejudice”, and that “[t]he parties expressly waive their rights to appeal”. Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court’s decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that “[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the ‘1501 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit”. Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner’s September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

*Inter partes* reexamination proceeding control no. 95/001,501 (the ‘1501 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,501 , 95/000,591 and 95/001,389.

*Inter partes* reexamination proceeding control no. 95/001,501 (the ‘1501 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue**.<sup>2</sup> Any rejection proposed by HTC (the requester of the ‘1501 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner “adopts” a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner’s determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner’s determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

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<sup>2</sup> As pointed out above, this decision does not address the September 30, 2011 petition to terminate the ‘591 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.<sup>3</sup> As noted in the June 1, 2011 decision entitled “Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings” (the June 1, 2011 merger decision), because the requester of the ‘591 proceeding did not propose any rejections of claims 18, 37, and 46-47 in its request for reexamination, the requester of the ‘591 proceeding has no appeal rights as to those claims as they appear in the ‘208 patent.

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,591 and 95/001,389, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,591 and 95/001,389 will otherwise remain, in general, as outlined by the June 1, 2011 merger decision.

The ‘1501 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM “Application Number Information” screen and the “Contents” screen will be printed, the printed copy will be annotated by adding the comment “PROCEEDING CONCLUDED,” and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.


## CONCLUSION

- Patent owner’s September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,501 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,501 (the ‘1501 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,501, 95/000,591 and 95/001,389.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue** in the manner set forth in this decision.
- The prosecution of the ‘1501 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The ‘1501 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the ‘1501 proceeding, as set forth in this decision.

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<sup>3</sup> A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester’s comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner’s amendment, if requester’s comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



---

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

Kenpet9



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)  
1000 LOUSIANA STREET  
FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

Date:

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**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389  
PATENT NO. : 7123208  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Date: **DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591  
PATENT NO. : 7123208  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
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(For *Inter Partes* '591 Requester) DEC 12 2011

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1000 Louisiana Street  
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Houston, TX 77002

(For *Inter Partes* '1389 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,591  
Filed: December 14, 2010  
For: U.S. Patent No.: 7,123,208

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,389  
Filed: July 01, 2010  
For: U.S. Patent No. 7,123,208

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND PETITION  
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:<sup>1</sup>

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,501, was granted. *Inter partes* reexamination proceeding 95/001,501 was severed from the merger of *inter partes* reexamination proceedings 95/001,501, 95/000,591 and 95/001,389, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,591 and 95/001,389.

## SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,591, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

## DECISION

### *The September 30, 2011 Petition to Terminate*

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,591 (the '591 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent '7,123,208 (the '208 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '591 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '208 patent's claims 1, 5, 7, 10-12, 14, 15, 18, 21, 24-26, 28, 29, 33, 37, 40, 41, 43-47, 48, 54, 57-59 and 61, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to

expunge, discussed below), the patent owner informs the Office that “[t]he Final Consent Judgment has been filed herewith UNDER SEAL” (emphasis in original).<sup>2</sup> The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.<sup>3</sup>

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to claims 1, 5, 7, 10-12, 14, 15, 21, 24-26, 28, 29, 33, 40, 43-45, 48, 54, 57-59 and 61 of the ‘208 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘591 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘591 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

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<sup>2</sup> The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

<sup>3</sup> If this is not the case, the patent owner is required to so inform the Office.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

### ***The September 30, 2011 Petition to Expunge***

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘591 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so,

whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '591 proceeding, has consented to a waiver of any protective order by the court, if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

### CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,591 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.



- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script, reading "Brian E. Hanlon". The signature is written in black ink and is positioned above a horizontal line.

Brian E. Hanlon  
Director  
Office of Patent Legal Administration



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patents and Trademark Office  
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date: **MAILED**

**FEB 27 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591 + 95001389

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
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Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
1100 New York Avenue, N.W.  
Washington, D.C. 20005

(For Patent Owner)

MAILED

FEB 27 2012

CENTRAL REEXAMINATION UNIT

Morrison & Foerster, LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, CA 92130-2040

(For *Inter Partes* '591 Requester)

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1389 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,591  
Filed: December 14, 2010  
For: U.S. Patent No.: 7,123,208

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,389  
Filed: July 01, 2010  
For: U.S. Patent No. 7,123,208

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).<sup>1</sup>

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,389 (the '1389 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1389 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,501. *Inter partes* reexamination proceeding 95/001,501 was severed from the merger of *inter partes* reexamination proceedings 95/001,501, 95/000,591 and 95/001,389, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,591 and 95/001,389.

## SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,591 is dismissed.

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,591 (the '591 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,123,208 (the '208 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '591 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.<sup>2</sup> The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '591 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '591 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

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<sup>2</sup> For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

### CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,591 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/  
Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration



**MAILED**

JUN 07 2011

(For Patent Owner)

(For *Inter Partes* '592 Requester)

(For *Inter Partes* '1414 Requester)

(For *Inter Partes* '610 Requester)

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**: DECISION, *SUA SPONTE*,  
: MERGING  
: *INTER PARTES*  
: PROCEEDINGS**

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 C.F.R. § 1.989 at this time.



## REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,202,822 (the '822 patent) issued to Carles Puente Baliarda *et al.* on April 10, 2007.
2. On August 4, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/001,414 (the '1414 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest. Reexamination was ordered on October 8, 2010. An action on the merits was issued on that same date, rejecting all of the claims under reexamination. Patent owner responded on April 11, 2011;<sup>1</sup> no amendments to the claims were proposed in that response. Third party requester submitted comments on May 2, 2011.
3. On November 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/000,592 (the '592 *inter partes* proceeding), and a filing date of December 16, 2010, the date at which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest. Reexamination was ordered on January 31, 2011. No action on the merits has been issued in this proceeding.
4. On December 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/000,610 (the '610 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest. Reexamination was ordered on February 1, 2011. No action on the merits has been issued in this proceeding.

## DECISION

### I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

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<sup>1</sup> An earlier patent owner response was refused entry, and additional time given for a proper response.

As evidenced by the above review of facts, the '1414, '592, and '610 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent have been mailed in both the '592 and '610 reexamination proceedings, and an order granting reexamination of claims 1, 4, 5, 7, 9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was mailed in the '1414 reexamination proceeding, and a decision under 37 C.F.R. § 1.989(a) is timely. The '592 and '610 proceedings are at the same stage, in which no Office action on the merits has been issued. The '1414 proceeding is at a stage following issuance of the first Office action on the merits and subsequent to reception of both patent owner and third party requester responses.

The general policy of the Office is that multiple reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1414, '610, and '592 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1414, '610, and '592 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

## **II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS**

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

## **III. CONDUCT OF MERGED PROCEEDING**

### **A. Governing regulations for the merged proceeding:**

The present decision merges an inter partes reexamination proceeding with two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

### **B. *Inter partes* Third Party Requester Participation:**

#### **1. Comment rights:**

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C.

314(b)(2).<sup>2</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

## 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '1414 *inter partes* third party requester does not propose any rejection of claim 8 in the request for reexamination, the '1414 requester has no appeal rights as to those claims as they appear in the '822 patent.

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<sup>2</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 C.F.R. § 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 C.F.R. § 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "*Inter Partes* Reexam"  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 C.F.R. § 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

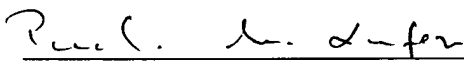
#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester

intends to contest. (37 C.F.R. § 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 C.F.R. § 41.67(c)(1)(vi))

### CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,414, *inter partes* Reexamination Control No.95/000,610, and *inter partes* Reexamination Control No. 95/000,592 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.

  
\_\_\_\_\_  
Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

June 7, 2011



UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

JUN 21 2011

CENTRAL REEXAMINATION UNIT

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,592  
Filed: December 16, 2010  
For: U.S. Patent No. 7,202,822

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*Inter Partes* Reexamination Proceeding  
Control No. 95/000,610  
Filed: December 16, 2010  
For: U.S. Patent No. 7,202,822

: **DECISION**  
: **ON PETITIONS**  
: **UNDER 37 CFR 1.183**  
:  
:  
:

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,414  
Filed: August 4, 2010  
For: U.S. Patent No. 7,202,822

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This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,414.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on May 2, 2011, in reexamination proceeding control no. 95/001,414.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are **granted** to the extent set forth below.

### BACKGROUND

1. On April 10, 2007, U.S. patent number 7,202,822 (the '822 patent) issued to Baliarda *et al.*
2. On August 4, 2010, a third party requester filed a request for *inter partes* reexamination of the '822 patent, which request was assigned Reexamination Control No. 95/001,414 (the '1414 proceeding).
3. On October 8, 2010, the Office issued an order granting *inter partes* reexamination in the '1414 proceeding. Concurrently with the order, the Office issued a non-final Office action.
4. On January 10, 2011, patent owner filed a response to the October 8, 2010 Office action.<sup>1</sup>
5. On February 9, 2011, third party requester filed comments after the October 8, 2010 Office action and patent owner's January 10, 2011 response, concurrently with a petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."
6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's January 10, 2011 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 11, 2011, the Office mailed a decision, dismissing as moot, the February 9, 2011 "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."
8. Also, on April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the October 8, 2010 Office action (patent owner corrected response submission).
9. On May 2, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" (requester petition under 37 CFR 1.183), concurrently with requester's comments after the October 8, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

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<sup>1</sup> On November 17, 2010, the Office mailed a decision granting patent owner's November 9, 2010 petition for a one-month extension of time.



10. On June 7, 2011, the Office issued a “DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS,” merging the ‘1414 proceeding with *inter partes* reexamination proceeding control no. 95/000,592 (the ‘592 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,610 (the ‘610 proceeding).

## DECISION

### I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner’s response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner’s response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner’s response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed

response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1414 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 62 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the corrected response submission.<sup>2</sup> Patent owner states that "a number of 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."<sup>3</sup> Nonetheless, patent owner also requests waiver of the 50-page limit "for any of the 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts."<sup>4</sup>

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.<sup>5</sup> Additionally, patent owner asserts that "the full

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<sup>2</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>3</sup> *Id.* at page 4 (stating that the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)" and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (45 pages)," are filed herewith and noting in FN 3 that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

<sup>4</sup> *Id.* at page 6.

<sup>5</sup> *Id.* at pages 4-6.

length of the Corrected Response is needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 9 pages, it incorporates by reference over 450 pages of arguments and detailed claim charts set forth by the third party requester in its request for reexamination.”<sup>6</sup> Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>7</sup> As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 a redlined document comparing patent owner’s January 10, 2011 original response submission to patent owner’s April 11, 2011 corrected response submission. This redlined document has been expunged from the record of the ‘1414 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),<sup>8</sup> and the individual facts and circumstances of this case (such as the length of the October 8, 2010 Office action), it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner’s April 11, 2011 corrected response submission is much less than the total number of pages of the substantive portion of the October 8, 2010 Office action, which has been determined to span more than 400 pages.<sup>9</sup> Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner’s corrected response to the October 8, 2010 Office action exceeds 50 pages. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s April 11, 2011 corrected response submission. This waiver makes patent owner’s April 11, 2011 corrected response submission page-length compliant.

#### **IV. Third party requester petition of May 2, 2011**

On May 2, 2011, the ‘1414 requester filed, in the ‘1414 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The ‘1414 requester asserts that the May 2, 2011 comments submission

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<sup>6</sup> Id. at page 2.

<sup>7</sup> Id. at page 3.

<sup>8</sup> 69 pages of the remarks portion of patent owner’s April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 17-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the total number of pages of the patent owner’s April 11, 2011 corrected response submission exceeds the 50-page limit.

<sup>9</sup> On its face, the substantive portion of the October 8, 2010 Office action spans only approximately 7 pages, but it incorporates by reference approximately 178 pages, in addition to approximately 220 pages of claim charts, from the ‘1414 request for *inter partes* reexamination.

includes “61 pages of double spaced 12 pt font arguments, a 13 page declaration from Dr. Balanis under 37 C.F.R. § 1.132 and a 21 page excerpt of Dr. Best’s expert report.”<sup>10</sup> The ‘1414 requester asserts, however, that “[i]f the Office agrees with [patent owner’s] interpretation of MPEP § 2667(I)(A)(2), then Samsung’s Comments are only 61 pages as Dr. Balanis’s declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue and the excerpts of Dr. Best’s [sic] expert report primarily address the background of antennas and how one of ordinary skill in the art would understand certain claim language.”<sup>11</sup>

In support of its request for waiver of the rule, the ‘1414 requester asserts that “[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner’s 144 page response.”<sup>12</sup> The ‘1414 requester asserts that it “has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit” and “is asking for significantly fewer total pages than [sic] the Patent Owner has submitted,” *i.e.*, requester “is only asking for a total of 95 pages.”<sup>13</sup> The ‘1414 requester also asserts that “in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner.”<sup>14</sup>

Based on the specific facts set forth in the ‘1414 requester’s petition under 37 CFR 1.183, the ‘1414 requester’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),<sup>15</sup> and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the ‘1414 requester’s May 2, 2011 comments submission exceeds 50 pages. Accordingly, the ‘1414 requester’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of

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<sup>10</sup> Third party requester petition under 37 CFR 1.183 at page 1.

<sup>11</sup> *Id.* at page 4. The ‘1414 requester is cautioned that statements submitted in opposition to patent owner’s petition under 37 CFR 1.183 are improper and may result in the requester’s petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the ‘1414 requester presents arguments against patent owner’s position set forth in patent owner’s petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner’s response to an Office action on the merits. Patent owner’s petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner’s corrected response submission, however, is not a “response” to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner’s petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper “closed” and “not public” in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

<sup>12</sup> *Id.* at page 2.

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

<sup>15</sup> 62 pages of the remarks portion of the ‘1414 requester’s May 2, 2011 comments submission count toward the page limit. Thus, the total number of pages of the ‘1414 requester’s May 2, 2011 comments submission exceeds the 50-page limit.

the '1414 requester's May 2, 2011 comments submission. This waiver makes the '1414 requester's May 2, 2011 comments submission page-length compliant.

### ADDITIONAL DISCUSSION

The 95/000,592 third party requester and the 95/000,610 third party requester have 30 days from the date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Additionally, section III(B)(1) of the Office's June 7, 2011 "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS" states:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2). First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. [footnote omitted]

Thus, because the patent owner's April 11, 2011 corrected response submission was not entered until the mailing date of this decision, which is after merger of the '1414 proceeding with the '592 and '610 proceedings, the entry of patent owner's April 11, 2011 corrected response submission triggers a right for the 95/000,592 third party requester and the 95/000,610 third party requester to file a comment paper pursuant to 37 CFR 1.947 within 30 days of the mailing date of this decision.

### CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 11, 2011 corrected response submission. This waiver makes patent owner's April 11, 2011 corrected response submission page-length compliant.
2. The '1414 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1414 requester's May 2, 2011 comments submission. This waiver makes the '1414 requester's May 2, 2011 comments submission page-length compliant.
3. The 95/000,592 third party requester and the 95/000,610 third party requester have 30 days from the mailing date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



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Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

06-17-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,592 + 95/000,610 + 95/001,414 26111 7590	12/16/2010 12/12/2011	7,202,822	3008.002REX1	8986
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
ART UNIT		PAPER NUMBER		

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patents and Trademark Office  
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 12-12-11

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SAN DIEGO, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000592 + 95/000610 + 95/001414  
PATENT NO. : 7202822  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.





United States Patent and Trademark Office

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**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

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(For *Inter Partes* '1414 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,592  
Filed: December 16, 2010  
For: U.S. Patent No.: 7,202,822

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,610  
Filed: December 16, 2010  
For: U.S. Patent No. 7,202,822

*Inter Partes* Reexamination Proceeding  
Control No: 95/001,414  
Filed: August 4, 2010  
For: U.S. Patent No. 7,202,822

**DECISION GRANTING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND  
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

**SUMMARY**

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,610, filed on September 16, 2011, is **granted**.

*Inter partes* reexamination proceeding control number 95/000,610 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/000,610, 95/000,592 and 95/001,414.

*Inter partes* reexamination proceeding 95/000,610, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue** in the manner set forth in this decision.<sup>1</sup>

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,610 (the ‘610 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,202,822 (the ‘822 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that “. . . HTC [the defendant/requester of the ‘610 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit” and that “[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

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<sup>1</sup> This petition does not address the petition under 37 CFR 1.182 to terminate the ‘592 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '822 patent, which is the patent under reexamination in the '610 proceeding, are listed in the consent judgment as claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53, which are identical to the claims that were requested to be reexamined by HTC in the '610 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '822 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '610 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

*Inter partes* reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,610, 95/000,592 and 95/001,414.

*Inter partes* reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue**.<sup>2</sup> Any rejection proposed by HTC (the requester of the '610 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

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<sup>2</sup> As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '592 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.<sup>3</sup>

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,592 and 95/001,414, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,592 and 95/001,414 will otherwise remain, in general, as outlined by the decision, mailed on June 7, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".<sup>4</sup>

The '610 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

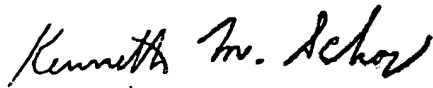
### CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,610 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,610, 95/000,592 and 95/001,414.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue** in the manner set forth in this decision.
- The prosecution of the '610 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '610 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '610 proceeding, as set forth in this decision.

<sup>3</sup> A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

<sup>4</sup> The statement at the bottom of page 4 of the June 7, 2011 decision, that "because the '1414 *inter partes* third party requester does not propose any rejection of claim 8 in the request for reexamination, the '1414 requester has no appeal rights as to those claims as they appear in the '822 patent", was made in error. The requester of the '1414 proceeding did propose rejections of claim 8 in the request filed in that proceeding, and does have appeal rights as to claim 8 as it appears in the '822 patent.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



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Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

Kenpet9



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,592 <b>295/001414</b>	12/16/2010	7,202,822	3008.002REX1	8986
26111	7590	02/23/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-23-12

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000592 + 951001414  
PATENT NO. : 7202822  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

(For Patent Owner)

**MAILED**

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(For 95/000,592 Third Party Requester)

**CENTRAL REEXAMINATION UNIT**

NOVAK, DRUCE & QUIGG, LLP  
(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

(For 95/001,414 Third Party Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,592  
Filed: December 16, 2010  
For: U.S. Patent No. 7,202,822

:  
:  
:  
: **DECISION GRANTING**  
: **PETITION UNDER**  
: **37 CFR 1.183**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,414  
Filed: August 4, 2010  
For: U.S. Patent No. 7,202,822

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This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 31, 2011 in reexamination proceeding control nos. 95/000,592, 95/000,610 and 95/001,414.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **granted** to the extent set forth below.

**RELEVANT BACKGROUND**

1. On April 10, 2007, U.S. patent number 7,202,822 (the '822 patent) issued to Carles Puente Baliarda *et al.*
2. Subsequently, three requests for *inter partes* reexamination of the '822 patent were filed, which requests were assigned Reexamination Control Nos. 95/000,592, 95/000,610, and 95/0001,414, and for each of which reexamination was instituted by the Office.



3. On June 7, 2011, the Office issued a “DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS,” merging the ‘1414 proceeding with the ‘592 and ‘610 proceedings (the merged proceeding).
4. On July 29, 2011, the Office issued a non-final Office action in the merged proceeding.
5. On October 31, 2011, patent owner filed a response to the July 29, 2011 Office action in the merged proceeding (the October 31, 2011 response submission), concurrently with the instant “PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION” (petition under 37 CFR 1.183).<sup>1</sup>
6. On December 12, 2011, the Office issued a “DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER,” terminating the 95/000,610 proceeding and severing the 95/000,610 proceeding from the merged proceeding.<sup>2</sup>

## DECISION

### I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which

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<sup>1</sup> On September 14, 2011, the Office mailed a decision granting a one-month extension of time for patent owner’s response to the July 29, 2011 Office Action.

<sup>2</sup> The merged proceeding continues as to the ‘592 and ‘1414 proceedings.

petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of October 31, 2011

On October 31, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission.<sup>3</sup> Patent owner asserts that the argument portion of the October 31, 2011 response submission is 87 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.<sup>4</sup> Patent owner states that it concurrently filed "a number of 132 declarations" but asserts that the declarations are "drawn to fact, not argument, and thus does [sic] not count towards the 50-page limit."<sup>5</sup> Nonetheless, patent owner also requests waiver of the 50-page limit for "those portions of the 132 Declarations that the PTO holds count towards the 50 page limit...."<sup>6</sup> Patent owner asserts that

<sup>3</sup> Because the '610 proceeding has been terminated, this decision does not address the instant petition with respect to the '610 proceeding.

<sup>4</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>5</sup> *Id.* at page 4 (identifying a declaration of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages), a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (14 pages), a declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 (38 pages), and a declaration of Dr. Yahya Rahmat-Samii under 37 C.F.R. § 1.132 (45 pages)).

<sup>6</sup> *Id.* at page 2.

both the response and the 132 declaration satisfy formatting guidelines for waiver of the regulatory page limit.<sup>7</sup>

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 31, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.<sup>8</sup> Additionally, patent owner asserts that although the Office action “constitutes only 40 pages, it incorporates by reference over 1200 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”<sup>9</sup> Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>10</sup> Thus, patent owner asserts that “the scope and complexity of the Office Action, as well as its efforts to efficiently prepare the Response, establish that more pages are needed (beyond what is permitted by 37 CFR 1.943(b)) to fully and adequately respond to the Office Action.”<sup>11</sup>

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),<sup>12</sup> and the individual facts and circumstances of this case (such as the length of the July 29, 2011 Office action),<sup>13</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s October 31, 2011 response submission. This waiver makes patent owner’s October 31, 2011 response submission page-length compliant.

### ADDITIONAL DISCUSSION

The 95/000,592 third party requester and the 95/001,414 third party requester have 30 days from the date of this decision, granting patent owner’s October 31, 2011 petition under 37 CFR 1.183 and entering patent owner’s October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

<sup>7</sup> Id. at pages 2 and 7 (stating that the response and 132 declarations satisfy “the following requirements: (1) double spaced; (2) non-script type font; (3) font size no smaller than 12-point; (4) conforms to the margin requirements of 37 C.F.R. § 1.52(a)(1)(ii); and (5) sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.”).

<sup>8</sup> Id. at pages 4-7.

<sup>9</sup> Id. at page 3.

<sup>10</sup> Id.

<sup>11</sup> Id.

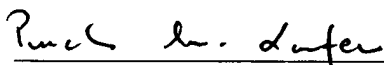
<sup>12</sup> 87 pages of the remarks portion of patent owner’s October 31, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 16-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the patent owner’s October 31, 2011 response submission exceeds the 50-page limit by at least 37 pages, without including any portions of the declarations that also count toward the regulatory page limit.

<sup>13</sup> On its face, the substantive portion of the July 29, 2011 Office action spans only approximately 40 pages, some of which pertain to rejections that have been withdrawn and not adopted, but in setting forth the rejections that have been adopted, it incorporates by reference over 1000 pages from the ‘1414, ‘592 and ‘610 requests for *inter partes* reexamination, far exceeding the number of pages of patent owner’s proposed response, including any pages of the accompanying declarations that also count toward the regulatory page limit.

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, “[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner’s completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so.” Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

### CONCLUSION

1. Patent owner’s October 31, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s October 31, 2011 response submission. This waiver makes patent owner’s October 31, 2011 response submission page-length compliant.
2. The 95/001,414 third party requester and the 95/000,592 third party requester each has 30 days from the mailing date of this decision, granting patent owner’s October 31, 2011 petition under 37 CFR 1.183 and entering patent owner’s October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-7717 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

02-21-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,592	12/16/2010	7,202,822	3008.002REX1	8986

26111 7590 02/27/2012

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 02/27/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date: 11/14/2012  
[RECEIVED]  
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000592 + 95001414

PATENT NO. : 7202822

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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FEB 27 2012

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(For *Inter Partes* '1414 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,592  
Filed: December 16, 2010  
For: U.S. Patent No.: 7,202,822

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,414  
Filed: August 4, 2010  
For: U.S. Patent No. 7,202,822

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).<sup>1</sup>

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,414 (the '1414 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1414 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,610. *Inter partes* reexamination proceeding 95/000,610 was severed from the merger of *inter partes* reexamination proceedings 95/000,610, 95/000,592 and 95/001,414, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,592 and 95/001,414.

## SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,592 is **dismissed**.

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,592 (the '592 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,202,822 (the '822 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '592 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in



original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.<sup>2</sup> The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '592 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '592 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

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<sup>2</sup> For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

### CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,592 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/

Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration



# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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Alexandria, Virginia 22313-1450  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	06/08/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/08/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date:

**MAILED**

**JUN 08 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



MAILED

JUN 08 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

(For *Inter Partes* '593 Requester)

(For *Inter Partes* '1413 Requester)

(For *Inter Partes* '598 Requester)

[illegible]

**: DECISION, *SUA SPONTE*,  
: MERGING  
: *INTER PARTES*  
: PROCEEDINGS**

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 C.F.R. § 1.989 at this time.

## REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,148,850 B2 (the '850 patent) issued to Carles Puente Baliarda *et al.* on December 12, 2006.
2. On August 4, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/001,413 (the '1413 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest. Reexamination was ordered on October 8, 2010. A first Office action on the merits was issued in this proceeding on the same date, rejecting all pending claims under reexamination. Patent owner filed a response on April 11, 2011;<sup>1</sup> the response did not include any proposed amendment to the claims. Third party requester filed comments on May 2, 2011.
3. On November 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/000,593 (the '593 *inter partes* proceeding), and a filing date of December 22, 2010, the date which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest. Reexamination was ordered on February 3, 2011. No action on the merits has been issued in this proceeding.
4. On December 3, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/000,598 (the '598 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest. Reexamination was ordered on February 4, 2011. No action on the merits has been issued in this proceeding.

## DECISION

### I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

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<sup>1</sup> An earlier-filed patent owner response was refused entry, and additional time was given for a proper response.

As evidenced by the above review of facts, the '1413, '593, and '598 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent have been mailed in each of the reexamination proceedings, and a decision under 37 C.F.R. § 1.989(a) is timely. The '593, and '598 reexamination proceedings are at the same stage, in which no Office action on the merits has been issued. The '1413 proceeding is at a stage following issuance of the first Office action on the merits and subsequent to the reception of both patent owner and third party requester responses.

The general policy of the Office is that multiple reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1413, '593, and '598 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1413, '593, and '598 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

## II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

The present decision merges an inter partes reexamination proceeding with two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

### B. *Inter partes* Third Party Requester Participation:

#### 1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).<sup>2</sup> First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters'

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<sup>2</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

## 2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

## C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:



By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 C.F.R. § 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 C.F.R. § 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "*Inter Partes* Reexam"  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window  
Attn: Central Reexamination Unit  
Randolph Building, Lobby Level  
401 Dulany Street  
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

#### D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 C.F.R. § 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

#### E. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

#### F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

#### G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 C.F.R. § 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 C.F.R. § 41.67(c)(1)(vi))

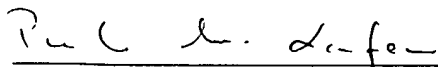
### CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,413, *inter partes* Reexamination Control No.95/000,598, and *inter partes* Reexamination Control No. 95/000,593 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

Inter partes Reexamination Control No. 95/001,413,  
inter partes Reexamination Control No.95/000,598, and  
inter partes Reexamination Control No. 95/000,593.

-7-

2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.



---

Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

June 7, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

Date:

**MAILED**

**JUN 21 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593  
PATENT NO. : 7148850  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
NOVAK DRUCE & QUIGG LLP  
(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

Date:

**MAILED**

**JUN 21 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413  
PATENT NO. : 7148850  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,598	12/03/2010	7148850	3008.009REX2	8625
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

Please find below and/or attached an Office communication concerning this application or proceeding.





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BAKER BOTTS LLP  
2001 ROSS AVENUE  
SUITE 600  
DALLAS, TX 75201-2980

Date:

**MAILED**

**JUN 21 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

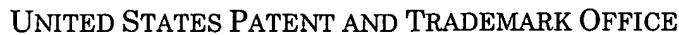
REEXAMINATION CONTROL NO. : 95000598  
PATENT NO. : 7148850  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**MAILED**

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(For 95/000,593 Third Party Requester) JUN 21 2011

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(For 95/001,413 Third Party Requester)

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(For 95/000,598 Third Party Requester)

***Inter Partes* Reexamination Proceeding**  
**Control No. 95/000,593**  
**Filed: December 22, 2010**  
**For: U.S. Patent No. 7,148,850**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,413  
Filed: August 4, 2010  
For: U.S. Patent No. 7,148,850

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,598  
Filed: December 3, 2010  
For: U.S. Patent No. 7,148,850

DECISION  
ON PETITIONS  
UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,413.

This is also a decision on the third party requester petition paper entitled “THIRD PARTY REQUESTER’S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A),” filed on May 2, 2011, in reexamination proceeding control no. 95/001,413.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are **granted** to the extent set forth below.

### BACKGROUND

1. On December 12, 2006, U.S. patent number 7,148,850 (the '850 patent) issued to Baliarda *et al.*
2. On August 4, 2010, a third party requester filed a request for *inter partes* reexamination of the '850 patent, which request was assigned Reexamination Control No. 95/001,413 (the '1413 proceeding).
3. On October 8, 2010, the Office issued an order granting *inter partes* reexamination in the '1413 proceeding. Concurrently with the order, the Office issued a non-final Office action.
4. On January 10, 2011, patent owner filed a response to the October 8, 2010 Office action.<sup>1</sup>
5. On February 9, 2011, third party requester filed comments after the October 8, 2010 Office action and patent owner's January 10, 2011 response, concurrently with a petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."
6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's January 10, 2011 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 11, 2011, the Office mailed a decision, dismissing as moot, the February 9, 2011 "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."
8. Also, on April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the October 8, 2010 Office action (patent owner corrected response submission).
9. On May 2, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" (requester petition under 37 CFR 1.183), concurrently with requester's comments after the

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<sup>1</sup> On November 17, 2010, the Office mailed a decision granting patent owner's November 9, 2010 petition for a one-month extension of time.

October 8, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

10. On June 8, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1413 proceeding with *inter partes* reexamination proceeding control no. 95/000,593 (the '593 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,598 (the '598 proceeding).

## DECISION

### I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a

response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1413 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 50 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).<sup>2</sup> Patent owner states that "a number of Rule 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."<sup>3</sup> Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."<sup>4</sup>

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<sup>2</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>3</sup> *Id.* (stating that "[i]n addition to the Corrected Response, a number of Rule 132 declarations are filed herewith: Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages); and, Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (19 pages)," and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

<sup>4</sup> *Id.*

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.<sup>5</sup> Additionally, patent owner asserts that “the full length of the Corrected Response and the Rule 132 declarations are needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 7 pages, it incorporates by reference almost 500 pages of arguments and detailed claim charts.”<sup>6</sup> Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>7</sup> As evidence of the reformatting and further editing made to reduce page length, patent owner submitted as “Exhibit 1” a redlined document comparing patent owner’s January 10, 2011 original response submission to patent owner’s April 11, 2011 corrected response submission. “Exhibit 1” has been expunged from the record of the ‘1413 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),<sup>8</sup> and the individual facts and circumstances of this case (such as the length of the October 8, 2010 Office action), it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner’s April 11, 2011 corrected response submission is much less than the total number of pages of the substantive portion of the October 8, 2010 Office action, which has been determined to span approximately 475 pages.<sup>9</sup> Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner’s corrected response to the October 8, 2010 Office action exceeds 50 pages. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s April 11, 2011 corrected response submission. This waiver makes patent owner’s April 11, 2011 corrected response submission page-length compliant.

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<sup>5</sup> Id. at pages 2-4.

<sup>6</sup> Id. at page 5.

<sup>7</sup> Id.

<sup>8</sup> 49 pages of the remarks portion of patent owner’s April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 14-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, portions of the 45-page “Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132” are subject to the regulatory page limit count, such that the total number of pages of the patent owner’s April 11, 2011 corrected response submission exceeds the 50-page limit.

<sup>9</sup> On its face, the substantive portion of the October 8, 2010 Office action spans only 5 pages, but it incorporates by reference more than 200 pages, in addition to approximately 270 pages of claim charts, from the ‘1413 request for *inter partes* reexamination.

#### **IV. Third party requester petition of May 2, 2011**

On May 2, 2011, the '1413 requester filed, in the '1413 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The '1413 requester asserts that the May 2, 2011 comments submission includes "49 pages of double spaced 12 pt font arguments, a 13 page declaration from Dr. Balanis under 37 C.F.R. § 1.132 and a 21 page excerpt of Dr. Best's expert report."<sup>10</sup> The '1413 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 49 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue and the excerpts of Dr. Best's [sic] expert report primarily address the background of antennas and how one of ordinary skill in the art would understand certain claim language" such that no waiver would be needed.<sup>11</sup>

In support of its request for waiver of the rule, the '1413 requester asserts that "[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner's 132 page response."<sup>12</sup> The '1413 requester asserts that it "has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit" and "is asking for significantly fewer total pages than [sic] the Patent Owner has submitted," *i.e.*, requester "is only asking for a total of 83 pages."<sup>13</sup> The '1413 requester also asserts that "in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner."<sup>14</sup>

Based on the specific facts set forth in the '1413 requester's petition under 37 CFR 1.183, the '1413 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),<sup>15</sup> and the

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<sup>10</sup> Third party requester petition under 37 CFR 1.183 at page 1.

<sup>11</sup> *Id.* at page 4. The '1413 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1413 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's corrected response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

<sup>12</sup> *Id.* at page 2.

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

<sup>15</sup> Upon brief review, it appears that 49 pages of the remarks portion of the '1413 requester's May 2, 2011 comments submission count toward the page limit. Further, based on the guidance set forth in section II above, portions of the

individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1413 requester's May 2, 2011 comments submission exceeds 50 pages. Accordingly, the '1413 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1413 requester's May 2, 2011 comments submission. This waiver makes the '1413 requester's May 2, 2011 comments submission page-length compliant.

### ADDITIONAL DISCUSSION

The 95/000,593 third party requester and the 95/000,598 third party requester have 30 days from the date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Additionally, section III(B)(1) of the Office's June 8, 2011 "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS" states:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2). First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action.

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submitted declarations are deemed to include legal argument and are subject to the regulatory page limit count, such that the total number of pages of the '1413 requester's May 2, 2011 comments submission exceeds the 50-page limit.



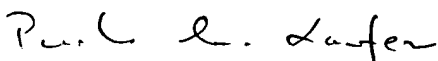
Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. [footnote omitted]

Thus, because the patent owner's April 11, 2011 corrected response submission was not entered until the mailing date of this decision, which is after merger of the '1413 proceeding with the '593 and '598 proceedings, the entry of patent owner's April 11, 2011 corrected response submission triggers a right for the 95/000,593 third party requester and the 95/000,598 third party requester to file a comment paper pursuant to 37 CFR 1.947 within 30 days of the mailing date of this decision.

### CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 11, 2011 corrected response submission. This waiver makes patent owner's April 11, 2011 corrected response submission page-length compliant.
2. The '1413 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1413 requester's May 2, 2011 comments submission. This waiver makes the '1413 requester's May 2, 2011 comments submission page-length compliant.
3. The 95/000,593 third party requester and the 95/000,598 third party requester have 30 days from the mailing date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

06-17-2011



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593 → 95/000,598 + 95/001,413	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patents and Trademark Office  
P.O.Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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Date: 12-12-11

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593 + 95/000598 + 95/001413  
PATENT NO. : 7148850  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

**MAILED**

DEC 12 2011

**CENTRAL REEXAMINATION UNIT**

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*Inter Partes* Reexamination Proceeding  
Control No. 95/000,593  
Filed: December 22, 2010  
For: U.S. Patent No.: 7,148,850

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,598  
Filed: December 03, 2010  
For: U.S. Patent No. 7,148,850

*Inter Partes* Reexamination Proceeding  
Control No: 95/001,413  
Filed: August 4, 2010  
For: U.S. Patent No. 7,148,850

**DECISION GRANTING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND  
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

#### SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,598, filed on September 16, 2011, is **granted**.

*Inter partes* reexamination proceeding control number 95/000,598 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/000,598, 95/000,593 and 95/001,413.

*Inter partes* reexamination proceeding 95/000,598, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue** in the manner set forth in this decision.<sup>1</sup>

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,598 (the ‘598 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,148,850 (the ‘850 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that “. . . HTC [the defendant/requester of the ‘598 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit” and that “[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

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<sup>1</sup> This petition does not address the petition under 37 CFR 1.182 to terminate the ‘593 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 29, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '850 patent, which is the patent under reexamination in the '598 proceeding, are listed in the consent judgment as claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, 68, 69, and 70, which are, with the exception of claim 68, identical to the claims that were requested to be reexamined by HTC in the '598 proceeding,<sup>2</sup> and are identical (i.e., including claim 68) to the claims under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '850 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '598 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

*Inter partes* reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,598 , 95/000,593 and 95/001,413.

*Inter partes* reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue**.<sup>3</sup> Any rejection proposed by HTC (the requester of the '598 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or

<sup>2</sup> Claim 68 was not specifically requested to be reexamined in the request of the '598 proceeding, but is currently under reexamination in the merged proceeding.

<sup>3</sup> As pointed out above, this decision does not address the September 29, 2011 petition to terminate the '593 proceeding which is presently pending. This petition will be addressed by a separate decision.

otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.<sup>4</sup>

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,593 and 95/001,413, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,593 and 95/001,413 will otherwise remain, in general, as outlined by the decision, mailed on June 8, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '598 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

### CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,598 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,598, 95/000,593 and 95/001,413.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue** in the manner set forth in this decision.
- The prosecution of the '598 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '598 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '598 proceeding, as set forth in this decision.

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<sup>4</sup> A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



---

Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

Kenpet9





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

**MAILED**

Date: **DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593  
PATENT NO. : 7148850  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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(NDQ REEXAMINATION GROUP)  
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR  
HOUSTON, TX 77002

Date: **MAILED**

**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413  
PATENT NO. : 7148850  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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Sterne, Kessler, Goldstein & Fox, P.L.L.C.  
1100 New York Avenue, N.W.  
Washington, D.C. 20005

(For Patent Owner)

**MAILED**

Morrison & Foerster, LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, CA 92130-2040

(For *Inter Partes* '593 Requester)

**DEC 12 2011**

**CENTRAL REEXAMINATION UNIT**

Novak, Druce & Quigg, LLP  
(NDQ Reexamination Group)  
1000 Louisiana Street  
Fifty-third Floor  
Houston, TX 77002

(For *Inter Partes* '1413 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,593  
Filed: December 22, 2010  
For: U.S. Patent No.: 7,148,850

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,413  
Filed: August 04, 2010  
For: U.S. Patent No. 7,148,850

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING AND PETITION  
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:<sup>1</sup>

1. The September 29, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 29, 2011 petition to terminate); and
2. The September 29, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 29, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 29, 2011, patent owner's petition to expunge filed on September 29, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,598, was granted. *Inter partes* reexamination proceeding 95/000,598 was severed from the merger of *inter partes* reexamination proceedings 95/000,598, 95/000,593 and 95/001,413, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,593 and 95/001,413.

## SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,593, filed on September 29, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 29, 2011, is **dismissed**.

## DECISION

### *The September 29, 2011 Petition to Terminate*

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,593 (the '593 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,148,850 (the '850 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '593 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '850 patent's claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, 68-70, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 29, 2011 petition to

expunge, discussed below), the patent owner informs the Office that “[t]he Final Consent Judgment has been filed herewith UNDER SEAL” (emphasis in original).<sup>2</sup> The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 29, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 29, 2011 petition to terminate.<sup>3</sup>

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the ‘850 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘593 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘593 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an

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<sup>2</sup> The September 29, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 29, 2011.

<sup>3</sup> If this is not the case, the patent owner is required to so inform the Office.

obligation to “provide an administrative record showing the evidence on which the findings are based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 29, 2011 petition to terminate is **dismissed**.

### ***The September 29, 2011 Petition to Expunge***

On September 29, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 29, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “ . . . entered a Final Consent Judgment against Kyocera [the requester of the ‘593 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 29, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the



requester of the '593 proceeding, has consented to a waiver of any protective order by the court, if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 29, 2011 petition to expunge information is **dismissed**.


The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

### CONCLUSION

- Patent owner's September 29, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,593 is **dismissed**.
- Patent owner's September 29, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 29, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script that reads "Brian E. Hanlon". The signature is written in black ink and is positioned above a horizontal line.

Brian E. Hanlon  
Director  
Office of Patent Legal Administration



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

**MAILED**

**FEB 22 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	02/22/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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Date:

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HOUSTON, TX 77002

**MAILED**

**FEB 22 2012**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**FEB 22 2012**

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(For Patent Owner)

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(For 95/000,593 Third Party Requester)

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HOUSTON, TX 77002

(For 95/001,413 Third Party Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,593  
Filed: December 22, 2010  
For: U.S. Patent No. 7,148,850

:  
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:  
: **DECISION GRANTING**  
: **PETITION UNDER**  
: **37 CFR 1.183**

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,413  
Filed: August 4, 2010  
For: U.S. Patent No. 7,148,850

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This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 31, 2011 in reexamination proceeding control nos. 95/000,593, 95/000,598 and 95/001,413.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **granted** to the extent set forth below.

**RELEVANT BACKGROUND**

1. On December 12, 2006, U.S. patent number 7,148,850 (the '850 patent) issued to Carles Puente Baliarda *et al.*
2. Subsequently, three requests for *inter partes* reexamination of the '850 patent were filed, which requests were assigned Reexamination Control Nos. 95/000,593, 95/000,598, and 95/0001,413, and for each of which reexamination was instituted by the Office.

3. On June 8, 2011, the Office issued a “DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS,” merging the ‘1413 proceeding with the ‘593 and ‘598 proceedings (the merged proceeding).
4. On July 29, 2011, the Office issued a non-final Office action in the merged proceeding.
5. On October 31, 2011, patent owner filed a response to the July 29, 2011 Office action in the merged proceeding (the October 31, 2011 response submission), concurrently with the instant “PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION” (petition under 37 CFR 1.183).<sup>1</sup>
6. On December 12, 2011, the Office issued a “DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER,” terminating the 95/000,598 proceeding and severing the 95/000,598 proceeding from the merged proceeding.<sup>2</sup>

## DECISION

### I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

### II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an

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<sup>1</sup> On September 8, 2011, the Office mailed a decision granting a one-month extension of time for patent owner’s response to the July 29, 2011 Office Action.

<sup>2</sup> The merged proceeding continues as to the ‘593 and ‘1413 proceedings.



attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

### III. Patent owner petition of October 31, 2011

On October 31, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission.<sup>3</sup> Patent owner asserts that the argument portion of the October 31, 2011 response submission is 95 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.<sup>4</sup> Patent owner states that it concurrently filed "a number of 132 Declarations" but asserts that the declarations are "drawn to fact, not argument, and thus does [sic] not count towards the 50-page limit."<sup>5</sup> Nonetheless, patent owner also requests waiver of the 50-page limit for "those portions of the 132 Declarations that the PTO

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<sup>3</sup> Because the '598 proceeding has been terminated, this decision does not address the instant petition with respect to the '598 proceeding.

<sup>4</sup> Patent owner petition under 37 CFR 1.183 at page 2.

<sup>5</sup> *Id.* at page 4 (identifying a declaration of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages), a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (14 pages), a declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 (38 pages), and a declaration of Dr. Yahya Rahmat-Samii under 37 C.F.R. § 1.132 (45 pages)).

holds count towards the 50 page limit....”<sup>6</sup> Patent owner asserts that both the response and the 132 declaration satisfy formatting guidelines for waiver of the regulatory page limit.<sup>7</sup>

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 31, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.<sup>8</sup> Additionally, patent owner asserts that although the Office action “constitutes only 36 pages, it incorporates by reference over 1200 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”<sup>9</sup> Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”<sup>10</sup> Thus, patent owner asserts that “the scope and complexity of the Office Action, as well as its efforts to efficiently prepare the Response, establish that more pages are needed (beyond what is permitted by 37 CFR 1.943(b)) to fully and adequately respond to the Office Action.”<sup>11</sup>

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),<sup>12</sup> and the individual facts and circumstances of this case (such as the length of the July 29, 2011 Office action),<sup>13</sup> it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s October 31, 2011 response submission. This waiver makes patent owner’s October 31, 2011 response submission page-length compliant.

## ADDITIONAL DISCUSSION

The 95/000,593 third party requester and the 95/001,413 third party requester have 30 days from the date of this decision, granting patent owner’s October 31, 2011 petition under 37 CFR 1.183 and entering patent owner’s October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

<sup>6</sup> Id. at page 2.

<sup>7</sup> Id. at pages 2 and 7 (stating that the response and 132 declarations satisfy “the following requirements: (1) double spaced; (2) non-script type font; (3) font size no smaller than 12-point; (4) conforms to the margin requirements of 37 C.F.R. § 1.52(a)(1)(ii); and (5) sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.”).

<sup>8</sup> Id. at pages 4-7.

<sup>9</sup> Id. at page 3.

<sup>10</sup> Id.

<sup>11</sup> Id.

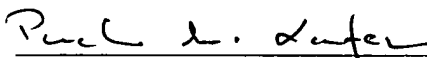
<sup>12</sup> 94 pages of the remarks portion of patent owner’s October 31, 2011 response submission count toward the page limit (the cover page, pages of the table of contents, and the last page that only includes a signature are excluded from the page count, as is the 15-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the patent owner’s October 31, 2011 response submission exceeds the 50-page limit by at least 44 pages, without including any portions of the declarations that also count toward the regulatory page limit.

<sup>13</sup> On its face, the substantive portion of the July 29, 2011 Office action spans only approximately 43 pages, but in setting forth the rejections that have been adopted, it incorporates by reference nearly 900 pages from the ‘1413, ‘593 and ‘598 requests for *inter partes* reexamination, far exceeding the number of pages of patent owner’s proposed response, including any pages of the accompanying declarations that also count toward the regulatory page limit.

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

### CONCLUSION

1. Patent owner's October 31, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's October 31, 2011 response submission. This waiver makes patent owner's October 31, 2011 response submission page-length compliant.
2. The 95/001,413 third party requester and the 95/000,593 third party requester each has 30 days from the mailing date of this decision, granting patent owner's October 31, 2011 petition under 37 CFR 1.183 and entering patent owner's October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-7717 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

02-21-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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FEB 27 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593 + 95001413  
PATENT NO. : 7148850  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For *Inter Partes* '1413 Requester)

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,593  
Filed: December 22, 2010  
For: U.S. Patent No.: 7,148,850

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,413  
Filed: August 04, 2010  
For: U.S. Patent No. 7,148,850

**DECISION DISMISSING  
PETITION TO TERMINATE  
INTER PARTES REEXAMINATION  
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).<sup>1</sup>

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,413 (the '1413 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1413 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

<sup>1</sup> On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,598. *Inter partes* reexamination proceeding 95/000,598 was severed from the merger of *inter partes* reexamination proceedings 95/000,598, 95/000,593 and 95/001,413, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,593 and 95/001,413.

## SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,593 is **dismissed**.

## DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,593 (the '593 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,148,850 (the '850 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '593 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 29, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 29, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.<sup>2</sup> The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '593 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '593 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

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<sup>2</sup> For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.



### CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,593 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/

Cynthia L. Nessler  
Senior Legal Advisor  
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,594	11/17/2010	7,749,024	CWC-10-5072REX	5399
32914	7590	10/19/2011	EXAMINER	
GARDERE WYNNE SEWELL LLP INTELLECTUAL PROPERTY SECTION 3000 THANKSGIVING TOWER 1601 ELM ST DALLAS, TX 75201-4761			ART UNIT	PAPER NUMBER

DATE MAILED: 10/19/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

PATENT GROUP

C/O DLA PIPER US LLP

203 N. LASALLE ST., SUITE 1900

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**MAILED**

**OCT 19 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000594

PATENT NO. : 7749024

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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**MAILED**

**OCT 19 2011**

**CENTRAL REEXAMINATION UNIT**

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DLA PIPER LLP (US) : (For Third Party  
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CHICAGO, IL 60601 :

*In re: Chambers et al.* :  
*Inter Partes* Reexamination Proceeding : DECISION ON PETITION  
Control No.: 95/000,594 :  
Deposited: November 17, 2010 :  
For: U.S. Patent No.: 7,749,024 :

This is a decision on a petition filed by the patent owner on April 26, 2011, entitled: "PETITION UNDER 37 C.F.R. § 1.182 REQUESTING SUBSTITUTION OF CORRECT VERSION OF PATENT OWNER'S RESPONSE TO INITIAL OFFICE ACTION IN PLACE OF INCORRECT VERSION THAT WAS FILED" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion to enter a substitute response to an Office action in place of an allegedly incorrect response that was erroneously filed. The Petition is being treated as a petition under 37 CFR § 1.181.

The petition is before the Director of the Central Reexamination Unit. The petition is granted.

## REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,749,024 issued on July 6, 2010.
- A request for *inter partes* reexamination was filed on November 17, 2010 and assigned control no. 95/000,594.
- *Inter partes* reexamination was ordered and a non-final Office action was mailed February 11, 2011.
- On April 11, 2011, patent owner responded to the Office action.
- On April 26, 2011, patent owner filed the instant petition along with a corrected response.
- On May 11, 2011, the third party filed comments to the April 11<sup>th</sup> response.

## DECISION

Patent owner [“petitioner”] submits that in filing its April 11<sup>th</sup> response it erroneously uploaded the incorrect documents. Petitioner claims it intended to file a particular final and edited version of the response, but inadvertently filed an unedited draft version. Petitioner asserts this error was caused by an earlier equipment malfunction, which led to inconsistencies in the numbering of documents in petitioner’s document numbering software, and an incorrect document reference number led to petitioner’s belief that the draft version was a final version. The declaration of Kenneth R. Glaser, petitioner’s representative in this proceeding, corroborates these facts. On April 26, 2011, petitioner filed the correct final version of the response [hereafter “substitute response”], which Glaser avers has not been altered since the original erroneous filing.

It is apparent on these facts that petitioner’s original filing was *bona fide*, and the error was inadvertent and not in bad faith. Accordingly, fairness favors entry of the substitute response so that the most accurate and complete response is set forth in the record. This is especially so given the compact prosecution typical in reexaminations, which allow for no continuations, requests for continued examination, etc., highlighting the importance of each response.

Potentially weighing on the other side is the requirement of 35 U.S.C. § 314 that this proceeding be conducted with special dispatch, always a consideration in reexaminations. Here, however, the requirement for special dispatch does not weigh against entry of the substitute response. The examiner has not yet acted on the original response, therefore we would not have to go backward

in prosecution. The only potential issue here is that the third party has already filed its comments to the original response, and it must also be given an opportunity to file comments to the substitute response. But even this does not weigh in the analysis, because the third party's comments submission was non-compliant as described below. The examiner would therefore have been required to send a Notice of Defective Paper and permit correction, thus the Office would have to wait for an additional third party comments submission anyway. The requirement for special dispatch therefore does not weigh against granting the petition.

Accordingly, fairness favors entry of the substitute response, while special dispatch does not weigh against entry. The patent owner's substitute response filed April 26, 2011 is taken as the patent owner's response to the Office action. As second responses are not entered as a matter of right, the substitute response was not officially entered until this decision. The third party therefore has 30 days from the mailing date of this decision to file comments under 37 CFR § 1.947 directed toward the substitute response. The petition is granted.

#### Additional Discussion

It is noted that the third party's comments submission filed May 11, 2011 is improper under 37 CFR § 1.943(b), which limits such submissions to 50 pages. This decision constitutes notice that the submission is improper and will not be considered. As described above, however, the third party now has 30 days from the mailing date of this decision to file comments directed to the substitute response. The third party is apprised that to be considered, any submission must comply with all of the typical requirements, including the page limit requirement, or else must be accompanied by a grantable petition under 37 CFR § 1.183 requesting waiver of the rule.

### CONCLUSION

1. The petition filed April 26, 2011 is granted. The patent owner's substitute response filed April 26, 2011 is the response to the Office action, replacing the April 11, 2011 submission.
2. As the substitute response was not entered until the mailing date of this decision, the third party now has a time period of 30 days to file comments directed to the substitute response.
3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



İrem Yücel  
Director, Central Reexamination Unit